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The Law of Trademarks Tradenames

and

Unfair Competition

Including Trade Secrets; Goodwill; The Federal Trademark Acts of 1870, 1881 and 1905; The Trademark Registration Acts of the States and Territories; and the Canadian Trademark and Design Act; with Forms

By

JAMES LOVE HOPKINS

THIRD EDITION

Cincinnati

THE W. H. ANDERSON COMPANY

1917

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1917

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INTRODUCING THE THIRD EDITION

With the present revision this book becomes the first American text on the subject to attain a third edition. This fact would have been impossible had it not been for the generous use given the earlier editions by the judges and lawyers of this country, and for the many and kindly suggestions and criticism from my professional brethren which have lightened my labors, all of which I take equal pride and pleasure in here acknowledging.

A quarter of a century has elapsed since I first ventured upon the literature of this division of the law, and engaged in its practice. I trust that these pages may reflect to the reader something of the fascination and charm the subject has ever had for the author.

JAMES LOVE HOPKINS.

Chemical Building, St. Louis.
December 1, 1916.

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AUTHOR'S NOTE

(FROM THE SECOND EDITION.)

Froude, in his essay on the Science of History, said, "Opinions alter, manners change, creeds rise and fall, but the moral law is written on the tablets of eternity."

In the law of trademarks is contained the first recognition by the courts of the principle that no man should be permitted to pass off his goods as those of another. Does the fact that this department of our law is of so recent origin import that, in the past, English speaking traders were more honest in their dealings? The answer to that question must be looked for in the pages of history. Even if Napoleon was correct in his assertion that history was "but a fiction agreed upon," it contains the only evidence available for our purpose. Furthermore, Buckle's theory that history, though conflicting as to the character and achievements of individuals, is still harmonious as to the manners of a given period, leads us to believe that the authors to whom we purpose to briefly refer may, for the purpose of our inquiry, be deemed authoritative.

Writing of the conditions existing in England during the Anglo-Saxon period, Hume says "Whatever we may imagine concerning the usual truth and sincerity of men who live in a rude and barbarous state, there is much more falsehood, and even perjury among them, than among civilized nations; virtue, which is nothing but a more enlarged and more cultivated reason, never flourishes to any degree, nor is founded on steady principles of honour, except where a good education becomes general; and where men are taught the pernicious consequences of vice, treachery and immorality. Even superstition, though more prevalent among ignorant nations, is but a poor supply for the defects in knowledge and education; our European ancestors, who employed every moment the expedient of swearing on extraordinary crosses, and relics, were less honourable in all engagements than their posterity,

who, from experience, have omitted those ineffectual securities. This general proneness to perjury was much increased by the usual want of discernment in judges, who could not discuss an intricate evidence, and were obliged to number, not weigh, the testimony of the witnesses."

Daniel De Foe (whom Taine describes as "one of those indefatigable labourers and obstinate combatants, who, ill-treated, calumniated, imprisoned, succeeded by their uprightness, common sense, and energy in gaining England over to their side") published in 1725 and 1727 his book, "The Complete English Tradesman," in which he treats of the ethics of English trade. In that work he refers to the "shop rhetorick" and "flux of falsehoods" used by tradesmen in disposing of their wares, and the common practice of keeping on hand a bag of spurious or debased coin from which to make change. Charles Lamb said this work was "of a vile and debasing tendency." The French critic is probably the better judge of De Foe.

In 1859 Herbert Spencer in his essay on "The Morals of Trade," treats of the ethics of the same tradesmen more than a century later. He refers to "the often-told tale of adulterations," and says, "It is not true, as many suppose, that only the lower classes of the commercial world are guilty of fraudulent dealing. Those above them are to a great extent blameworthy. On the average, men who deal in bales and tons differ but little in morality from men who deal in yards and pounds. Illicit practices of every form and shade, from venial deception up to all but direct theft, may be brought home to the higher grades of our commercial world. Tricks innumerable, lies acted or uttered, elaborately-devised frauds, are prevalent; many of them established as 'customs of the trade'; nay, not only established, but defended. * * * We cannot here enlarge on the not uncommon trick of using false trademarks, or of imitating another maker's wrappers. * * * Omitting the highest mercantile classes, a few of the less common trades, and those exceptional cases where an entire command of the market has been obtained, the uniform testimony of competent judges is, that success is incompatible with strict integrity. To live in the commercial world it

appears necessary to adopt its ethical code; neither exceeding nor falling short of it—neither being less honest nor more honest. Those who sink below its standard are expelled; while those who rise above it are either pulled down to it or ruined. As, in self-defense, the civilized man becomes savage among savages; so it seems that in self-defense, the scrupulous trader is obliged to become as little scrupulous as his competitors. It has been said that the law of the animal creation is—'eat and be eaten'; and of our trading community it may similarly be said that its law is—cheat and be cheated. A system of keen competition, carried on, as it is, without adequate moral restraint, is very much a system of commercial cannibalism. Its alternatives are—use the same weapons as your antagonists or be conquered and devoured."

If the statements of those three writers are to be accepted as evidence, and they would seem to be the best evidence, as to the ethics of trade in England at the several periods referred to, it would appear that the present condition of trade as to fairness in competition is far more wholesome. That bettered condition must be attributed largely to the judicial evolution of the principles treated in this book.

In this conclusion, the author is supported by Sir Frederick Pollock. In his First Book of Jurisprudence he says, "Rules of law may well have, in particular circumstances, an effective influence in maintaining, reinforcing, and even elevating the standard of current morality. The moral ideal present to lawgivers and judges, if it does not always come up to the highest that has been conceived, will at least be, generally speaking, above the common average of practice; it will represent the standard of the best sort of citizens. This is especially the case in matters of good faith, whether we look to commercial honesty or to relations of personal confidence. With few exceptions, the law has, in such matters, been constantly ahead not only of the practice but of the ordinary professions of business men."

Ethical evolution and organic evolution alike are accomplished slowly, and the possibilities of each are alike limitless. From the days when the Anglo-Saxon judges numbered the witnesses because of inability to weigh their testimony, to the

era when the requirement of fairness in trade was established, the English-speaking people have made immeasurable ethical progress. To that progress, the science of law has made many contributions, and has been indispensable.

We are dealing in the subjects comprised in this book with the highest ethical development of that which we term the common law. The standard set for the regulation of competition by the modern decisions evidences the high degree of ethical development of the modern judiciary. It is not to be expected that all of the decisions should reach the same altitude as the foremost. To say this, is merely to say that the judges who wrote the opinions were not of equal ability and learning. It is impossible that they should be. But on the whole, the body of cases with which we here deal, forms the most convincing proof which we have of the steady improvement of the morals of trade, and the gradual extinction of that "commercial cannibalism" of which Spencer wrote less than fifty years ago. It is doubtful whether jurisprudence has, during any corresponding period in the world's history, been of greater value to the advancement of civilization than it has in dealing with the subjects here considered, during the past half century.

It is a remarkable fact that in this department of the law which has, less than any other, been hampered by statutes and precedents, and which, more than any other, rests upon a foundation purely ethical, there should be found so great harmony between so many independent jurisdictions, English and American. Such legislation as has been effected in the United States has been desultory and comparatively ineffective. Its most admirable quality is its non-interference with common-law trademark rights.

In submitting this more comprehensive work to the profession, it is a subject of gratification to the author that his former book entitled "The Law of Unfair Trade" has been so generally accepted, and used as a working tool. The present work, it is hoped, will be found more adequate. The late cases have been exhaustively dealt with. The addition of the statutes and forms for registration employed in the several states and territories, and the Dominion of Canada, is intended

to facilitate the business of the practitioner, in registration and litigation outside of the state in which he resides. The forms of pleading have been added to from the best sources. The recently enacted federal trademark act, together with the rules and forms prescribed by the Commissioner of Patents for the registration of trademarks and patent office practice under the act, is reproduced in the appendix, while the acts of 1870 and 1881 have been preserved, with their annotations.

THE AUTHOR.

St. Louis, October 1, 1905.

CONTENTS

CHAPTER I.

PREFATORY.

SECTION.		PAGE.
1.	Primitive merchandise marks	1
2.	The need of legal restraint of unfair trade	2
3.	Trademark defined	4
4.	Tradename defined	10
5.	Earliest recognition of trademarks	15
6.	The evolution of the law of trademarks	16
7.	The relative protection given by patents and trademarks	16
8.	Trademarks distinguished from patents and copyrights	17
9.	Function	17
10.	Nature of the right to a trademark	18
11.	The test of exclusiveness	20
12.	Requisites of a valid trademark	20
13.	Perpetual existence	21
14.	Territorial limitation	21
15.	The necessity of user	25
16.	How trademark rights may be acquired	26
17.	Trademarks as subject of sale, assignment or bequest	27
18.	Assignability of distillery brands and the like	38
19.	Unfair competition	39
20.	Historical	40
21.	Property right as the basis of the action for unfair competition	45
22.	Unfair competition distinguished from trademark infringement	47
23.	Trade slander and libel	53
24.	Are trademark rights monopolistic in character?	56
25.	Title	57
26.	Licenses	59
27.	Trademarks as subjects of taxation	60

CHAPTER II.

THE ACQUISITION OF A TRADEMARK.

28.	Who may acquire	61
29.	User	63
30.	Affixing the mark	65
31.	Registration not a means of acquiring	65
32.	Acquisition by assignment	67
33.	Acquisition by an alien	68
34.	Priority of appropriation	69
35.	Acquisition of the right to use the name of another	73

CHAPTER III.

WHAT CONSTITUTES A VALID TRADEMARK.

SECTION.		PAGE.
36.	The general rule	75
37.	It must be truthful	75
38.	A dishonest label will invalidate	76
39.	The cases of false representation in connection with trademarks.	78
40.	Manhattan Medicine Co. v. Wood	80
41.	The similar cases—Assignment must be made public in conjunction with the trade mark, when	81
42.	Unauthorized use of words "patent" or "patented"	81
43.	Use of such word as a trademark where there has been a patent.	84
44.	The effect of expiration of the patent upon the collocation of color used in the patented article	87
45.	Names of patented articles	88
46.	Generic term, defined	93
47.	Illustrations of generic terms	98
48.	Examples of valid trademarks, fancy, arbitrary or distinctive words	114
49.	Generic terms judicially defined	132
50.	Marks common to the trade	134
51.	The name given an unpatented invention by the inventor	136
52.	Necessary name of a product	136
53.	The trademarked article not a trademark	139
54.	Packages as trademarks	140
55.	Pictures as trademarks	141
56.	Words as trademarks	141
57.	Method of arranging goods as trademark	142
58.	Words taken from the dead languages	143
59.	Words and phrases from modern foreign languages	143
60.	Words become generic through use	148
61.	The use of generic names protected	149
62.	"Distinctive names," under the Food and Drugs Act (June 30, 1906, Chap. 3915, 34 Stat. at L. 768	154
63.	Systems of licensing and inspection of goods mad from a basic ingredient bearing a trademark	155
64.	The test of "origin or ownership"	157
65.	Geographical names	159
66.	As employed by sole owner of a natural product and its place of production	160
67.	When geographical names will be protected as trademarks	160
68.	Geographical names—The underlying principle	161
69.	A false geographical name vitiates trademark	165
70.	The right to complain of unfair use of geographical name	166
71.	When relief will be granted against fraudulent use of geographical names	167
72.	Proper names as trademark	168

SECTION. PAGE.
73. "Secondary meaning" doctrine applied to proper names..... 169
74. Names of celebrities 170
75. In general, of one's own name 171
76. The use of proper names in trade..... 172
77. The proper name cases classified 174
78. Fictitious proper names 182
79. Revocation of license to use one's own name 182
80. Corporate names 183
81. Names of unincorporated associations 190
82. "Secondary meaning" defined 190
83. Words of double meaning 194
84. The mark's validity to be judged as of the date of its adoption.. 195

CHAPTER IV.

TRADEMARK RIGHTS IN TITLES OF BOOKS, PERIODICALS AND PLAYS.

85. Trademark in title of a book 196
86. Trademark in title of periodical 198
87. Play titles as trademarks 202
88. Infringement of book titles and play titles by motion picture titles. 204

CHAPTER V.

THE LOSS OF THE RIGHT TO A TRADEMARK'S USE.

89. Laches 206
90. Laches and acquiescence distinguished 208
91. Acquiescence 209
92. Caution notices to infringers as evidence of acquiescence..... 210
93. Abandonment 210

CHAPTER VI.

GOODWILL.

94. Defined 218
95. In particular cases 221
96. As a subject of sale 225
97. Goodwill subject to proceedings in eminent domain..... 229
98. Goodwill in its relation to firm and other names..... 229
99. Rights of vendor 230
100. Right of vendee to reassign 233
101. Covenants not to re-engage in business 233
102. The valuation of goodwill 238
103. Competition between vendor and vendee 239
104. Partnership goodwill 243
105. Remedies 245
106. Breach of covenant not to re-engage 247
107. Remedy as to infringement of tradenames identified with goodwill 252

CHAPTER VII.

TRADE SECRETS; RIGHT OF PRIVACY.

SECTION.		PAGE.
108.	Trade secrets—Introductory	253
109.	Protection in equity	255
110.	Trademarks on products of secret processes	265
111.	Actions and defenses	266
112.	The right of privacy	267

CHAPTER VIII.

INFRINGEMENT.

113.	Of infringement generally	279
114.	No trademark in form, size, material or color	280
115.	The early adjudications	283
116.	Infringement of color	284
117.	Infringement of size and form—Distinctive dress	287
118.	Intent and scienter	293
119.	What persons liable	295
120.	Of labels, generally	296
121.	Of packages, generally	297
122.	The engraver or manufacturer of the label	298
123.	Of counterfeiting trademarks	300
124.	Of imitation of trademarks	300
125.	Colorable imitation	300
126.	The test of probability of deception	301
127.	The degree of resemblance which constitutes infringement	302
128.	The degree of care expected of the purchaser	304
129.	Infringement must be by use on same class of goods	307
130.	The value of proof of fraudulent intent	310
131.	The manner of establishing fraudulent intent	311
132.	Infringing by refilling trademarked packages	313
133.	Packages distinguished from their contents	314
134.	Infringement by refitting and reselling worn trademarked articles	315
135.	Infringement by applying a manufacturer's trademark to goods of his to which he does not intend its application	315
136.	Substitution	317
137.	The use of misleading signs and circulars	319
138.	Infringement by a non-identical word or mark	321
139.	Patent office rulings on similarity of alleged conflicting marks	336
140.	Miscellaneous matters relating to infringement	336
141.	The use of letters and numerals	338
142.	The judicial test of infringement	342
143.	Restraint of use of misleading advertisements and the like	347
144.	Infringement in another jurisdiction	348
145.	Trademarks of variable sound and pronunciation	349

SECTION. PAGE.
146. The effect of a plurality of marks for a single article..... 350
147. Confusion of mail matter as test of the right to injunction..... 352
148. Hotel, restaurant and theater names and rights created thereby.. 354
149. Artistic productions as subjects of unfair competition 356
150. Trade rights in patentable but unpatented articles 357
151. "The right to imitate" 358
152. The use of machine manufacturer's name in sale of repair parts. 358
153. Solicitation of customers by former employee 359
154. Inciting breach of contract as unfair competition 363
155. Contracts relating to stock quotations 366
156. Appropriation of "blind" advertising as unfair competition.... 366
157. The appropriation of ideas, aside from patent, trademark or copyright, as unfair competition 368
158. Threats as unfair competition 372
159. Private actions for damages under the federal anti-trust acts... 375

CHAPTER IX.

REGISTRATION.

160. Introductory 378
161. The invalid registration acts 378
162. The power of congress to protect trademarks 379
163. The constitutionality of the present registration act..... 379
164. The advantages of registration 384
165. The disadvantages of registration 386
166. Interferences 388
167. Between a registrant and an applicant 388
168. The preliminary statement 389
169. The issues in interference, opposition and cancellation proceedings 389

CHAPTER X.

COURTS, PARTIES AND PROCEDURE.

170. Introductory 391
171. Jurisdiction of United States District Courts 391
172. Jurisdiction of the state courts 395
173. Jurisdiction of the Federal Trade Commission 396
174. The elements whereon jurisdiction must be predicated 398
175. The parties plaintiff 399
176. The parties defendant 402
177. Forms of action 405

CHAPTER XI.

THE CRIMINAL PROSECUTION—FEDERAL AND STATE.

178. The Act of 1876 407
179. Section 3449, Revised Statutes 408
180. Criminal liability at common law 410
181. The penal statutes of the several states 411

CHAPTER XII.

ACTIONS AT LAW.

SECTION.		PAGE.
182.	The form of action	412
183.	The declaration	413
184.	Defenses	417
185.	Damages	418

CHAPTER XIII.

THE ACTION IN EQUITY.

186.	The basis of equitable jurisdiction	424
187.	The bill in equity	426
188.	Presenting the defenses	432
189.	The answer	433
190.	Particulars	434
191.	Scandal and impertinence	435
192.	The defenses in equity	436
193.	The relief in equity	451
194.	The decree in unfair competition cases as to the accounting	458
195.	Forbidding publication of the decree	460
196.	Restraining misrepresentations concerning the decree	460
197.	Punitive damages in equity	460
198.	Increase of damages in equity	461
199.	The defendant's credits upon accounting	461
200.	Label designing as a judicial function	462
201.	Appeals	464
202.	Certiorari	465

CHAPTER XIV.

MATTERS OF PRACTICE AND EVIDENCE.

203.	Matters of which courts will take judicial notice	467
204.	Expert and other evidence on the question of infringement	467
205.	Successive changes, approach to plaintiff's dress	470
206.	Exhibits	470
207.	Discovery	471
208.	Evidence of recognition by others of plaintiff's right to the mark	472
209.	Contempts	473
210.	Affidavits	476
211.	The taking of testimony	477
212.	Effect of former adjudication	488

CHAPTER XV.

COSTS.

213.	Generally	490
214.	Avoiding costs by submission	490
215.	Submission to avoid costs must be complete	492
216.	Costs refused successful defendant	492
217.	Miscellaneous matters	493

APPENDIX.

		PAGE.
A.	Trademark Act of July 8, 1870. Annotated	501
B.	Label Registration Act of June 18, 1874. Annotated. Patent Office Rules, and Form relative thereto	513
C.	Trademark Act of August 14, 1876. Annotated	528
D.	Trademark Act of March 3, 1881. Annotated	532
E.	Trademark Act of February 20, 1905. Annotated. Patent Office Rules, and Forms relative thereto	549
F.	Trademark statutes of the states and territories. Annotated. With forms for registration applications	620
G.	Canadian Trademark and Design Act, with rules and forms	831
H.	Bills of complaint and answers. Judicially approved	852
I.	Forms of injunction—Interlocutory and final decrees	901
J.	Classification of registered trademarks	907
K.	International Convention of March 20, 1883	909
L.	Trademark provision of an act incorporating the American National Red Cross	922
M.	Federal Trade Commission Act; rules of the commission	923
N.	False Stamping; Act of June 13, 1906, Ch. 3289, 34 Stat. L. 260	944

TABLE OF CASES

References are to pages.

A

A. Bauer & Co. v. Distillerie de la Liqueur Benedictine (56 C. C. A. 480), 116.

v. Order of Carthusian Monks (56 C. C. A. 484), 325.

Abbott v. Bakers & Confectioners Tea Assn. (W. N., 1871, p. 207), 301.

Abernethy v. Hutchinson (3 L. J. Ch. 214), 260.

Acker, Merrall & Condit Co. v. McGaw (144 Fed. Rep. 864), 233.

Acme Harvester Co. v. Craver (110 Ill. App. 413), 223.

Actiengesellschaft Vereinigte Ultramarin-Fabriken v. Amberg (48 C. C. A. 264), 443.

Adams v. Heisel (31 Fed. Rep. 279), 7, 142, 279, 334, 386, 508, 536, 538.

v. Tannage Pat. Co. (81 Fed. Rep. 179), 440.

Addington v. Cullinane (28 Mo. App. 238-241), 419.

Addley Bourne v. Swan & Edgar, Ltd. (20 R. P. C. 105, 120), 348.

Adee v. Peck Bros. & Co. (39 Fed. Rep. 209, 210), 8, 88, 149.

Adriance, Platt & Co v. National Harrow Co. (58 C. C. A. 163), 375.

Aetna Mill & Elec. Co. v. Kramer Milling Co. (82 Kan. 679), 174.

A. F. Pike Mfg. Co. v. Cleveland Stone Co. (35 Fed. Rep. 896), 167, 896.

A. G. Spalding & Bros. v. A. W. Gamage, Ltd. (32 R. P. C. 284), 23.

v. A. W. Gamage, Ltd. (31 R. P. C. 125, 139), 317.

v. A. W. Gamage, Ltd. (32 R. P. C. 273, 286), 347.

Ainsworth v. Walmsley (L. R. 1 Eq. 518), 114, 168, 307, 338, 341, 439, 443.

v. Walmesley (44 L. J. 555), 213.

Air-Brush Mfg. Co. v. Thayer (84 Fed. Rep. 640), 52, 308, 546.

A. J. Reach Co. v. Simmons Hdw. Co. (155 Mo. App. 412), 401.

Alaska Packers' Assn. v. Crooks & Co. (18 R. P. C. 135), 469.

v. Alaska Imp. Co. (60 Fed. Rep. 103), 30, 81, 417.

Albany Perforated Wrapping Paper Co. v. John Hoberg Co. (102 Fed. Rep. 157, 158), 352.

Albers Bros. Milling Co. v. Acme Mills Co. (170 Fed. Rep. 989), 101.

Albert v. Strange (2 DeG. & Sm. 652), 260.

Alden v. Gross (25 Mo. App. 123), 103, 471.

A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co. (201 U. S. 166), 139, 282.

v. Broderick & Bascom Rope Co. (36 App. D. C. 451), 570.

v. Broderick & Bascom Rope Co. (123 Fed. Rep. 149, 152), 545, 580.

v. Broderick & Bascom Rope Co. (134 Fed. Rep. 571), 99, 385.

References are to pages.

A. Leschen & Sons Rope Co. v. Fuller (134 C. C. A. 570), 139.
v. Macomber & Whyte Rope Co. (142 Fed. Rep. 289), 139.
Alexander v. Morse (14 R. I. 153), 329.
Alexander Pirie & Sons v. Goodall (L. R., 1891, 1 Ch. D. 35-41), 65.
Alff v. Radam (77 Tex. 530), 107.
Allen v. McCarthy (37 Minn. 347), 62, 509.
v. McKeen (1 Sumn. 276-314), 209.
v. Walton Wood & Metal Co. (178 Fed. Rep. 287), 178.
Allen B. Wrisley Co. v. Buck (95 Off. Gaz. 2483), 336.
v. Geo. E. Rouse Soap Co. (87 Fed. Rep. 589), 286, 290.
v. Iowa Soap Co. (104 Fed. Rep. 548), 108.
v. Iowa Soap Co. (59 C. C. A. 54), 108.
v. Iowa Soap Co. (122 Fed. Rep. 796), 48.
Allegheny Fertilizer Co. v. Woodside (Fed. Case No. 206), 98, 120, 143, 345.
Allegretti v. Allegretti Chocolate Cream Co. (177 Ill. 129), 28.
Allegretti Chocolate Cream Co. v. Keller (85 Fed. Rep. 643), 52, 176, 307.
Alpin v. Richards (20 R. P. C. 799), 331.
Aluminum Cooking Utensil Co. v. National Aluminum Works (226 Fed. Rep. 815, 817), 131, 302, 332.
American Book Co. v. Gates (85 Fed. Rep. 729-734), 54.
American Box Co. v. Crosman (57 Fed. Rep. 1021, 1029), 454.
American Brewing Co. v. Bienville Brewery (153 Fed. Rep. 615, 619), 99, 296.
v. St. Louis Brewing Co. (47 Mo. App. 14), 286, 320.
American Cereal Co. v. Eli Pettijohn Cereal Co. (2) (22 C. C. A. 236), 174, 451.
v. Eli Pettijohn Cereal Co. (72 Fed. Rep. 903), 166, 187.
American Clay Mfg. Co. v. American Clay Mfg. Co. (198 Pa. 189), 295.
American Coat Pad Co. v. Phoenix Pad Co. (113 Fed. Rep. 629), 52.
American Exchange National Bank v. First Natl. Bank (82 Fed. Rep. 961), 484.
American Fibre Chamois Co. v. De Lee (67 Fed. Rep. 329), 121, 443.
American Grocer Pub. Co. v. Grocer Pub. Co. (25 Hun, 398), 294, 344.
American Grocery Co. v. Sloan (68 Fed. Rep. 539), 126, 328.
American Law Book Co. v. Edward Thompson Co. (84 N. Y. Supp. 225), 364.
American Novelty & Mfg. Co. v. Manufacturing Electrical Novelty Co. (73 N. Y. Supp. 755), 320.
American Order of Scottish Clans v. Merrill (151 Mass. 558), 190.
American Solid Leather Button Co. v. Anthony (15 R. I. 338), 339, 508.
American Stay Co. v. Delaney (211 Mass. 229), 257.
American Stove Co. v. Detroit Stove Works (31 App. D. C. 304), 123.

References are to pages.

American Tin Plate Co. v. Licking Roller Mill Co. (158 Fed. Rep. 690), 450.

American Tobacco Co. v. Globe Tobacco Co. (193 Fed. Rep. 1015), 113.

v. Guest (9 R. P. C. 218), 438, 493.

v. Polnesek (170 Fed. Rep. 117, 120), 8, 131.

American Waltham Watch Co. v. Sandman (96 Fed. Rep. 330), 161.

v. United States Watch Co. (173 Mass. 85), 10, 161, 193.

American Washboard Co. v. Saginaw Mfg. Co. (103 Fed. Rep. 281), 45, 64, 98.

American Wine Co. v. Kohlman (158 Fed. Rep. 830), 98.

Amoskeag Mfg. Co. v. Garner (2) (54 How. Pr. 298), 439, 493.

v. Garner (55 Barb. 151), 148, 213, 293, 308, 537.

v. Spear (2 Sand. S. C. 599), 132, 158, 209.

v. Trainer (101 U. S. 51, 56), 4, 5, 7, 77, 98, 157, 340, 341, 342.

Anargyros v. Egyptian Amasis Cigarette Co. (66 N. Y. Supp. 626), 326.

Anargyros & Co. v. Anargyros (167 Fed. Rep. 753, 769), 452.

Anderson v. Liebig's Extract of Meat Co. (45 L. T. N. S. 757-758), 54, 106.

v. Rowland (18 Tex. Civ. App. 460), 251.

Andrew Jergens Co. v. Woodbury (133 O. G. 513), 567.

Andrew McLean Co. v. Adams Mfg. Co. (31 App. D. C. 509), 131, 569.

Angle v. Chicago, etc., Railway Co. (151 U. S. 1), 364.

Angier v. Webber (92 Am. Dec. 754), 247.

v. Webber (14 Allen, 211), 240.

Anglo-Swiss Condensed Milk Co. v. Metcalf (L. R. 31 Ch. D. 454), 321.

Anheuser-Busch Brewing Assn. v. Clarke (26 Fed. Rep. 410), 286, 296, 337.

v. Pisa (23 Blatchf. 245), 159.

v. Piza (24 Fed. Rep. 149-151), 167, 307, 337.

v. Yuengling & Son (129 O. G. 3501), 573.

Anheuser-Busch Brewing Co. v. Fred Miller Brewing Co. (87 Fed. Rep. 864), 52, 152, 168.

Ansell v. Gaubert (Seton (4th Ed.) 235), 256.

Apollinaris Brunnen v. Somborn (14 Blatchf. 380), 324.

Apollinaris Co. v. Brumler (Manual, 429), 290.

v. Herrfeldt (4 P. R. 478), 115, 324.

v. Moore (Cox, Manual, Case No. 675), 115.

v. Norrish (33 L. T. N. S. 242), 61, 115.

Apollinaris Co. (Ltd.) v. Scherer (23 Blatchf. 459), 115, 402.

Apollo Bros. v. Perkins (207 Fed. 530), 367.

Appeal of the Putnam Nail Co. (Cox, Manual, No. 725), 490.

Applebee v. Skiwanek (140 N. Y. S. 450), 257.

Armington v. Palmer (21 R. I. 109), 14, 15, 184.

Armistead v. Blackwell (1 Off. Gaz. 603), 32, 120, 507, 512.

v. Kleinhaus (82 Ky. 303), 37, 213, 401.

References are to pages.

Armstrong v. Bitner (71 Md. 118-127), 222, 243.
Armstrong & Co. v. Savannah Soap Works (53 Fed. Rep. 124), 403.
Armstrong Seatag Oyster Co v. Smiths' Island Oyster Co. (139 C. C. A. 656), 283, 370.
Arthur v. Howard (19 Pa. Co. Ct. 81), 123.
Arundell v. Bell (52 L. J. Ch. 537), 224.
Asbestone Co. v. Philip Carey Mfg. Co. (41 App. D. C. 507), 566.
Asbestos & Asbetic Co. v. Wm. Schter Co. (18 Rap. Jud. Que. C. S. 360), 99.
Ashley v. Dixon (48 N. Y. 430), 365.
A. Stein & Co. v. Liberty Garter Co. (198 Fed. Rep. 959), 127.
Astor v. West 82d Str. Realty Co. (152 N. Y. S. 631), 356, 367.
Atkins v. Moore (142 O. G. 571), 574.
Atkinson v. Atkinson (85 L. T. Jour. 229), 404, 443.
v. John E. Doherty & Co. (121 Mich. 372), 273.
Atlanta v. Chattanooga Foundry & Pipeworks (127 Fed. Rep. 23), 376.
Atlantic Milling Co. v. Robinson (20 Fed. Rep. 217), 27, 37, 61, 117, 212, 401.
v. Rowland (27 Fed. Rep. 24), 456.
Atlas Assurance Co. v. Atlas Insurance Co. (112 N. W. Rep. 232), 22, 115.
Atlas Mfg. Co. v. Street & Smith (122 C. C. A. 568), 205.
Atwater v. Castner (32 C. C. A. 77), 109.
Aubin v. Holt (2 K. & J. 66), 225.
Auerbach & Sons v. Hall & Hayward Co. (111 O. G. 866), 389.
Ault & Wyborg Co. v. Cheshire (191 Fed. Rep. 741), 108.
Austen v. Boys (2 DeGex & Jones, 626-636), 223.
Automatic Recording Safe Co. v. Bankers' Reg. Safe Co. (224 Fed. Rep. 506, 511), 96, 130.
Avery v. Meikle (81 Ky. 73, 91), 6, 318, 341, 424.
v. Wilson (20 Fed. Rep. 856-859), 449, 495.
Avenarius v. Kornely (121 N. W. Rep. 336), 117.
v. Kornely (139 Wis. 247), 90.
Ayer v. Hall (3 Brewst. 509), 241.
v. Rushton (7 Daly, 9), 100.

B

Babbitt v. Brown (68 Hun, 515), 13, 335.
Bachelder & Co. v. Bachelder (220 Mass. 173), 232.
Backus v. Taylor (84 Ind. 503), 245.
B. A. Corbin & Son v. Miller, Kohlhepp, Griese & Co. (98 Off. Gaz. 1485), 390.
Bagby & Rivers Co. v. Rivers (87 Md. 400), 233, 234, 244.
Bagley v. Peddie (16 N. Y. 469), 246.
Baglin v. Cusenier Co. (156 Fed. Rep. 1016), 69.
v. Cusenier Co. (72 C. C. A. 555), 452.
v. Cusenier Co. (221 U. S. 580), 118.
Bailly v. Nashawannuck Mfg. Co. (51 Off. Gaz. 970), 123.
Bain v. Munro (15 Scot. L. Rep. 260), 224.
Baker v. Baker (53 C. C. A. 157), 187.
v. Sanders (97 Fed. Rep. 948), 176.

References are to pages.

Baker & Co. v. Baker (77 Fed. Rep. 181), 166, 176, 177, 320.
Baking Powder Co. v. Fyfe (45 Fed. Rep. 799), 150.
Baldwin v. Grier Bros. Co. (215 Fed. Rep. 735, 737), 293, 369.
v. Von Micheroux (25 N. Y. Supp. 857), 28, 38, 263, 401.
Ball v. Best (135 Fed. Rep. 434, 437), 23, 353.
v. Broadway Bazaar (87 N. E. Rep. 674), 116.
v. Siegel (116 Ill. 137-146), 104, 279, 301, 306, 508.
Ball & Socket Fastener Co. v. Cohn (90 Fed. Rep. 664), 430.
Baltimore Life Ins. Co. v. Gleisner (202 Pa. 386), 56.
Bamfort v. Douglass Post Card & Machine Co. (158 Fed. Rep. 355, 357), 140, 357, 372.
Banks v. Gibson (34 Bevan, 566), 11, 29, 31, 32, 222.
Banzhaf v. Chase (150 Cal. 180), 52.
Barber v. Connecticut Mutual Life Ins. Co. (15 Fed. Rep. 312, 313), 219.
Barclay v. Carter Med. Co. (41 App. D. C. 240), 567.
Barlow v. Johnson (7 R. P. C. 395), 127, 152, 323, 344.
Barnes v. Pierce (164 Fed. Rep. 213), 115, 318.
Barnett v. Leuchars (13 L. T. N. S. 495), 313.
Barrett v. Goom (74 L. T. Jour. 388), 337, 443.
Barrett Chem. Co. v. Stern (176 N. Y. 27), 95, 128.
Barrows v. Knight (6 R. I. 434, 438), 128, 170, 424.
v. Pelsall (Seb. 530), 340.
Barry v. Edmunds (116 U. S. 550, 562), 421.
Barstow Stove Co. v. Detroit Stove Works (31 App. D. C. 304), 123.
Basket Stores v. Allen (Neb.) (155 N. W. Rep. 893), 309.
Bass v. Dawber (19 L. T. N. S. 626), 490.
v. Guggenheimer (69 Fed. Rep. 271), 438, 491.
v. Henry Zeltner Brewing Co. (87 Fed. Rep. 468), 310.
v. Henry Zeltner Brew. Co. (37 C. C. A. 355), 310.
Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan (96 Fed. Rep. 206-211), 19, 308, 333, 337, 441, 442.
Bassett v. Percival (87 Mass. (5 Allen), 345-347), 231.
Batcheller v. Thomson (35 C. C. A. 532), 90.
v. Thomson (86 Fed. Rep. 630), 31, 37, 241.
Bateman v. Fargason (4 Fed. Rep. 32, 33), 445.
Bates Mfg. Co. v. Bates Mach. Co. (141 Fed. Rep. 213), 315.
v. Bates Numbering Machine Co. (172 Fed. Rep. 892), 115.
v. Bates Numbering Mach. Co. (172 Fed. Rep. 892), 188.
Bates Numbering Mach. Co. v. Bates Mfg. Co. (178 Fed. Rep. 681), 188.
Battersby v. Collier (54 N. Y. Supp. 363), 55.
Battershell v. Bauer (91 Ill. App. 181), 242.
Battle v. Finlay (1), (45 Fed. Rep. 796), 117, 138.
v. Finlay (2), (50 Fed. Rep. 106), 19, 117, 392, 442.
Battle Creek Sanitarium Co. v. Fuller (30 App. D. C. 411), 562, 564, 567, 569, 570.
Batty v. Hill (1 H. & M. 264), 109.

References are to pages.

B. B. Hill Co. v. Sawyer-Boss Mfg Co. (112 Fed. Rep. 144), 89.
Beadleston & Woerz v. Cooke Brewing Co. (20 C. C. A. 405), 8, 105, 195.
Beakin v. Stanton (3 Fed. Rep. 435), 454.
Beal v. Chase (31 Mich. 490), 242.
Beard v. Dennis (6 Ind. 200), 247.
v. Turner (13 L. T. N. S. 746), 143, 209, 337.
Beddall v. Maitland (17 C. D. 181), 434.
Beebe v. Tolerton & Stetson Co. (117 Iowa, 593), 62.
Beecham v. Jacobs (159 Fed. Rep. 129), 82, 446.
Bein v. Heath (12 How. 168), 454.
Bell v. Ellis (33 Cal. 620-625), 219.
v. Locke (8 Paige, 75), 41, 126, 199, 202.
Bell & Bogart Soap Co. v. Petrolia Mfg. Co. (54 N. Y. Supp. 663-666), 261, 262.
Benbow v. Low (L. R. 16 Ch. D. 93), 472.
Bender v. Enterprise Mfg. Co. (84 C. C. A. 353), 315.
Benedictus v. Sullivan (12 R. P. C. 25), 326.
Benjamin Moore & Co. v. Auwell (158 Fed. Rep. 462), 453.
Benkert v. Feder (34 Fed. Rep. 534), 429, 455, 456, 893, 901.
Bennett v. McKinley (65 Fed. Rep. 505), 96, 105, 193, 194.
v. White (W. N., 1910, p. 167), 434.
Benton v. Ward (59 Fed. Rep. 411-413), 261.
Bergamini v. Bastien (35 La. Ann. 60), 231.
Berliner Brauerei Gesellschaft v. Knight (W. N., 1883, p. 70), 130.
Bernstein v. Danwitz (190 Fed. Rep. 604), 581.
Bickmore Gall Cure Co. v. Karns (134 Fed. Rep. 833), 51.
v. Karns Mfg. Co. (126 Fed. Rep. 573), 469.
Bigbie Bros. & Co. v. Bluthenthal & Bickart (126 O. G. 1063), 573.
Billiken Co. v. Baker & Bennet Co. (174 Fed. Rep. 829), 116, 449.
Bingham School v. Gray (122 N. Car. 699), 175.
Bininger v. Clark (60 Barb. 113), 244.
Binninger v. Wattles (28 How. Pr. 206), 108, 174.
Binns v. Vitagraph Co. (132 N. Y. S. 237), 278.
Birmingham Vinegar Brewery Co. v. Powell (L. R., 1897, A. C. 710), 266.
Bischoffscheim v. Baltzer (10 Fed. Rep. 1), 485.
Bissell Chilled Plow Works v. T. M. Bissell Plow Co. (121 Fed. Rep. 357, 364), 20.
Black v. Allen (42 Fed. Rep. 618, 623), 430.
Black v. Ehrich (44 Fed. Rep. 794), 102, 197, 205.
Blacklock v. U. S. (208 U. S. 75), 410.
Blackwell v. Armistead (Fed. Case No. 1474), 57, 120.
v. Armistead (3 Hughes, 163), 326.
v. Crabb (36 L. J. Ch. 504), 337.
v. Dibrell (Fed. Case No. 1475), 164, 210.
v. Dibrell (14 Off. Gaz. 633), 120.
v. Wright (73 N. C. 310), 102, 120, 305.
Blackwell & Co. v. Dibrell & Co. (3 Hughes, 151), 160.
Blakey v. Latham (85 L. T. (Journal), 47), 86.

References are to pages.

Blanchard v. Hill (2 Atk. 484), 16, 40.
Blanchard Co. v. Simon (51 S. E. Rep. 222), 74.
Blease v. Garlington (92 U. S. 1), 478, 479.
Block v. Standard Distilling & Distributing Co. (95 Fed. Rep. 978), 52, 430.
Bloete v. Simon (19 Abb. N. C. 88), 62, 509.
Blofield v. Payne (4 B. & Ad. 410), 338, 412, 422, 442.
Blogg v. Anderson (N. S. W. 21 L. R. Eq. 238), 217.
Bloss v. Bloomer (23 Barb. 604), 418.
Bluthenthal v. Mohlmann (48 Fla. 321), 329.
Boardman v. Meriden Britannia Co. (35 Conn. 402), 339, 341, 442.
Board of Trade v. L. A. Kinsey Co. (130 Fed. Rep. 507, 513), 366.
Bodega Co. (Ltd.) v. Owens (23 L. R. Ir. 371), 418.
Boessneck v. Iselin (82 N. Y. Supp. 164), 334.
Boggs v. Friend (W. Va.) (87 S. E. Rep. 873), 247.
Bolander v. Peterson (136 Ill. 215), 112.
Bolen & Byrne Mfg. Co. v. Jonasch (60 N. Y. Supp. 555), 312.
Bond v. Milbourn (20 W. R. 197), 29.
Bondier v. Depatie (3 Dorion, 233), 340.
Bonnie & Co. v. Bonnie Bros. (Ky.) (169 S. W. Rep. 871), 116.
Boon v. Moss (70 N. Y. 465), 226.
Boord v. Huddart (21 R. P. C. 149), 135.
Boord & Son v. Thom & Cameron, Ld. (24 R. P. C. 697, at pages 720, 721), 73.
Boosing v. Dorman (133 N. Y. S. 910), 360.
Booth v. Jarrett (52 How. Pr. 169), 180, 212.
Borden Ice Cream Co. v. Borden Condensed Milk Co. (201 Fed. 510), 367.
Borthwick v. Evening Post (L. R. 37 Ch. D. 449), 202.
Boston Diatite Co. v. Florence Mfg Co. (114 Mass. 69), 19, 273, 294.
Boston El. Ry. Co. v. Grace & Hyde Co. (50 C. C. A. 329), 414.
Bourlier v. Macauley (91 Ky. 135), 365.
Bourne v. Swan & Edgar (1903) (1 Ch. 211), 469.
Boutelle v. Smith (116 Mass. 111), 242.
Bowden v. Randolph Tp. (41 N. J. Law, 462), 736.
Bowman v. Floyd (85 Mass. 76), 11.
Boynton v. Shaw Stocking Co. (146 Mass. 219), 55.
Boyson v. Thorn (98 Cal. 578), 365.
Bozon v. Farlow (1 Mer. 459), 224.
Bradbury v. Barden (35 Conn. 577), 225.
v. Beeton (39 L. J. Ch. 57), 202.
v. Dickens (27 Beav. 53), 32.
Bradford v. Belknap Co. (105 Fed. Rep. 63, 66), 454.
v. Peckham (9 R. I. 250-253), 231, 239.
Bradley v. Norton (33 Conn. 157), 118.
Braham v. Beachim (7 Ch. D. 848), 61.
v. Bustard (1 H. & M. 447), 121, 143, 215, 301.
v. Bustard (9 L. T. N. S. 199), 279.

References are to pages.

Brandreth v. Lance (8 Paige), 273.
Brant v. Froelich (49 N. J. Law, 336), 736.
Brass & Iron Works v. Payne (50 Ohio St. 115), 240, 244.
Braun & Co. v. Blackwell (19 Off. Gaz. 481), 511.
Breeding v. Tandy (148 Ky. 345), 249.
Breitenbach & Strong Co. v. Rosenberg (167 O. G. 763), 559.
Brennan v. Emery-Bird-Thayer Dry Goods Co. (99 Fed. Rep. 971), 111, 448.
v. Emery-Bird-Thayer Dry Goods Co. (47 C. C. A. 532), 191.
Brewer v. Lamar (69 Ga. 656), 179.
Brill v. Singer Manufacturing Co. (41 Ohio St. 127), 89, 279, 290, 508.
Bristol v. Equitable Life Assurance Society (132 N. Y. 264), 261.
Broadhurst v. Barlow (W. N., 1872, p. 212), 147, 339, 341.
Broderick & Bascom Rope Co. v. A. Leschen & Sons Rope Co. (100 Off. Gaz. 3011), 389.
Bronk v. Scott Co. (211 Fed. Rep. 338), 488.
Brooklyn White Lead Co. v. Masury (25 Barb. 416), 159
Brower v. Boulton (1), (53 Fed. Rep. 389), 26, 66, 70, 385, 536.
v. Boulton (2), (7 C. C. A. 567), 26, 66, 545.
Brown v. Benzinger (118 Md. 29), 232.
v. Braunstein (83 N. Y. Supp. 1096), 320, 449.
v. Doscher (147 N. Y. 647), 52, 279.
v. Mercer (37 N. Y. Super. Ct. 265), 755.
Brown Chemical Co. v. Meyer (31 Fed. Rep. 453), 152, 222.
v. Meyer (55 Off. Gaz. 287), 177.
v. Meyer (139 U. S. 540), 29, 105, 172, 174, 175, 896.
v. Stearns (37 Fed. Rep. 36), 105.
Browne v. Freeman (1), (12 W. R. 305), 100, 148, 212, 489.
v. Freeman (2), W. N., 1873, p. 178), 53, 100, 148.
Bryson v. Whitehead (1 S. & S. 74), 223, 256.
Buck's Stove & Range Co. v. Kiechle (76 Fed. Rep. 758), 285.
Bucklnud v. Rice (40 Ohio St. 526), 79.
Bucyrus Co. v. McArthur (219 Fed. Rep. 266), 432.
Buerk v. Imhaeuser (Fed. Case No. 2107*a*), 476.
Buffalo Rubber Mfg. Co. v. Batavia Rubber Co. (153 N. Y. S. 779), 110, 565.
Buffalo Specialty Co. v. Van Cleef (227 Fed. Rep. 391), 90.
v. Van Cleef (217 Fed. Rep. 91), 434.
Bulena v. Newman (31 N. Y. Supp. 449), 62, 755.
Bulloch, Lade & Co. v. Gray (19 Jour. Juris. 218), 106, 159.
Bullock v. Chapman (2 DeG. & Sm. 211), 53.
Bulte v. Igleheart Bros. (137 Fed. Rep. 492), 113, 136.
v. Ingleheart Bros. (70 C. C. A. 76), 29.
Bunker v. Stevens (26 Fed. Rep. 245-249), 490.
Burckhardt v. Burckhardt (42 Ohio St. 474), 249, 252.
v. Burckhardt (36 Ohio St. 261), 246, 250.
Burfield v. Rouch (31 Beavan, 241), 227.

References are to pages

Burgess v. Burgess (17 Eng. L. & Eq. 257), 159.
v. Burgess (3 DeG. M. & G. 806), 171, 172, 174, 177.
v. Hately (26 Beav. 249), 443, 490, 492.
v. Hills (26 Beavan, 244), 294, 324, 490, 491, 492.
Burke v. Cassin (45 Cal. 467), 110, 637.
Burkhardt v. Burkhardt Co. (4 Ohio N. P. 358), 28, 31, 36.
Burland v. Broxburn Oil Co. (6 R. P. C. 482, 489), 135.
Burnett v. Hahn (88 Fed. Rep. 694), 430, 448, 449.
v. Lenchars (13 L. T. N. S. 495), 491.
v. Phalon (1), (21 How. Pr. 100), 457.
v. Phalon (3 Keyes, 594), 118, 137.
v. Phalon (9 Bos. 192), 325.
Burrow v. Marceau (109 N. Y. St. 105), 128.
Burrowes v. Carrom-Archarena Co. (190 Fed. Rep. 204), 292.
Burt v. Smith (71 Fed. Rep. 161), 286, 290, 334, 342, 393.
v. Tucker (178 Mass. 493), 70, 124, 211, 213.
Burton v. Stratton (12 Fed. Rep. 696), 28, 79, 88, 131, 134, 149, 150, 191, 214, 342.
Burton Med. Co. v. United Drug Co. (179 O. G. 288), 568.
Busch v. Gross (71 N. J. Eq. 805), 355.
Bush v. Gross (N. J. Ch.), (64 Atl. Rep. 754), 125.
Bussard v. Catalino (2 Cranch C. C. 421), 485.
Butler v. Alter (139 N. Y. S. 882), 249.
v. Burleson (16 Vt. 176), 225.
v. Fayerweather (91 Fed. Rep. 458), 474, 476.
v. State (56 S. E. Rep. 1000), 661.
Bury v. Bedford (4 DeG. J. & S. 352), 31, 34, 36.
Buzby v. Davis (150 Fed. Rep. 275), 124.
v. Davis (80 C. C. A. 163), 94.
Byam v. Bullard (1 Curt. 100), 469.
Byass v. Sullivan (21 How. Pr. 50), 472.
Byron v. Johnston (2 Mer. 29), 50.

C

Cady v. Schultz (19 R. I. 193), 5, 113, 320.
Caffarelli Bros. v. Western Grocer Co. (127 S. W. Rep. 1018), 119.
Cahn v. Gottschalk (2 N. Y. Supp. 13), 107, 168, 328.
v. Hoffman House (28 N. Y. Supp. 388), 107.
California Fig Syrup Co. v. Improved Fig Syrup Co. (61 Off. Gaz. 155), 403.
v. Improved Fig Syrup Co. (51 Fed. Rep. 296), 100, 150.
v. Putnam (16 C. C. A. 376), 100.
v. Putnam (66 Fed. Rep. 750), 100, 150.
v. Worden (86 Fed. Rep. 212), 100, 150.
v. Worden (2), (95 Fed. Rep. 132), 78, 150.
California Fruit Canners Assn. v. Foster, Caldarera & Co. (C. D., 1911, p. 11), 573.
v. Myer (104 Fed. Rep. 82), 162, 166.
v. Radcliff-Sanders Grocer Co. (C. D., 1909, p. 160), 572.

References are to pages.

California Syrup of Figs Co. v. Stearns (1), (67 Fed. Rep. 1008), 79, 100, 150.
v. Stearns (2), (73 Fed. Rep. 812), 79.
Campbell Printing Press Co. v. Manhattan R. Co. (49 Fed. Rep. 930-932), 454.
Canady v. Knox (43 Wash. 567), 248.
Canal Co. v. Clark (13 Wall. 311-322), 94, 132.
94, 132.
Candee v. Deere (54 Ill. App. 439), 107, 159, 172, 281, 350.
Canham v. Jones (2 V. & B. 218), 253.
Cantrell & Cochrane v. Butler (124 Fed. Rep. 290), 304.
Cantrell & Cochrane, Ltd. v. Wittemann (109 Fed. Rep. 82), 298, 452.
Capewell Horse Nail Co. v. Mooney (167 Fed. 575), 293, 563.
v. Mooney (172 Fed. 826), 293.
v. Putnam Nail Co. (140 Fed. Rep. 670), 292.
Car Advertising Co. v. New York City Car Advertising Co. (107 N. Y. S. 547), 100.
Carbolic Soap Co. v. Thompson (25 Fed. Rep. 625), 101, 286, 404.
Carey v. New Home Sewing Machine Co. (101 Off. Gaz. 448), 389.
Carmel Wine Co. v. Palestine Hebrew Wine Co. (161 Fed. Rep. 654), 453, 470, 488.
Carmichael v. Latimer (11 R. I. 395), 30, 159, 174, 213, 401.
Carnrick v. Morson (L. J. N. of C. (1877), p. 71), 328.
Carrington v. Libby (14 Blatchf. 128), 508.
Carroll v. Duluth Superior Mill. Co. (232 Fed. Rep. 675, 681), 367.
v. Etheiler (1 Fed. Rep. 688), 125, 308, 439, 442, 444.
Carson v. Ury (39 Fed. Rep. 777), 47, 63, 299, 867.
Carter Med. Co. v. Barclay (36 App. D. C. 123), 570.
Cartier v. Carlile (31 Beavan, 292), 294, 340, 342.
v. May (Seb. 200), 340.
v. May (Cox, Manual, No. 200), 475.
v. Westhead (Seb. 199), 340.
Caruncho v. Stephenson (25 Sol. J. 929), 144.
Carver v. Bowker (Seb. 581), 339.
v. Pinto Leite (L. R. 7 Ch. App. 90), 339, 405.
Case v. Murphey (31 App. D. C. 245), 120.
v. Quirk (136 Off. Gaz. 1531), 390.
Case Bros. v. Murphey & Co. (C. D., 1908, p. 196), 552.
Cassidy v. Metcalf (1 Mo. App. 593-601), 234, 241.
v. Metcalf (65 Mo. 519), 241.
Castle v. Siegfried (103 Cal. 71), 136, 637.
Castner v. Coffman (178 U. S. 168), 109.
Castroville Co-operative Creamery Co. v. Col (6 Cal. App. 533), 446.
Caswell v. Davis (58 N. Y. 223 233), 8, 103, 137, 138.
v. Hazard (121 N. Y. 484), 31.
Cauffman v. Schuler (123 Fed. Rep. 205), 307.
Cave v. Myers (Seton (4th Ed.) 238), 206, 311.
v. Myers (Seton (5th Ed.) 539), 85.

References are to pages.

Cavendish v. Graves (24 Beav. 163), 434.
Cellular Clothing Co. v. Maxton (L. R., 1899, A. C. 326), 13, 100, 152, 153, 473.
Celluloid Mfg. Co. v. Cellonite Mfg. Co. (32 Fed. Rep. 94), 117, 185, 187, 189, 214, 325, 439, 443, 451.
v. Read (47 Fed. Rep. 712), 117, 439, 468.
Centaur Co. v. Heinsfurter (84 Fed. Rep. 955), 89.
v. Hughes Bros. Mfg. Co. (91 Fed. Rep. 901), 89, 136, 151.
v. Hughes Bros. Mfg. Co. (34 C. C. A. 127), 100.
v. Killenberger (87 Fed. Rep. 725), 88, 151, 297, 444.
v. Link (62 N. J. Eq. 147), 91, 100.
v. Marshall (97 Fed. Rep. 785), 89.
v. Marshall (38 C. C. A. 413), 294.
v. Marshall (92 Fed. Rep. 605), 89.
v. Neathery (91 Fed. Rep. 891), 89, 136, 151.
v. Neathery (34 C. C. A. 118), 100.
v. Reinecke (34 C. C. A. 684), 89.
v. Robinson (91 Fed. Rep. 889), 78, 89, 100, 136, 151.
Central Transportation Co. v. Pullman's Palace Car Co. (139 U. S. 24), 253.
C. F. Simmons Med. Co. v. Mansfield Drug Co. (93 Tenn. 84), 294.
v. Simmons (81 Fed. Rep. 162), 52.
Chadron Opera House Co. v. Loomer (71 Nebr. 785), 356.
Chadwick v. Covell (151 Mass. 190), 28, 174.
Chalmers Knitting Co. v. Columbia Mesh Knitting Co. (160 Fed. Rep. 1013), 335.
Chambers v. Baldwin (91 Ky. 121), 365.
Champion Spark Plug Co. v. A. R. Mosler & Co. (233 Fed. Rep. 112, 115), 371, 460, 495.
Champlin v. Stoddart (30 Hun, 300-302), 253.
Chance v. Gulden (165 Fed. Rep. 624), 119, 333.
Chancellor of Oxford University v. Wilmore-Andrews Pub. Co. (101 Fed. Rep. 443), 127.
Channell Chem. Co. v. E. W. Hayden Co. (222 Fed. Rep. 162), 447.
Chapin-Sacks Mfg. Co. v. Hendler Creamery Co. (231 Fed. Rep. 550), 96, 136, 489.
Chapleau v. Laporte (16 Rap. Jud. Que. C. S. 189), 423.
Chappell v. Davidson (2 K. & J. 123), 302, 444, 490.
Charles E. Hires Co. v. Consumers' Co. (100 Fed. Rep. 809-813), 290, 312, 463, 465.
v. Consumers' Co. (41 C. C. A. 71), 279, 451.
v. Simpkins (179 Fed. Rep. 1012), 429.
v. Xepapas (180 Fed. Rep. 952), 317.
Charles R. De Bevoise Co. v. H. & W. Co. (60 Atl. Rep. 407), 100, 148.
Chas. Dennehy & Co. v. Robertson, Sanderson & Co. (32 App. D. C. 355), 107.
Chase v. Mays (121 Mass. 343), 532.
Chattanooga Foundry & Pipe Works v. Atlanta (203 U. S. 390), 376.

References are to pages.

Chattanooga Medicine Co. v. Thedford (1), 49 Fed. Rep. 949, 952), 35.
v. Thedford (2), 58 Fed. Rep. 347), 35.
v. Thedford (14 C. C. A. 101), 36.
Cheavin v. Walker (L. R. 5 Ch. D. 850), 84.
Cheese Cutter Co. v. Dunn (45 Ind. App. 20), 119.
Chemical Co. v. Meyer (139 U. S. 540), 193.
Chicago Board of Trade v. Christie Grain & Stock Co. (198 U. S. 236), 366.
Chicago Landlord's Protective Bureau v. Koebel (112 Ill. App. 21), 328.
Chickering v. Chickering & Sons (131 C. C. A. 538, 542), 169.
v. Chickering & Sons (120 Fed. Rep. 69), 177, 465.
Chissum v. Dewes (5 Russ. 29), 223.
Chittenden v. Witbeck (50 Mich. 401-421), 229.
Choynski v. Cohen (39 Cal. 501), 67, 98, 600, 637.
Christy v. Murphy (12 How. Pr. 77), 173, 180, 210.
Chubb v. Griffiths (35 Beav. 127), 441, 490.
Church v. Kresner (49 N. Y. Sup. 742), 312.
v. Proctor (66 Fed. Rep. 240-245), 76.
Church & Dwight Co. v. Russ (99 Fed. Rep. 276-278), 40, 51, 295, 310.
Churton v. Douglas (Johnson, 174-188), 28, 36, 181, 219, 230.
Cigarmakers' International Union of America v. Goldberg (57 Atl. Rep. 141), 62, 736.
Cigar Makers' Protective Union v. Lindner (3 Ohio St. Dec. 244), 62.
Cigar Makers' Union v. Conhaim (40 Minn. 726), 5, 62.
Citizens' Light, Heat & Power Co. v. Montgomery Light & Water Power Co. (171 Fed. Rep. 553), 364, 366.
City Brewery Co. v. Powell (L. R. (1897), App. Cas. 710, 716), 216.
City of Carlsbad v. Kutnow (68 Fed. Rep. 794), 160, 449, 473.
v. Kutnow (71 Fed. Rep. 167), 61, 164.
v. Schultz (78 Fed. Rep. 469), 61, 160, 164, 176, 462.
v. Thackeray (57 Fed. Rep. 18), 168.
v. Tibbetts (51 Fed. Rep. 852), 52.
Clark v. Aetna Iron Works (44 Ill. App. 510), 189.
v. Clark (25 Barb. 76), 174, 177.
v. Freeman (11 Beavan, 112), 53, 436.
v. Ins. Co. (7 Mo. App. 71), 29.
v. Leach (32 Beav. 14), 29.
Clark Thread Co. v. Armitage (21 C. C. A. 178), 179, 325.
v. Armitage (67 Fed. Rep. 896), 325.
v. Wm. Clark Co. (1), (55 N. J. Eq. 658), 448.
v. William Clark (2), (56 N. J. Eq. 739), 455.
Clay v. Kline (149 Fed. Rep. 912), 296.
Clayton v. Stone (2 Paine, 382-392), 200.
Clemens v. Belford (14 Fed. Rep. 728), 196, 201.
v. Belford (11 Biss. 459), 508.

References are to pages.

Clement v. Maddick (1 Giff. 98), 198, 444.
v. Maddick (5 Jur. N. S. 592), 202.

Cleveland Stone Co. v. Wallace (52 Fed. Rep. 431-439), 58, 286, 442.

Clinton E. Worden & Co. v. California Fig Syrup Co. (187 U. S. 516), 80, 150.
v. California Fig Syrup Co. (42 C. C. A. 383), 150.

Clinton Metallic Paint Co. v. New York Metallic Paint Co. (50 N. Y. Supp. 437), 107, 159, 412.

Clip Bar Mfg. Co. v. Steel Protected Concrete Co. (209 Fed. Rep. 874), 374.

Close v. Flesher (59 N. Y. State Rep. 283), 240.

Clotworthy v. Schepp (42 Fed. Rep. 62), 79, 109, 127, 334.

Coats v. Chadwick (L. R., 1894, 1 Ch. D. 347), 474.
v. Holbrook (2 Sandf. Ch. 586), 22, 68, 302, 404, 442, 443, 490, 492.
v. Merrick Thread Co. (149 U. S. 562), 172, 193, 342.
v. Merrick Thread Co. (36 Fed. Rep. 324), 89, 286, 301.
v. Platt (17 Leg. Int. 213), 174.

C. O. Burns Co. v. W. F. Burns Co. (118 Fed. Rep. 944), 207.

Coca-Cola Co. v. Branham (216 Fed. Rep. 264), 333.
v. Butler (229 Fed. Rep. 224, 232), 156, 938.
v. Deacon Brown Bottling Co. (200 Fed. Rep. 105), 564.
v. Gay-Ola Co. (200 Fed. Rep. 720), 287, 370.
v. Nashville Syrup Co. (200 Fed. Rep. 153), 564.

Coe v. Bradley (9 Off. Gaz. 541), 38.
v. Bradley (Fed. Case No. 2941), 325.

Cochrane v. MacNish & Son (13 R. P. C. 100), 447.
v. Macnish (P. C., L. R. 1896, A. C. 225), 118.

Cocks v. Chandlers (L. R. 11 Eq. 447), 151, 436.

Coffeen v. Brunton (4 McLean, 516), 68, 118, 421, 905.
v. Brunton (2), (5 McLean, 256), 305, 338, 442.

Coffman v. Castner (87 Fed. Rep. 457), 109.

Cohen v. Nagle (190 Mass. 4), 72, 217.
v. Nagle (73 N. E. Rep. 276), 124.

Cohn v. People (149 Ill. 486), 62, 668.

Cole v. Cole's Many-use Oil Co. (147 Fed. Rep. 930), 492.

Cole Co. v. American Cement & Oil Co. (65 C. C. A. 105), 294.

Coleman v. Flavel (40 Fed. Rep. 854), 347.

Coleman & Co., Ltd. v. Jno. Brown & Co. (16 R. P. C. 619), 334.

Colgan v. Danbeiser (35 Fed. Rep. 150), 112.

Colgate v. Adams (88 Fed. Rep. 899), 117, 325.
v. Compagnie Francaise (23 Fed. Rep. 82), 472.

Colley v. Hart (7 R. P. C. 101), 54.

Collier v. Jones (120 N. Y. St. 991), 122.

Collins v. Cowen (3 K. & J. 428), 68.

Collins v. Reynolds Card Mfg. Co. (7 Abb. N. C. 17), 332, 339.

References are to pages.

Collins Chemical Co. v. Capitol City Mfg. Co. (42 Fed. Rep. 64), 440, 467.
Collins Co. v. Ames (20 Blatchf. 542), 439.
v. Brown (3 K. & J. 423), 22, 68.
v. Cohen (3 K. & J. 428), 22.
v. Oliver Ames & Sons Corporation (18 Fed. Rep. 561-571), 308, 455.
v. Reeves (28 L. J. Ch. 56), 22, 68.
v. Walker (7 W. R. 222), 22, 68, 490, 492.
Collinsplatt v. Finlayson (88 Fed. Rep. 693), 161, 162, 283, 307, 344, 430.
Colloday v. Baird (4 Phila. 139), 139.
Colman v. Crump (70 N. Y. 573), 293, 298, 299, 306, 308, 443, 449.
Colton v. Thomas (2 Brewst. 308), 904.
Columbia Mill Co. v. Alcorn (150 U. S. 460), 64, 69, 157, 159, 163.
v. Alcorn (40 Fed. Rep. 676), 468.
Columbian Eng. Works v. Mallory (75 Or. 542), 315.
Com. v. K. D. & W. Co. (116 S. W. Rep. 76), 60.
Comer v. State (103 Ga. 69), 661.
Commercial Advertiser Assn. v. Haynes (49 N. Y. Supp. 938-942), 201, 202.
Commonwealth v. Anselvich (186 Mass. 376), 693.
v. Rozen (176 Mass. 129), 63, 693, 694.
Compagnie Laferme v. Hendrick (Seb. 512), 490.
Compania de Tobacos v. Rehder (5 R. P. C. 61), 305.
Compania General de Tobacos v. Rehder (5 R. P. C. 61), 301.
Computing Scale Co. v. Standard Computing Scale Co. (55 C. C. A. 459), 101, 191, 193.
Comstock v. White (18 How. Pr. 421), 123, 174, 253, 445.
Condy v. Mitchell (37 L. T. N. S. 268), 31, 34, 253.
Congress, etc., Spring Co. v. High Rock Congress Spring Co. (57 Barb. 526), 28, 119.
Congress & Empire Spring Co. v. High Rock Congress Spring Co. (45 N. Y. 291), 19, 61.
v. High Rock Congress Spring Co. (4 Am. L. T. 168), 160.
Connell v. Reed (128 Mass. 477), 79.
Conrad v. Brewing Co. (8 Mo. App. 277, 285), 422.
Consolidated Fruit Jar Co. v. Dorflinger (Fed. Case No. 3129), 82.
v. Thomas (Cox, 665), 206.
Consolidated Ice Co. v. Hygeia Distilled Water Co. (151 Fed. Rep. 10, 12), 51.
v. Hygeia Distilled Water Co. (80 C. C. A. 506), 22, 123, 450.
Consumers' Co. v. Hydrox Chem. Co. (182 O. G. 721), 567.
Continental Ins. Co. v. Board of Fire Underwriters (67 Fed. Rep. 310), 373.
v. Continental Fire Assn. (96 Fed. Rep. 846, 849), 101, 186, 352.
Continental Tobacco Co. v. Larus & Bro. Co. (66 C. C. A. 557), 284.
Cook & Bernheimer Co. v. Ross (73 Fed. Rep. 203), 287.

References are to pages.

Cook & Cobb Co. v. Miller (65 N. Y. Supp. 730), 103.
Cook v. Starkweather (13 Abb. Pr. N. S. 392), 442, 467, 508.
Cooper v. Hood (26 Beavan, 293), 28, 228.
Cope v. Evans (L. R. 18 Eq. 138), 144, 468.
Corbin v. E. Taussig & Co. (132 Fed. Rep. 662), 441.
v. Gould (133 U. S. 308), 112.
Corliss v. E. W. Walker Co. (57 Fed. Rep. 434), 273.
v. E. W. Walker Co. (64 Fed. Rep. 280-282), 259, 274.
Corning Glass Works v. Corning Cut Glass Co. (197 N. Y. 173), 367.
Corwin v. Daly (7 Bos. 222) 27, 101.
Cory v. Gerteken (2 Madd. 49), 490.
Costello v. Eddy (12 N. Y. Supp. 236), 222, 234.
v. Eddy (128 N. Y. 650), 231.
Cotton v. Gillard (44 L. J. Ch. 90), 26, 28, 31, 124, 265.
Cottrell v. Babcock Mfg. Co. (54 Conn. 138), 231, 232, 239.
Coulston v. Francke Steel Range Co. (221 Fed. Rep. 669), 434.
Counts v. Medley (163 Mo. App. 546), 231.
Covert v. Bernat (156 Mo. App. 687), 28.
Cowie Bros. & Co. v. Herbert (14 R. P. C. 436), 141.
Cravenette Co. v. Benjamin (105 Fed. Rep. 621), 294.
Craver's Sons v. Conklin & Sons (165 O. G. 241), 559.
Crawford v. Lans (60 N. Y. Supp. 387), 328.
Crawshay v. Thompson (4 Man. & G. 357), 293, 305, 340, 415.
Crescent Mfg. Co. v. Wilson (233 Fed. Rep. 282), 155.
Crocker-Wheeler Co. v. Bullock (134 Fed. Rep. 241, 245), 265.
Croft v. Day (7 Beavan, 84), 33, 42, 47, 171, 401.
v. Day (2), (Cox, Manual, No. 77), 475.
Cropper Minerva Machines Co. (Ltd.) v. Cropper, Charlton & Co. (23 R. P. C. 388, 394), 447.
Cross v. Howe (62 L. J. Ch. 342), 436.
Crowder v. Allen-West Commission Co. (213 Fed. Rep. 177), 469.
Cruess v. Fessler (39 Cal. 336), 250.
Cruttwell v. Lye (17 Ves. 335), 50, 219, 223.
Cuervo v. Jacob Henkell Co. (60 Off. Gaz. 440), 298.
v. Jacob Henkell Co. (50 Fed. Rep. 471), 443.
v. Landauer (63 Fed. Rep. 1003), 448.
v. Owl Cigar Co. (68 Fed. Rep. 541), 279, 303, 454.
Cullinan v. Dwight (100 N. Y. Supp. 896), 265.
Cumberland Glass Mfg. Co. v. DeWitt (120 Md. 381), 365.
Curtis v. Bryan (2 Daly, 212), 79 147.
v. Bryan (36 How. Pr. 33), 445.
v. Gokey (68 N. Y. 300), 223.
v. Pape (5 R. P. C. 146), 152.
v. Phelps (D. C.), (209 Fed. 261), 435.
Cushing v. Drew (97 Mass. 445), 248.
Cusimano & Co. v. Olive Oil Imp. Co. (38 So. Rep. 200), 324.

References are to pages.

Cutter v. Gudebrod Bros. Co. (2), (61 N. Y. Supp. 225), 35.
v. Gudebrod Bros. Co. (55 N. Y. Supp. 298), 338.

D

Dadirrian v. Gullian (79 Fed. Rep. 784), 475.
Dadirrian v. Yacubian (3), 98 Fed. Rep. 872), 147.
v. Yacubian (37 N. Y. Supp. 611), 146.
v. Yacubian (2), (90 Fed. Rep. 812), 107, 146.
v. Yacubian (72 Fed. Rep. 1010), 107, 146.
v. Yacubian (98 Fed. Rep. 872-876), 75.
Dakin v. Williams (17 Wendell, 447), 246.
Dale v. Smithson (12 Abb. Pr. 237), 182.
Daniel v. Whitehouse (15 R. P. C. 134), 217.
Daniel O'Donnell v. Riseal Mfg. Co. 228 Fed. Rep. 127, 130), 329, 406.
Dant v. Head (90 Ky. 255), 28.
Daugherty v. Van Nostrand (1 Hoff. Ch. (N. Y.) 68), 229.
Dausman & Drummond Tobacco Co. v. Ruffner (Fed. Case No. 3585), 281.
Davey v. Bentinck (1893), (1 Q. B. 185), 435.
v. Davey (50 N. Y. Supp. 161), 54.
David E. Foutz Co. v. S. A. Foutz Stock Food Co. (163 Fed. Rep. 408), 121, 188
Davids Co. v. Davids (233 U. S. 461, 471), 193, 563.
Davidson v. Munsey (29 Utah, 181), 477.
Davies v. Hodgson (25 Beavan, 177), 223, 239.
Davies County Distilling Co. v. Martinoni (117 Fed. Rep. 186), 106.
Davis v. A. Booth & Co. (65 C. C. A. 269), 238.
v. Davis (27 Fed. Rep. 490, 492), 7, 139, 142, 279, 281, 452, 508, 538.
v. Kendall (2 R. I. 566), 253, 300.
v. Kennedy (13 Grant. Up. Can. Ch. 523), 69, 127.
v. Stribolt (59 L. T. N. S. 854), 146, 144.
Dawes v. Davies (Seb. 426), 304.
Dawson v. Beeson (L. R. 24 Ch. D. 504), 244.
Day v. New England Car Spring Co. (3 Blatch. 154-159), 476.
v. Webster (49 N. Y. Supp. 314), 449.
v. Woodworth (54 U. S. (13 Howard), 363, 371), 416, 421.
Dayton v. Wilkes (17 How. Pr. 516), 221, 231.
Dean v. Emerson (102 Mass. 480), 222.
Decker v. Decker (52 How. Pr. 218), 174, 418, 502
Deering Harvester Co. v. Whitman & Barnes Mfg. Co. (86 Fed. Rep. 764), 18.
v. Whitman & Barnes Mfg. Co. (33 C. C. A. 558), 18, 157, 158, 315.
De Florez v. Raynolds (14 Blatchf. 505), 469.
Deister Concentrator Co. v. Deister Mach. Co. (Ind. App.). (112 N. E. Rep. 909), 175, 311.
Deitsch v. Geo. G. Gibson Co. (155 Fed. Rep. 383), 217, 385.
v. Loonen (141 Off. Gaz. 1161), 390.

References are to pages.

De Kuyper v. Witteman (23 Fed. Rep. 871), 298, 299, 430.
Delaware & Hudson Canal Co. v. Clark (13 Wall. 311), 94, 106, 134, 142, 157, 159, 164.
DeLong v. DeLong Hook & Eye Co. (74 Off. Gaz. 809), 177.
De Long Hook & Eye Co. v. Francis Hook & Eye Co. (118 Fed. Rep. 938), 281.
v. Francis Hook & Eye Co. (75 C. C. A. 484), 296.
v. Francis Hook & Eye Co. (2), (139 Fed. Rep. 146), 296.
v. Francis Hook & Eye Co. & F. Co. (168 Fed. Rep. 898), 458.
v. Francis Hook & Eye & Fastener Co. (159 Fed. Rep. 292), 457.
Del Valle v. Mayer (Seton (4th Ed.) 236), 405.
Dempsey v. Dobson (174 Pa. 122), 259.
Dence v. Brand (W. N., 1881, p. 31), 494.
v. Mason (41 L. T. N. S. 573), 29.
Dennison Mfg. Co. v. Thomas Mfg. Co. (94 Fed. Rep. 651-658), 340.
Dennison Mfg. Co. v. Scharff Tag, Label & Box Co. (68 C. C. A. 263), 338.
v. Thomas Mfg. Co. (94 Fed. Rep. 651, 659), 4, 18, 44, 114, 133, 158.
Dent v. Turpin (30 L. J. Ch. 495), 31, 48, 401.
Denver Chem. Co. v. Lilley (133 C. C. A. 73), 322.
Denver Railway v. Harris (122 U. S. 597, 609), 421.
Deposit Bank v. Frankfort (191 U. S. 510), 488.
Derby Dry Plate Co. v. Pollard (2 Times L. R. 276), 326.
Dering v. Earl of Winchelsea (1 Cox, Ch. 318, 319), 445.
Derringer v. Plate (29 Cal. 292), 5, 18, 22, 70, 119, 637.
De Sands v. N. Y. Herald (88 N. Y. App. Div. 492), 276.
Detroit v. Detroit City Ry. Co. (55 Fed. Rep. 569), 578.
Detroit Creamery Co. v. Velvet Brand Ice Cream Co. (Mich), (153 N. W. Rep. 664), 24.
Devlin v. Devlin (69 N. Y. 212), 177, 474, 494.
v. McLeod (135 Fed. Rep. 164), 51, 112.
DeVoe Snuff Co. v. Wolff (124 C. C. A. 302), 18, 295, 310, 364, 440, 454.
Dewitt v. Mathey (18 Ky. L. Rep. 257), 61, 213.
DeYoungs v. Jung (27 N. Y. Supp. 370), 312.
Diamond Crystal Salt Co. v. Worcester Salt Co. (137 C. C. A. 16, 17), 447.
Diamond Match Co. v. Roeber (106 N. Y. 473-484), 235.
v. Safe Harbor Match Co. (109 Fed. Rep. 154), 476.
v. Saginaw Match Co. (74 C. C. A. 59), 140, 282, 314, 370.
Dietz v. Horton Mfg. Co. (170 Fed. Rep. 865), 73, 103.
Dicks v. Yates (L. R. 18 Ch. D. 76-88), 201.
Dickson v. McMaster (18 Ir. Jur. 202), 29, 401.
Dittgen v. Racine Paper Goods Co (164 Fed. Rep. 85), 374.
Dixon Crucible Co. v. Benham (4 Fed. Rep. 527-530), 344.
v. Guggenheim (3 Am. L. T. 228), 79, 212.
v. Guggenheim (2 Brewster, 321), 26, 200.

References are to pages.

Dixon v. Fawcus (3 Ell. & Ell. 537), 291, 301, 494.
v. Jackson (2 Scot. L. Rep. 1884), 129.
Dobell v. Stevens (3 B. & C. 623), 250, 251.
Dobson v. Graham (49 Fed. Rep. 171), 254, 472.
Dodge Stationery Co. v. Dodge (145 Cal. 380), 176, 179.
Dodge Mfg. Co. v. Sewall & Day Cordage Co. (142 Fed. Rep. 288), 139.
Donnell v. Herring-Hall-Marvin Safe Co. (208 U. S. 267), 174.
Dornan v. Keefer (49 Fed. Rep. 462), 264.
Douglas v. Stokes (149 Ky. 506), 277.
Dover Stamping Co. v. Fellows (163 Mass. 191), 2, 89, 91, 290, 694.
Dow v. Electric Co. (69 N. H. 312), 250.
Dowling v. Livingstone (108 Mich. 321), 55.
Drake v. Dodsworth (4 Kansas 135), 230, 231.
Drake Hdw. Co. v. Wrought-Iron Range Co. (78 N. Y. Supp. 1114), 373.
Drake Medicine Co. v. Glessner (68 Ohio St. 337), 120, 168.
Draper v. Skerrett (94 Fed. Rep. 912), 52.
v. Skerrett (2), 116 Fed. Rep. 206, 208), 48, 103, 393.
Dr. A. Reed Cushion Shoe Co. v. Frew (162 Fed. Rep. 887, 889), 13, 181.
v. Frew (158 Fed. Rep. 552), 13.
Dr. Dadirrian & Sons Co. v. Hauenstein (74 N. Y. Supp. 709), 107.
Dr. David Kennedy Corp. v. Kennedy (55 N. Y. Supp. 917), 181.
Drevet Mfg. Co. v. Liquozone Co. (122 O. G. 3014), 568.
Drewry & Son v. Wood (127 Fed. Rep. 887), 328.
Dreydoppel v. Young (14 Phila. 226), 99, 134.
Dr. Peter H. Fahrney & Sons Co. v. Ruminer (82 C. C. A. 621), 207.
v. Ruminer (153 Fed. Rep. 735), 114.
Drummond Tobacco Co. v. Randle (114 Ill. 412), 174, 183.
v. Tinsley Tobacco Co. (52 Mo. App. 10, 26), 311, 398, 399, 467, 468.
Dr. Williams Med. Co. v. Alexander, Cape Good Hope (27 S. C. R. 589), 326.
v. Tothill, Cape Good Hope (20 S. C. R. 483), 326.
Du Boulay v. Du Boulay (L. R. 2 P. C. 430-441), 171.
Ducat v. Chicago (10 Wall. 410), 414.
Duden v. Maloy (63 Fed. Rep. 183), 245.
Duer v. Corbin Cabinet Lock Co. (149 U. S. 216, 223), 17.
Duke v. Cleaver (19 Tex. Civ. App. 218), 320.
v. Green (16 Off. Gaz. 1094), 504, 510, 538.
Dunbar v. Glenn (42 Wis. 118), 61, 116, 159.
Dunlap v. Schofield (152 U. S. 244, 248), 388.
v. Willbrandt Surgical Mfg. Co. (80 C. C. A. 575), 406.
Dunlap & Co. v. Young (74 N. Y. Supp. 184), 442.
Dunnachie v. Young & Sons (Ct. Sess. Cas. 4th Ser. X 874), 57.

References are to pages.

Du Pont-De Nemours Powder Co. v. Masland (216 Fed. Rep. 271), 266.
Duryea v. National Starch Mfg. Co. (25 C. C. A. 139), 175.
Duwel v. Bohmer (14 Off. Gaz. 270), 506.
Dwight v. Hamilton (113 Mass. 175), 225, 231, 241.
Dwinnell-Wright Co. v. Co-operative Supply Co. (148 Fed. Rep. 242), 131, 438.
Dyment v. Lewis (Iowa), (123 N. W. Rep. 244), 128.

E

Eagle White Lead Co. v. Pflugh (180 Fed. Rep. 579, 583), 449.
E. & J. Burke, Ltd. v. Bishop (75 C. C. A. 666), 207.
Earl of Lytton v. Devey (54 L. J. Ch. 293), 260.
Eastern Extracting Co. v. Greater New York Extracting Co. (110 N. Y. S. 738), 257.
Eastern Outfitting Co. v. Manheim (59 Wash. 428), 14.
Eastman Co. v. Reichenbach (20 N. Y. Supp. 110), 254, 256, 258.
E. B. Estes & Sons v. George Frost Co. (176 Fed. Rep. 338), 93, 131, 369.
Eckhart v. Consolidated Milling Co. (72 Ill. App. 70), 313.
Economist Furnace Co. v. Wrought-Iron Range Co. (86 Fed. Rep. 1010), 373.
Edelsten v. Edelston (9 Jur. N. S. 479), 301.
v. Edelston (10 L. T. N. S. 780), 462.
v. Edelsten (1 DeG. J. & S. 185), 115, 294, 301, 310, 338, 412, 415, 442, 490.
v. Vick (11 Hare, 78), 85.
Edison v. Edison Polyform Mfg. Co. (67 Atl. Rep. 392), 276.
v. Hawthorne (106 Fed. Rep. 172-174), 347.
v. Thomas A. Edison, Jr., Chemical Co. (128 Fed. Rep. 1013), 532.
Edison Mfg. Co. v. Gladstone (58 Atl. Rep. 391), 318.
Edmonds v. Benbow (Seton (3d Ed.) 905), 201.
v. Boston (108 Mass. 549), 229.
Edna Smelting & Refining Co. v. Nathan Mfg. Co. (30 App. D. C. 487), 126.
Edwards v. Dennis (30 Ch. D. 454), 63.
Egbert v. Citizens' Ins. Co. (7 Fed. Rep. 47), 485.
Eggers v. Hink (63 Cal. 445), 109, 158, 159, 600, 637.
E. H. Taylor & Sons Co. v. Taylor (85 S. W. Rep. 1085), 428, 457.
Einstein v. Sawhill (65 Off. Gaz. 1918), 66, 385, 395, 544.
v. Sawhill (2), (64 Off. Gaz. 1533), 539.
v. Sawhill (61 Off. Gaz. 287), 539.
Eisel v. Hays (141 Ind. 41), 252.
Eiseman v. Schiffer (157 Fed. Rep. 473), 69, 128, 575.
Eisenstadt Mfg. Co. v. J. M. Fisher Co. (232 Fed. Rep. 957), 370.
Elaterite Paint & Mfg. Co. v. S. E. Frost Co. (105 Minn. 239), 257.
Electric Renovator Mfg. Co. v. Vacuum Cleaner Co. (189 Fed. Rep. 754), 375.
Electro-Silicon Co. v. Levy (59 How. Pr. 469), 326.
v. Hazard (29 Hun. 369), 120, 138.
v. Trask (59 How. Pr. 189), 138, 326.

References are to pages.

Electro Steel Co. v. Lindenberg Steel Co. (43 App. D. C. 270), 102
Elgin Butter Co. v. Elgin Creamery Co. (155 Ill. 127), 188.
v. Sands (155 Ill. 127), 668.
Elgin National Watch Co. v. Illinois Watch Case Co. (2), (179 U. S. 665), 8, 9, 165, 193, 294, 380, 532, 545.
v. Illinois Watch Co. (1), (89 Fed. Rep. 487), 165, 312.
v. Loveland (132 Fed. Rep. 41, 47), 193.
Elliott Machine Co. v. Center (227 Fed. Rep. 124), 938.
Elliott Varnish Co. v. Sears, Roebuck & Co. (221 Fed. Rep. 797), 96, 128, 330, 334.
Ellis v. Zeilen (42 Ga. 91), 445.
El Modello Cigar Co. v. Gato (25 Fla. 886, 915), 422, 429.
Emack v. Kane (34 Fed. Rep. 44), 374.
E. McIlhenny's Sons v. New Iberia Co. (133 Off. Gaz. 995), 390.
v. New Iberia Extract of Tabasco Pepper Co. (30 App. D. C. 337), 130.
Emerson v. Badger (101 Mass. 82), 58.
Emery v. Bradley (88 Me. 357), 242.
Empire Steam Laundry Co. v. Lozier (165 Calif. 95), 360.
Empire Typesetting Machine Co. v. Linotype Co. (79 L. T. N. S. 8), 54.
Employers' Liability Assur. Corp., Ltd. v. Employers' Liability Ins. Co. (16 N. Y. Supp. 397, 400), 23.
England v. New York Pub. Co. (8 Daly 375), 174.
Eno v. Dunn (L. R. 15 App. Cas. 252, 260), 308, 439.
Enoch Morgan's Sons Co. v. Elder (Cox, Manual, 714), 444.
v. Hunkele (16 Off. Gaz. 1092, 1093), 453.
v. Schwachofer (5 Abb. Pr. N. C. 265), 330.
v. Troxell (89 N. Y. 292), 279, 289.
v. Ward (152 Fed. Rep. 690), 563.
v. Wendover (43 Fed. Rep. 420), 128, 317.
v. Whittier-Coburn Co. (118 Fed. Rep. 657), 330.
Enoch Morgan & Sons Co. v. Ward (81 C. C. A. 616), 128, 330.
Enterprise Mfg. Co. v. Bender (148 Fed. Rep. 313), 315.
v. Landers, Frary & Clark (65 C. C. A. 587), 292, 318, 369, 371.
E. P. Dutton & Co. v. Cupples (102 N. Y. Supp. 309), 198, 449.
Epperson & Co. v. Bluthenthal (149 Ala. 125), 80.
E. Regensburg & Sons v. Juan F. Portuondo Cigar Mfg. Co. (73 C. C. A. 378), 279.
v. Juan F. Portuondo Cigar Mfg. Co. (136 Fed. Rep. 866, 869), 279, 282.
Erwin v. Hayden (Texas), (43 S. W. Rep. 610), 250.
Esselstyn v. Holmes (42 Mont. 507), 160.
Esseylstyn v. Holmes (114 Pac. Rep. 118), 108, 160.
Estcourt v. The Estcourt Hop Essence Co. (31 L. T. N. S. 567), 79.
Estes v. Leslie (1), 27 Fed. Rep. 22), 118, 202.
v. Leslie (29 Fed. Rep. 911), 118, 202, 325.
v. Williams (21 Fed. Rep. 189), 20, 26, 29.
v. Worthington (22 Fed. Rep. 822), 207, 452.

References are to pages.

Estes v. Worthington (2), (30 Fed. Rep. 465), 403.
v. Worthington (31 Fed. Rep. 154), 118, 202.
E. T. Fairbanks & Co. v. Des Moines Scale & Mfg. Co. (96 Fed. Rep. 972), 451.
Eureka Fire Hose Co. v. Eureka Rubber Mfg. Co. (69 N. J. Eq. 159), 120.
Evans v. Smallcombe (L. R. 3 H. L. 249), 209.
v. Von Laer (32 Fed. Rep. 153), 107, 159, 299, 313.
Evenson v. Spalding (150 Fed. 517), 50.
Everett Piano Co. v. Bent (60 Ill. App. 372), 374.
v. Maus (200 Fed. Rep. 718), 56.
Ewing v. Standard Oil Co. (42 App. D. C. 321), 576.
Exchange Bank v. Wichita Cattle Co. (61 Fed. Rep. 190), 472.
Ex parte Adam Roth Gro. Co. (62 Off. Gaz. 315), 537.
Adriance, Platt & Co. (20 Off. Gaz. 1820), 542.
Alden (15 Off. Gaz. 389), 507.
American Lead Pencil Co. (61 Off. Gaz. 151), 544.
American Optical Co. (C. D. 1908, 102), 561.
American Separator Co. (119 O. G. 339), 584.
American Weavers' Assn. (94 Off. Gaz. 586), 516.
American Wringer Co. (134 O. G. 1803), 567.
Atkins & Co. (119 O. G. 2236), 554.
Austin, Nichols & Co. (167 O. G. 981), 560.
Auto Grand Piano Co. (155 O. G. 307), 560.
Ball (98 Off. Gaz. 2366), 516.
Ex parte Barclay & Barclay (134 O. G. 1562), 552.
Barclay & Barclay (C. D. 1908, 154), 561, 567.
Barnhart Bros. & Spindler (87 Off. Gaz. 2118, 2119), 516.
Bassett (55 Off. Gaz. 997), 533.
Bloch & Co. (40 Off. Gaz. 443), 506, 541.
Bloch Bros. Clothing Co. (124 O. G. 1521), 562.
Bloomington Canning Co. (119 O. G. 2235), 577, 578.
Boston Fountain Pen Co. (116 O. G. 2531), 553.
Brand Stove Co. (62 Off. Gaz. 588), 102.
Bronson Co. (87 Off. Gaz. 1782), 102.
Brown & Co. (143 O. G. 561), 560.
Brigham (20 Off. Gaz. 891), 110, 502.
Buffalo Pitts Co. (89 Off. Gaz. 2069), 534, 535, 542, 548.
Butler (87 Off. Gaz. 1781), 126.
Capitol City Dairy Co. (93 Off. Gaz. 295), 109.
Carborundum Co. (118 O. G. 2250), 553.
Central Consumers Co. (C. D., 1908, p. 186), 562.
C. G. Hainline & Co. (58 Off. Gaz. 947), 514.
C. H. Alden Co. (131 O. G. 2419), 563.
Cigar Makers' Assn. (16 Off. Gaz. 958), 62, 509.
Claire (15 Off. Gaz. 248), 331, 509.
Clark-Jewell-Wells Co. (83 Off. Gaz. 915), 537.
Cluett, Peabody & Co. (120 O. G. 902), 567.
Coats (16 Off. Gaz. 544), 508.
Cobb Mfg. Co. (C. D., 1908, p. 6), 562.

References are to pages.

Ex parte Cohn (1), (16 Off. Gaz. 680), 111, 507.
Cohn (2) (16 Off. Gaz. 680), 101, 507.
Conrad Seipp Brew. Co. (206 O. G. 877), 562.
Consolidated Fruit Jar Co. (16 Off. Gaz. 679), 504, 510.
Coon (58 Off. Gaz. 946), 540, 543.
Creedmore Cartridge Co. (56 Off. Gaz. 1333), 542.
Crescent Mfg. Co. (C. D., 1901, p. 160), 561.
Cross (C. D., 1907, p. 125), 560.
Davids & Co. (16 Off. Gaz. 94), 501, 506, 508, 509.
Dawes & Fanning (1 Off. Gaz. 27), 508.
Dayton Spice Mills (135 O. G. 893), 560.
De Long Hook & Eye Co. (128 O. G. 885), 560, 561.
De Long Hook & Eye Co. (C. D., 1907, p. 139), 562.
Diamond Laboratory Co. (44 MSS. Dec. 19), 514.
Dodge Mfg. Co. (128 O. G. 2531), 550.
Dr. Harter Med. Co. (106 Off. Gaz. 1779), 336.
Egyptian Cigarette Co. (85 Off. Gaz. 1905), 124.
Eldredge Co. (55 Off. Gaz. 1278), 514.
Ervin A. Rice Co. (83 Off. Gaz. 1207), 99.
E. Wertheimer & Cie (132 O. G. 679), 555.
Fairchild (21 Off. Gaz. 789), 510.
Falkenberg (115 O. G. 1065), 562.
Farnum & Co. (18 Off. Gaz. 412), 90, 160, 507.
F. H. Gilson Co. (83 Off. Gaz. 1992), 534.
Fisk (113 U. S. 713), 480.
Ex parte Foley & Co. (87 Off. Gaz. 1957), 120, 336, 559.
Foss (2 DeG. & J. 230), 31.
Freiberg & Workum (20 Off. Gaz. 1164), 6, 542.
George B. Hurd & Co. (59 Off. Gaz. 1763), 543.
G. F. Heublein & Co. (87 Off. Gaz. 179), 98, 562.
Goldberg, Bowen & Co. (182 O. G. 972), 563.
Goldsmith & Co. (C. D., 1908, p. 104), 561.
Grand Rapids School Furniture Co. (87 Off. Gaz. 1957), 138.
Grossmith (100 O. G. 2175), 560.
Grove (67 Off. Gaz. 1447), 541.
Guenther Milling Co. (86 Off. Gaz. 1986), 104.
Halliday Bros. (16 Off. Gaz. 500), 508.
Hampden Watch Co. (81 Off. Gaz. 1282), 125.
Hance Bros. & White (87 Off. Gaz. 698), 100.
Harris (117 O. G. 903), 554.
Henderson (85 Off. Gaz. 453), 95, 106.
Hendley (72 Off. Gaz. 1654), 542.
Heyman (18 Off. Gaz. 922), 123.
H. J. Heinz Co. (62 Off. Gaz. 1064), 514.
Holophane Glass Co. (100 Off. Gaz. 450), 90.
Horlick's Food Co. (84 Off. Gaz. 1870), 106.
Hudson (55 Off. Gaz. 1401), 538.
Hutchins (100 Off. Gaz. 1330), 336.
Indiana Bicycle Co. (72 Off. Gaz. 654), 131.
J. D. Richards & Son (54 MSS. D. 425), 537.
J. Fred Wilcox Co. (153 O. G. 546), 559.

References are to pages.

Ex parte Keet & Rountree D. G. Co. (115 O. G. 1849), 562.
Kenyon (124 O. G. 2901), 562.
Keystone Chamois Co. (101 Off. Gaz. 3109), 336.
King (C. D., 1870, p. 109), 501.
King (2), (46 Off. Gaz. 119), 506.
Kingan Packing Assn. (119 O. G. 2234), 554, 574.
Kinney (72 Off. Gaz. 1349), 128, 537, 540.
Kipling (24 Off. Gaz. 899), 541.
Kirker, Greer & Co. (Ltd.) (37 MSS. D. 392), 540.
Knapp (16 Off. Gaz. 318), 507.
Konigliches Hofbrauam & Munchen (146 O. G. 720), 555.
Krusius Bros. (82 Off. Gaz. 1687), 99.
Langdon (61 Off. Gaz. 286), 502, 533.
Lawrence Bros. (44 L. T. N. S. 98), 27, 399.
Lazarus Schwarz & Lipper (64 Off. Gaz. 1396), 537, 540.
Lee & Shepard (24 Off. Gaz. 1271), 543.
Lewis & Co. (66 MSS. Dec. 219), 560.
Lorenz (89 Off. Gaz. 2067), 127.
Lutz (33 Off. Gaz. 1389), 502.
Lyon, Dupuy & Co. (28 Off. Gaz. 191), 66, 501, 542.
Magazine & Book Co. (C. D., 1908, p. 163), 553, 562.
Mahn (82 Off. Gaz. 1210), 516.
Mark Cross Co. (116 O. G. 1733), 584.
Marsching & Coo. (15 Off. Gaz. 294), 103, 507.
Martin (89 Off. Gaz. 2258), 80, 541.
M. Block & Co. (40 Off. Gaz. 443), 536.
McCabe (46 Fed. Rep. 363), 467.
McClain (C. D., 1902, p. 185), 561.
Ex parte McInnerney (85 Off. Gaz. 149), 274, 559.
Meyer Bros. Coffee & S. Co. (135 O. G. 893), 560.
Moodie (28 Off. Gaz. 1271), 502.
Mt. Carbon Co. (150 O. G. 828), 560.
Muir (87 Off. Gaz. 357), 537.
Nave & McCord Merc. Co. (86 Off. Gaz. 1985), 103.
Neuman (159 O. G. 993), 560.
Nicholaus (161 O. G. 268), 560.
Olive Wheel Co. (84 Off. Gaz. 1871), 108.
Oliver (18 Off. Gaz. 923), 160.
Orcutt & Son (8 Off. Gaz. 276), 514.
Pace, Talbott & Co. (16 Off. Gaz. 909), 509.
Palmer (58 Off. Gaz. 383), 514.
Parker (13 Off. Gaz. 323), 514.
Parker, Holmes & Co. (85 Off. Gaz. 287), 104.
Pearson Tobacco Co. (85 Off. Gaz. 295), 80, 109.
Peper (16 Off. Gaz. 678), 508.
Phenix Ins. Co. (118 U. S. 610), 479.
Polar Knitting Mills (154 O. G. 251), 563.
Punnett (L. R. 16 Ch. D. 226), 229.
Rall (85 Off. Gaz. 453), 108.
Rat Biscuit Co. (C. D., 1907, p. 241), 562.
Roasted Cereals Co. (57 MSS. D. 455), 533.
R. Steinecke Co. (122 Off. Gaz. 3011), 516.
Roth Grocery Co. (62 Off. Gaz. 315), 540.
Roy (54 Off. Gaz. 1267), 532, 538.
Ruckstuhl (56 Off. Gaz. 927), 514.
Sacks (C. D., 1907, p. 169), 562.
Safety Powder Co. (16 Off. Gaz. 136), 110, 507.

References are to pages.

Ex parte Satzman & Forman (134 O. G. 2243), 559.
Schmachtenberg Bros. (51 MSS. D. 204), 541.
Schollenberger (96 U. S. 369), 414.
Schumacher & Ettlinger (1) (19 Off. Gaz. 791), 501.
Schumacher & Ettlinger (2) (22 Off. Gaz. 1291), 502.
Scott Paper Co. (137 O. G. 1482), 562.
Seaconst Canning Co. (199 O. G. 617), 562.
Shenkberg Co. (132 O. G. 1073), 562.
Sides (123 Off. Gaz. 1663), 516.
Smith (1) (16 Off. Gaz. 679), 509.
Smith (2) (16 Off. Gaz. 679), 107, 507.
Smith (3) (16 Off. Gaz. 764), 107, 506.
Sodafoam Baking Powder Co. (96 Off. Gaz. 1239), 336.
Spayd (86 Off. Gaz. 631), 105.
Spinner (35 MSS. D. 15), 532, 533.
Standard Fashion Co. (89 Off. Gaz. 189), 537.
St. Anthony Milling & Elevator Co. (161 O. G. 1047), 563.
Stokes (64 Off. Gaz. 437), 111, 507.
Strasburger & Co. (20 Off. Gaz. 155), 112, 502, 511, 540, 541, 543.
Strauss (C. D., 1907, p. 133), 922.
Streator Metal Co. (130 Off. Gaz. 1483), 922.
Stuhmer (86 Off. Gaz. 181), 95, 103, 148.
Sullivan & Burke (16 Off. Gaz. 765), 509.
Sutton (108 Off. Gaz. 291), 336.
Ex parte Taylor & Co. (114 O. G. 972), 562.
Thaddeus Davids & Co. (16 Off. Gaz. 94), 514.
The Anti-Adulteration League (86 Off. Gaz. 1803), 533.
The Bronson Co. (87 Off. Gaz. 1782), 534.
Thompson, Derby & Co. (16 Off. Gaz. 137), 112, 507.
Tietgens & Robertson (87 Off. Gaz. 2117), 122, 541.
Union Carbide Co. (135 O. G. 160), 561.
United Roofing & Mfg. Co. (187 O. G. 1913), 563.
United States Brewing Co. (125 O. G. 352), 562.
United States Playing Card Co. (82 Off. Gaz. 1209), 130, 515, 516.
Velvril Co., Ltd. (84 Off. Gaz. 807), 90, 534.
Vi-Stix Products Co. (175 O. G. 846), 568.
Vogel & Son (99 O. G. 2321), 336, 560.
Waeferling (16 Off. Gaz. 764), 104, 502, 507.
W. B. Belknap & Co. (105 Off. Gaz. 745), 336.
Weil (83 Off. Gaz. 1802), 114, 542.
Weisert Bros. (16 Off. Gaz. 689), 510.
Wiesel (36 Off. Gaz. 689), 502.
Willard Chem. Co. (107 Off. Gaz. 1972), 336.
Wolf (80 Off. Gaz. 1271), 104, 541.
W. Simpson & Sons (10 Off. Gaz. 334), 514.
Yale & Towne Mfg. Co. (81 Off. Gaz. 801), 113.

References are to pages.

Ex parte Young (Seb. 537), 31, 340.
Zwack & Co. (76 Off. Gaz. 1855), 535.

F

Faber v. D'Utassey (11 Abb. Pr. N. S. 399), 310.
v. Faber (49 Barb. 357), 121, 174.
v. Hovey (Codd. Dig. 79, 242), 129.
Fairbanks v. Jacobus (Fed. Case No. 4608), 88, 102, 149, 279, 292.
Fairfield v. Lowry (207 Mass. 352), 232.
F. & J. Burke v. Bishop (175 Fed. Rep. 167, 175), 445.
Falk v. American West Indies Trading Co. (180 N. Y. 445), 38.
Falkinburg v. Lucy (35 Cal. 52), 158, 637.
Familton v. Bliss Medical Co. (135 O. G. 1359), 577.
Farben-fabriken T. M. K. (7 R. P. C. 439), 111.
Farina v. Cathery (L. J. N. C., 1867, p. 134), 404.
v. Silverlock (6 DeG., M. & G. 214, 217), 19, 298, 299, 399.
Farley v. Evening Chronicle Pub. Co. (113 Mo. App. 216), 276.
Farmers' Loan & Trust Co. v. Farmers' Loan & Trust Co. of Kansas (1 N. Y. Supp. 44), 185.
Farmers' Mfg. Co. v. W. R. Harrison & Co. (96 Off. Gaz. 2062), 539.
Farr v. Pearce (3 Madd. 74), 225.
Featherstonhaugh v. Fenwick (17 Ves. 298), 222.
v. Turner (25 Beav. 382), 239.
Feder v. Benkert (76 Fed. Rep. 613), 906.
v. Brudno (5 Ohio N. P. 275), 125.
Fels v. Hedley (20 Times L. R. 69), 107.
Fennessy v. Rabbits (56 L. T. 138), 455.
v. Clark (L. R. 37 Ch. D. 184, 187), 423.
v. Day (55 L. T. N. S. 161), 443, 492.
Ferguson v. Davol Mills (2 Brewst. 314), 6.
Ferguson-McKinney Dry Goods Co. v. J. A. Scriven Co. (165 Fed. Rep. 655), 448.
Fetridge v. Merchant (4 Abb. Pr. 156), 79, 115.
v. Wells (4 Abb. Pr. 144), 79, 158.
Field v. Lewis (Seton (4th Ed.) 237), 443, 490.
v. Wagnel Syndicate (L. R. (1900) 1 Ch. 651), 330.
Filkins v. Blackman (13 Blatchf. 440), 29, 34, 35, 36, 241.
Filley v. Child (16 Blatchf. 376), 88, 118.
v. Fassett (44 Mo. 173), 118, 120, 121, 279, 293, 301, 443, 467.
Findlay v. Carson (97 Iowa, 537), 231.
Finger v. Hahn (42 N. J. Eq. 606), 242, 248.
Finley Rubber-Varnish & Enamel Co. v. Finley (N. J. Ch. 32 Atl. Rep. 740), 263.
Finney Orchestra v. Finney's Famous Orchestra (126 N. W. Rep. 198), 121.
Fischer v. Blank (138 N. Y. 244), 99, 147, 286, 306.
v. Hayes (6 Fed. Rep. 63-68), 474.
Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co. (95 Fed. Rep. 457, 461), 16, 36, 401.
v. La Belle Wagon Works (82 Wis. 546), 36, 58, 232.

References are to pages.

Fisher & Co. v. The Apollinaris Co. (L. R. 10 Ch. D. 297-299), 53.
Fisher v. Owen (8 C. D., p. 653), 436.
Fisk v. Mahler (54 Fed. Rep. 528), 454.
Fite v. Dorman (Tenn.) (57 S. W. Rep. 129), 245.
Flagg Mfg. Co. v. Holway (178 Mass. 83), 180, 279, 291, 370.
Flavel v. Harrison (10 Hare, 467), 79, 82.
Fleischman v. Rahmstorf (226 Fed. Rep. 443), 247.
Fleischmann v. Schuckmann (62 How. Pr. 92), 166, 442.
v. Starkey (25 Fed. Rep. 127), 279, 286.
Fleming v. Lee (1901) (2 Ch. 594), 434.
v. Newton (L. R. 1 H. L. C. 363), 53.
Florence Mfg. Co. v. Dowd (171 Fed. Rep. 122), 105, 327.
Follet v. Jeffreyes (1 Sim. N. S. 1), 254.
Fontipia Limited v. Bradley (171 Fed. Rep. 951, 959), 369, 450.
Ford v. Foster (L. R. 7 Ch. D. 611), 79, 82, 120, 143, 214, 215, 443.
Fordham v. Hicks (224 Fed. Rep. 810), 433.
Ford Motor Co. v. Wilson (223 Fed. Rep. 808), 207, 359.
Forney v. Engineering News Publishing Co. (57 Hun, 588), 367.
Foss v. Roby (191 Mass. 292, 297), 225.
Foster v. Blood Balm Co. (77 Ga. 216), 115, 342.
v. Webster Piano Co. (13 N. Y. Supp. 338), 175, 334.
Foster-Milburn Co. v. Chinn (134 Ky. 824), 277.
Fotheringham v. Express Co. (36 Fed. Rep. 252, 253), 421.
Fowle v. Spear (7 Penn. L. J. 176), 78, 131.
v. Park (131 U. S. 88), 253, 254.
Fox & Co. v. Glynn (191 Mass. 344), 369.
Fralich v. Despar (165 Pa. St. 24), 256.
Francis v. Flynn (117 U. S. 385), 56.
Franck v. Franck Chicory Co. (95 Fed. Rep. 818-821), 286, 470.
Frank v. Macwilliam (117 Off. Gaz. 1165), 310.
v. Sleeper (150 Mass. 583), 29, 340, 342.
Frank & Gutmann v. McWilliam (114 O. G. 542), 553.
Frankau v. Pope (11 Cape of Good Hope, 209), 342.
Frazer v. Frazer Lubricator Co. (121 Ill. 147), 29, 177, 241.
Frazier v. Dowling (18 Ky. L. Rep. 1109), 78, 445.
French v. Alter & Julian Co. (74 Fed. Rep. 788), 452.
French Republic v. Saratoga Vichy Co. (191 U. S. 427), 193.
Frese v. Bachof (13 Off. Gaz. 635), 104, 284, 448.
Frohman v. Miller (29 N. Y. S. 1109), 117.
v. Morris (123 N. Y. St. 1090), 117.
v. Payton (68 N. Y. Supp. 849), 204.
Frost v. Rindskopf (42 Fed. Rep. 408), 332.
Ft. Stanwix Canning Co. v. Wm. McKinley Canning Co. (63 N. Y. Supp. 704), 379.
Fuller v. Huff (99 Fed. Rep. 439), 104, 193, 311.
Fullwood v. Fullwood (1) (W. N. 1873, p. 93), 312.
Fulton v. Sellers (4 Brewst. 42), 28, 29, 81, 115, 116, 172.

References are to pages.

Funke v. Baldwin (127 Off. Gaz. 392), 390, 577.
v. Dreyfus (34 La. Ann. 80), 116.

G

Gabriel v. Sicilian Asphalt Co. (52 N. Y. Supp. 722), 159.
v. Sicilian Asphalt Co. (2) (56 N. Y. Supp. 30), 159.
Gage v. Canada Pub. Co. (11 Can. Sup. 306), 33, 116, 177, 442.
Gage-Downs Co. v. Featherbone Corset Co. (83 Fed. Rep. 213), 118, 167.
Gail v. Wackerbarth (28 Fed. Rep. 286), 286, 467.
Gaines & Co. v. Sroufe (117 Fed. Rep. 965), 429.
Galena Signal Oil Co. v. W. P. Fuller & Co. (142 Fed. Rep. 1002, 1007), 294.
Gally v. Colt's Patent Fire Arms Mfg. Co. (30 Fed. Rep. 118), 89.
Gamble v. Stephenson (10 Mo. App. 581), 355.
G. & C. Merriam Co. v. Straus (136 Fed. Rep. 477), 441.
v. Ogilvie (170 Fed. Rep. 167), 93.
v. Saalfield (190 Fed. Rep. 927), 93.
v. Syndicate Pub. Co. (237 U. S. 618), 466.
v. Syndicate Pub. Co. (207 Fed. Rep. 515), 93.
G. & J. Tire Co. v. G. J. G. Motor Car Co. (39 App. D. C. 508), 121.
Gandy Belting Co. v. Victor-Balata Co. (215 Fed. Rep. 795), 291.
Gannert v. Rupert (127 Fed. Rep. 962), 118.
Gannett v. Rupert (62 C. C. A. 594), 202.
Gardner v. Bailey (Fed. Case No. 5221), 331.
Garnier v. Rossman (195 Fed. Rep. 175), 114.
Garretson v. Clark (111 U. S. 120), 456.
Garrett v. T. H. Garrett & Co. (24 C. C. A. 173), 74, 177, 179, 188, 337, 444.
Gartside v. Outram (3 Jur. N. S.), 254.
Gebbie v. Stitt (31 N. Y. Supp. 102), 159.
Gee v. Pritchard 2 Swanst. 402), 53, 260.
Geiger v. Cawley (146 Mich. 550), 248.
Geo. G. Fox Co. v. Glynn (78 N. E. Rep. 89), 119.
v. Glynn (191 Mass. 344), 325.
General Electric Co. v. Re-New Lamp Co. (128 Fed. Rep. 154), 315, 342, 450.
v. Re-New Lamp Co. (121 Fed. Rep. 164), 315.
Genessee Salt Co. v. Burnap (20 C. C. A. 27), 94.
v. Burnap (67 Fed. Rep. 534), 94.
George v. Smith (52 Fed. Rep. 830), 70, 120, 308, 309, 443.
George Frost Co. v. E. B. Estes & Sons (156 Fed. Rep. 677), 92.
George T. Stagg Co. v. Taylor (95 Ky. 651), 126, 342, 347, 387.
Georgia Co. v. Bilfinger (129 Fed. Rep. 131), 578.
German-American Button Co. v. Heymsfeld, Inc. (156 N. Y. S. 223), 451.
Germer Stove Co. v. Art Stove Co. (80 C. C. A. 9), 46.
Geron v. Gartner (47 Fed. Rep. 467), 340.
Gessler v. Grieb (80 Wis. 21), 104.
G. G. White Co. v. Miller (50 Fed. Rep. 277), 19, 118, 328.

References are to pages.

G. Heileman Brew. Co. v. Independent Brew. Co. (191 Fed. Rep. 489), 126.
Giblett v. Read (9 Mod. 459), 33, 130, 401.
Giles v. Paxton (36 Fed. Rep. 882, 883), 484.
Gilka v. Mihalovitch (50 Fed. Rep. 427), 206.
Gillett v. Lumsden (4 Ont. Law Rep. 300), 101, 211.
Gillette Safety Razor, Ltd., v. Pellett, Ltd. (26 R. P. C. 588), 460.
Gilley v. United Shoe Mach. Co. 152 Fed. Rep. 726), 377.
Gillis v. Hall (Cox, 596), 177.
v. Hall (3 Brews. 509), 173.
v. Hall (3 Brewst. 342), 904.
Gillott v. Esterbrook (47 Barb. 455), 209, 210, 338, 341, 442, 904.
v. Esterbrook (48 N. Y. 374), 213.
v. Kettle (3 Duer, 624), 316, 339, 341, 442.
Gilman v. Dwight (13 Gray. 356), 225.
v. Hunnewell (122 Mass. 139), 16, 101, 174, 290, 306.
Ginter v. Kinney Tobacco Co. (12 Fed. Rep. 782), 79, 111.
Giragosian v. Chutjian (194 Mass. 504), 454.
Giron v. Gartner (47 Fed. Rep. 467), 342.
Glaser v. St. Elmo Co. (175 Fed. Rep. 276), 204.
Glen & Hall Mfg. Co. v. Hall (61 N. Y. 226), 213, 339.
Glencoe Sand & Gravel Co. v. Hudson (138 Mo. 439), 365.
Glen Cove Manufacturing Co. v. Ludeman (23 Blatchf. 46), 503.
v. Ludeling (22 Fed. Rep. 823), 125, 378, 385, 392, 418, 428, 441, 545, 546.
Glendon Iron Co. v. Uhler (75 Pa. St. 467), 103, 159.
Glenny v. Smith (2 Drew. & Sm. 476), 293.
Glenwood Light & Water Co. v. Mutual Light Co. (239 U. S. 121), 393.
Globe-Wernicke Co. v. Brown (121 Fed. Rep. 185), 120.
v. Brown & Besly (57 C. C. A. 344), 292.
v. Fred Macey Co. (56 C. C. A. 304), 292.
Glotin v. Oswald (65 Fed. Rep. 151), 392, 415.
Gluckman v. Strauch (91 N. Y. Supp. 223), 78.
Godillot v. American Grocery Co. (71 Fed. Rep. 873), 342.
v. Harris (81 N. Y. 263, 266), 9, 18.
v. Hazard (44 N. Y. Sup. Ct. 427), 6, 63.
v. Hazzard (81 N. Y. 263), 105.
Golden & Co. v. Heitz & Co. (125 O. G. 989), 572.
Goldstein v. Whelan (62 Fed. Rep. 124), 126, 393, 451, 477.
Goodfellow v. Jolly (C. D., 1905, p. 105), 572.
v. Prince (L. R. 35 Ch. 9), 378.
Goodlet v. Railroad (122 U. S. 391), 414.
Goodman v. Bohls (3 Tex. Civ. App. 183), 152.
v. Curtis (174 Fed. Rep. 644), 469.
v. Henderson (58 Ga. 567), 223.
v. Meriden Brittania Co. (50 Conn. 139), 27.
Goodwin v. Ivory Soap Co. 23 R. P. C. 389), 333.
Goodyear Rubber Co. v. Day (22 Fed. Rep. 44), 88, 186, 452.
v. Goodyear's Rubber Mfg. Co. (21 Fed. Rep. 276), 184.

References are to pages.

Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. (128 U. S. 598), 41, 47, 103, 186.
Gordon v. Knott (199 Mass. 173), 232.
Gordon Dry Gin Co. v. Reilly (153 N. Y. S. 226), 756.
Gorden Hollow Blast Grate Co. v. Gordon (142 Mich. 488), 74, 174, 178.
Gorham Co. v. White (14 Wall. 511), 468.
Gorham Mfg. Co. v. Emery-Bird-Thayer Co. (43 C. C. A. 511), 295.
v. Emery-Bird-Thayer Dry Goods Co. (92 Fed. Rep. 774-779), 437, 444, 474.
v. Weintraub (176 Fed. Rep. 927), 72.
Gormley v. Bunyan (138 U. S. 623), 467, 485.
Gouraud v. Trust (3 Hun, 627), 122, 312.
Gout v. Aleploglu (6 Beavan, 69), 147.
Graham v. Plate (40 Cal. 593, 598), 422, 456, 637.
v. St. Charles St. R. Co. (47 La. Ann. 214), 373.
Gravel Roofers' Exchange v. Turnbull (64 Off. Gaz. 441), 400.
Gravely v. Gravely (52 Off. Gaz. 1538), 392.
v. Gravely (42 Fed. Rep. 265), 385, 415, 429, 547.
Graves v. Gunder (136 O. G. 227), 552, 578.
Gray v. Taper-Sleeve Pulley Works 16 Fed. Rep. 436-443), 394, 442.
Greacen v. Bell (115 Fed. Rep. 553, 554), 35.
Great Atlantic & Pacific Tea Co. v. Cream of Wheat Co. (224 Fed. Rep. 566), 156.
Great Tower Street Tea Co. v. Smith (6 R. P. C. 172), 135.
Green v. Rooke (W. N., 1872, p. 49), 103.
Greene v. Woodhouse (38 Off. Gaz. 1891), 151.
Greene, Tweed & Co. v. Manufacturer's Belt Hook Co. (137 O. G. 2221), 553, 569.
v. Manufacturer's Belt Hook Co. 132 O. G. 680), 574.
v. Manufacturer's Belt Hook Co. (158 Fed. Rep. 640), 112, 446.
Gregg v. Bassett (3 Ont. L. Rep. 263), 28.
Gregory v. Spieker (110 Cal. 150), 249, 250.
Gropp v. Perkins (148 Ky. 183), 248.
Grow v. Seligman (47 Mich. 607), 181, 252.
Grier Bros. Co. v. Baldwin (219 Fed. Rep. 735), 282, 369, 371.
Griggs, Cooper & Co. v. Erie Preserving Co. (131 Fed. Rep. 359), 23, 59, 327, 428.
Grillon v. Guenin (W. N. 1877, p. 14), 130, 144, 444.
Grimm v. Walker (45 Iowa, 106), 231.
Grocer's Journal v. Midland Pub. Co. (127 Mo. App. 366), 43.
Grocers' Supply Co. v. Dupuis (Mass.) (107 N. E. Rep. 389), 338.
Grossman v. Griggs (186 Mass. 275), 68.
Gruber Almanack Co. v. Swingley (103 Md. 362), 446.
Guilhon v. Lindo (9 Bos. 605), 437.
Guinness v. Heap (Seb. 617), 377.
v. Ullmer (10 L. T. 127), 279, 298, 304.
Gulden v. Chance (163 Fed. Rep. 447), 119, 333.

References are to pages.

Guth v. Guth Chocolate Co. (140 C. C. A. 410), 179.
Guth Chocolate Co. v. Guth (215 Fed. Rep. 750), 179.
G. W. Cole v. Cole's Oil Co. (147 Fed. Rep. 930), 438.
G. W. J. Murphy Co. v. Metal Stamping Co. (214 Fed. Rep. 382), 448.

H

Hagan & Dodd Co. v. Rigbers (1 Ga. App. 100), 413.
Hagen v. Beth (118 Cal. 330), 452.
Hagg v. Darley (47 L. J. Ch. 567), 256.
Hainque v. Cyclops Iron Works 136 Calif. 35), 325.
Hall v. Barrows (32 L. J. Ch. 548), 64.
v. Barrows (4 DeG. J. & S. 150), 16, 115, 169, 212, 223, 227, 305, 307, 340, 342, 443.
v. Hall (20 Beavan, 139), 222, 227.
Hall & Ruckel v. Ingram (126 O. G. 759), 334.
v. Ingram (28 App. D. C. 454), 129.
Hall Mfg. Co. v. Western Steel & Iron Works (227 Fed. Rep. 588, 592), 235.
Hall Safe & Lock Co. v. Herring-Hall-Marvin Safe Co. (74 C. C. A. 361), 175.
Halsey v. Brotherhood (45 L. T. N. S. 640), 54.
Halstead v. Houston (111 Fed. Rep. 376), 347, 370.
Hamilton Brown Shoe Co. v. Wolf Bros. & Co. (240 U. S. 251), 98, 114, 324, 456.
Hamilton Mfg. Co. v. Tubbs Mfg. Co. (216 Fed. Rep. 401), 258, 261, 266, 334.
Hammond v. Brunker (9 R. P. C. 301), 31, 215.
v. Douglas (5 Ves. 539), 223.
Handy v. Commander (49 La. Ann. 1119), 424, 440.
Hanford v. Westcott (Fed. Case No. 6022), 544.
v. Westcott (16 Off. Gaz. 1181), 122, 510.
Hanks Dental Assn. v. International Tooth Crown Co. (194 U. S. 303), 480.
Hanley v. Fidelity Ins. T. & S. Co. (8 Pa. Dist. R. 207), 263.
Hanna v. Andrews (50 Ia. 462), 225, 231.
Hanover Star Milling Co. v. Allen 208 Fed. Rep. 513), 367.
v. Allen & Wheeler Co. (125 C. C. A. 515), 169.
v. Metcalf (240 U. S. 403), 64.
Hansen v. Inland Type Foundry (134 O. G. 775), 569.
v. Siegel-Cooper Co. (2) (106 Fed. Rep. 691), 123, 307, 327, 471.
Hardy v. Cutter (3 Off. Gaz. 468), 108, 174, 305.
Hargraves v. Smith (Seb. 338), 415.
Harper v. Holman (84 Fed. Rep. 222), 406.
v. Lare (93 Fed. Rep. 989), 335.
v. Pearson (3 L. T. N. S. 547), 401.
Harper & Bros. v. Lare (43 C. C. A. 182), 335.
Harrington v. Libby (Fed. Case No. 6107), 140, 141.
v. Libby (14 Blatchf. 128), 279.
Harris v. Brown (202 Pa. 16), 183.
Harrison v. Taylor (11 Jur. N. S. 408), 294.
Harryman v. Harryman (144 Pac. Rep. 262), 15.
Harschbarger v. Eby (Idaho) (156 Pac. Rep. 619), 249.

References are to pages.

Harson v. Halkyard (22 R. I. 102), 174, 175.
Hart v. Colley (7 R. P. C. 93), 307.
v. Smith (159 Ind. 182), 226.
Hartell v. Viney (Fed. Case No. 6158), 100.
Hartshorn v. Philbrick (C. D., 1902, p. 427), 551.
Hatchard v. Mege (L. R. 18 Q. B. D. 771), 55, 401.
Havana Commercial Co. v. Nichols (155 Fed. Rep. 302), 124, 207, 327.
Hawley v. Donnelly (8 Paige, 415), 476.
Hay & Todd Mfg. Co. v. Querns Brothers (86 Off. Gaz. 1323), 10, 539, 551.
Hazard v. Caswell (57 How. Pr. 1), 339.
v. Caswell (93 N. Y. 259, 262), 31, 401.
Hazelton Boiler Co. v. Hazelton Tripod Boiler Co. (142 Ill. 494), 65, 187, 189.
v. Tripod Boiler Co. (142 Ill. 494), 551.
Hazlett v. Pollack Stogie Co. (115 C. C. A. 30), 447.
Hazzopulo v. Kaufmann (23 Sol. J. 819), 378.
H. B. Wiggins Sons' Co. v. Cott-A-Lap Co. (169 Fed. Rep. 150), 257.
Heath v. American Book Co. (97 Fed. Rep. 533), 364.
v. Wright (3 Wall. Jr., 1), 78, 124.
Hecht v. Porter (9 Pac. C. L. J. 569), 123, 308, 439.
Hegeman v. Hegeman (8 Daly, 1), 28, 30.
v. O'Byrne (9 Daly, 264), 442, 443.
Heide v. Wallace & Co. (129 Fed. Rep. 649, 650), 48, 314.
Heinz v. Lutz (146 Pa. 592), 305.
Heller & Merz Co. v. Shaver (102 Fed. Rep. 882), 216.
Helmhold v. Helmhold Mfg. Co. (53 How. Pr. 453), 81, 104.
Hennessy & Co. v. Dompe (19 R. P. C. 333, 339), 469.
v. Keating (25 R. P. C. 125, 361), 469.
Hennessy v. Braunschweiger (89 Fed. Rep. 664), 19, 66, 217, 385, 392, 429, 532, 535, 545, 546, 547.
v. Budde (82 Fed. Rep. 541), 474, 494.
v. Herrmann (89 Fed. Rep. 669), 295, 298, 392, 393, 415, 430, 546, 890.
v. Hogan (6 W. W. & A'B. Eq. 225), 316, 442.
v. Kennett (Seb. 556), 437, 442.
v. Wheeler (51 How. Pr. 457), 445.
v. Wheeler (69 N. Y. 271), 79.
v. White (6 W. W. & A'B. Eq. 216), 316, 442.
v. Wilmerding-Loewe Co. (103 Fed. Rep. 90), 430, 461.
Henning v. Boyle (112 Fed. Rep. 397), 484, 485.
Henry v. Cherry & Webb (30 R. I. 13), 277.
Herbert v. Dupaty (42 La. Ann. 343), 222, 234, 239.
Herring-Hall-Marvin Safe Co. v. Hall's Safe Co. (208 U. S. 554, 560), 30, 193.
Herz v. Lowenstein (40 App. D. C. 277), 550.
Hetterman v. Powers (102 Ky. 133), 62, 679.
Heublein v. Adams (125 Fed. Rep. 782), 26, 65, 72, 118.
Hickman v. Link (116 Mo. 123), 216.
Hier v. Abrahams (82 N. Y. 519), 127, 141, 142, 329, 442.

References are to pages.

Higgins v. Dakin (33 N. Y. Supp. 890), 756.
v. Keuffel (140 U. S. 428), 513, 514, 516.
Higgins Co. v. Higgins Soap Co. (144 N. Y. 462), 177, 179, 183, 189.
Hildreth v. McCaul (74 N. Y. Supp. 1075), 476.
v. McDonald (164 Mass. 16), 290.
v. Sparks Mfg. Co. (99 Fed. Rep. 484), 298, 405, 458.
Hill v. Lockwood (32 Fed. Rep. 389), 37, 61, 164, 402.
Hillman v. Star Pub. Co. (64 Wash. 691), 276.
Hillside Chemical Co. v. Munson (146 Fed. Rep. 198), 300.
Hilsen v. Libbey (44 N. Y. Supr. Ct. 12), 60.
Hilson Co. v. Foster (80 Fed. Rep. 896-897), 43.
Hine v. Lart (10 Jur. 106), 120, 147, 400.
Hinrichs v. Berndes (Cox, Manual, 594), 53.
Hipgrave v. Case (L. R. 28 Ch. D. 356), 251.
Hiram Holt Co. v. Wadsworth (41 Fed. Rep. 34), 89, 93, 125, 328.
Hiram Ricker & Sons v. Leigh (77 N. Y. Supp. 540), 313.
Hiram Walker & Sons v. Grubman (224 Fed. Rep. 725), 167, 358.
v. Grubman (222 Fed. Rep. 478, 479), 287, 370.
v. Hockstaeder (85 Fed. Rep. 776), 286, 324.
v. Mikolas (79 Fed. Rep. 955), 168.
Hires v. Hires (6 Pa. Dis. R. 285), 286.
Hirsch v. Jonas (L. R. 3 Ch. D. 584, 586), 62.
Hitchcock v. Coker (6 Ad. & E. 428, 454), 226.
Hirst v. Denham (L. R. 14 Eq. 542), 124, 125, 129.
H. Mueller Mfg. Co. v. A. Y. McDonaly & Morrison Mfg. Co. (132 Fed. Rep. 585, 588), 452.
v. A. Y. McDonaly & Morrison Mfg. Co. (164 Fed. Rep. 1001), 122, 293.
Hoagland v. Segur (38 N. J. Law, 237), 242.
Hobbs v. Francais (19 How. Pr. 567), 79.
Holf v. Tarrant & Co. (71 Fed. Rep. 163), 29.
Hogg v. Kirby (8 Ves. 215), 198.
Hohner v. Gratz (52 Fed. Rep. 871), 177.
v. Gratz (50 Fed. Rep. 369), 449, 473.
Holbrook v. Nesbitt (163 Mass. 120), 231, 239, 244.
v. Tobey (66 Me. 410), 248.
Holeproof Hosiery Co. v. Fitts (167 Fed. Rep. 378), 327.
v. Richmond Hosiery Mills (167 Fed. Rep. 381), 432.
v. Wallach Bros. (172 Fed. Rep. 859), 464.
v. Wallach Bros. (112 C. C. A. 655), 464.
v. Wallach Bros. (167 Fed. Rep. 373), 464.
v. Wallach Bros. (190 Fed. Rep. 606), 122.
Hollis v. Shaffer (38 Kas. 492), 234.
Holloway v. Holloway (13 Beav. 209), 171, 177, 445.
Holmes, Booth & Haydens v. Holmes, Booth & Atwood Mfg. Co. (37 Conn. 278), 177, 181, 189, 293.
Holt v. Menendez (23 Fed. Rep. 869, 871), 440.
Holzapfel's Composition Co. v. Rahtjen's American Composition Co. (183 U. S. 1, 8), 83, 447.

References are to pages.

Hoosier Drill Co. v. Ingers (14 Id. 785), 502, 510.
Hopkins v. Hitchcock (14 C. B. N. S. 65), 340, 342.
Hopkins Amusement Co. v. Frohman (202 Ill. 541), 204.
Horlick's Food Co. v. Elgin Milkine Co. (56 C. C. A. 544), 106.
Hornbostel v. Kinney (110 N. Y. 94), 130.
Horton Mfg. Co. v. Horton Mfg. Co. 18 Fed. Rep. 816), 30, 243, 244.
Horwich v. Walker-Gordon Laboratory Co. (205 Ill. 497), 668.
Hostetter v. Adams (10 Fed. Rep. 838), 286, 290, 337, 344, 345.
v. Adams (20 Blatchf. 326), 100.
v. Anderson (1 W. W. & A'B. Eq. 7), 313, 337.
v. Becker (73 Fed. Rep. 297), 327.
v. Bower (74 Fed. Rep. 235), 314, 468.
v. Brueggeman-Reinart Distilling Co. (46 Fed. Rep. 188), 313.
v. Brunn (107 Fed. Rep. 707), 437.
v. Comerford (97 Fed. Rep. 585), 314, 469.
v. Conron (111 Fed. Rep. 737), 313.
v. E. G. Lyons Co. (99 Fed. Rep. 734), 441.
v. Fries (17 Fed. Rep. 620), 6, 313.
v. Gallagher Stores (142 Fed. Rep. 208), 313.
v. Martinoni (110 Fed. Rep. 524), 314.
v. Sommers (84 Fed. Rep. 333), 313.
v. Van Vorst (62 Fed. Rep. 600), 318, 492.
v. Vowinkle (Fed. Case No. 6714), 327, 444, 456, 470.
v. Wm. Schneider Co. (107 Fed. Rep. 705), 313.
Houchens v. Houchens (95 Md. 37), 445.
Hovenden v. Lloyd (18 W. R. 1132), 33.
Howard v. Henriques (3 Sandf. 725), 355.
v. Taylor (90 Ala. 241-244), 241, 249.
Howard Dustless Duster Co. v. Carleton (219 Fed. Rep. 913, 916), 345.
Howe v. Howe Sewing Machine Co. (50 Barb. 236), 172.
v. McKernon (30 Beav. 547), 68, 471, 472.
v. Searing (10 Abb. Pr. 264), 29, 231.
Howe Scale Co. v. Wyckoff, Seamans & Benedict (198 U. S. 118), 66, 175, 176, 187.
Hoxie v. Chaney (143 Mass. 592), 29, 30, 79, 115, 181, 227, 230, 232.
Hoyt v. Holly (39 Conn. 326), 225.
v. Hoyt (143 Pa. St. 623), 5, 17, 21.
v. J. T. Lovett Co. (71 Fed. Rep. 173), 104.
Hubback v. Wilkinson, 1899 (1 Q. B. 90, 91), 55, 433.
Hubbard v. Miller (27 Mich 15), 235, 242.
Hudson v. Osborne (39 L. J. Ch. 79), 31, 212, 213, 222.
v. Osborne (21 L. T. N. S. 386), 355.
Huff v. Wallace (N. J. Ch., 93 Atl. Rep. 702), 116.
Hughes v. Alfred H. Smith Co. (205 Fed. Rep. 311), 89, 564.
v. Northern Pacific Ry. Co. (18 Fed. Rep. 106, 110), 430.
Humphreys' Homeopathic Medicine Co. v. Hilton (60 Fed. Rep. 756), 339.

References are to pages.

Humphreys' Specific Med. Co. v. Wenz (14 Fed. Rep. 250), 6, 39, 105, 327, 339.
Hunt v. Maniere (34 Beav. 157), 405.
v. New York Cotton Exchange (205 U. S. 322, 333), 366.
Hurricane Patent Lantern Co. v. Miller (56 How. Pr. 234), 333.
Hutchinson v. Blumberg (51 Fed. Rep. 829), 129, 448, 492.
v. Covert (51 Fed. Rep. 832), 129, 331.
v. Nay (187 Mass. 262), 225.
Hutchinson, Pierce & Co. v. Loewy (217 U. S. 457), 466, 581.
Huwer v. Dannenhoffer (82 N. Y. 499), 31, 401.
H. W. Johns-Manville Co. v. American S. P. Co. (33 App. D. C. 224), 567.
Hyams v. Old Dominion Co. (204 Fed. Rep. 681), 433.
Hygeia Distilled Water Co. v. Consolidated Ice Co. (144 Fed. Rep. 139), 22, 123.
v. Hygeia Ice Co. (40 Atl. 534, 540), 8.
v. Hygeia Ice Co. (1) (70 Conn. 516), 123.
v. Hygeia Ice Co. (2) 72 Conn. 646), 123.
Hygienic Fleeced Underwear Co. v. Way (70 C. C. A. 553), 107, 126, 335.
v. Way (133 Fed. Rep. 245), 441.
Hyman v. Solis Cigar Co. (4 Colo. App. 475), 64, 70.

I

Illinois Hydraulic Cement Mfg. Co. v. Utica Hydraulic Cement Co. (129 O. G. 2502), 577.
Illinois Watch Co. v. Elgin Nat. Watch Co. (94 Fed. Rep. 667), 52, 102, 165, 380, 395, 532.
Iman v. Inkster (90 Neb. 704), 221.
Improved Fig Syrup Co. v. California Fig Syrup Co. (4 C. C. A. 264), 100, 150.
v. California Fig Syrup Co. (54 Fed. Rep. 175), 442.
Independent Baking Powder Co. v. Boorman (130 Fed. Rep. 726), 450.
v. Boorman (175 Fed. 448), 68.
India Rubber Comb Co. v. Rubber Com'. Co. (45 N. Y. Super. Ct. R. 258), 177.
v. Jewelry Co. (45 N. Y. Sup. Ct. 258), 339.
Indurated Fibre Co. v. Amoskeag Indurated Fibre Ware Co. (37 Fed. Rep. 695), 105, 137.
Industrial Mutual Deposit Co. v. Central Mutual Deposit Co. (112 Ky. 937), 185.
Industrial Press v. W. R. C. Smith Pub. Co. (164 Fed. Rep. 842), 429.
Ingersoll v. Goldstein (N. J. Ch., 93 Atl. Rep. 193), 736.
Ingram v. Stiff (5 Jur. N. S. 947), 202.
Insurance Oil Tank Co. v. Scott (33 La. Ann. 946), 61, 123.
International Cheese Co. v. Phenix Cheese Co. (103 N. Y. Supp. 362), 162.
International Food Co. v. Price Baking Powder Co. (33 App. D. C. 137), 119.
International Silver Co. v. Rogers (71 N. J. Eq. 560), 176.
v. Rogers (72 N. J. Eq. 933), 176.
v. Rogers Bros. Cutlery Co. (136 Fed. Rep. 1019), 182, 330.
v. Rogers Corp'n. (66 N. J. Eq. 119), 176, 193.

References are to pages.

International Silver Co. v. Simeon L. & George H. Rogers Co. (110 Fed. Rep. 955), 177, 401.
v. Wm. G. Rogers Co. (113 Fed. Rep. 526), 177.
International Society v. International Society (59 N. Y. Supp. 785), 312.
v. Wm. H. Rogers Corp. (67 N. J. Eq. 646), 176.
Investor Pub. Co. v. Dobinson (72 Fed. Rep. 603), 184, 185.
v. Dobinson (82 Fed. Rep. 56), 52, 174, 367.
Iowa Seed Co. v. Dorr (70 Ia. 481), 175, 223.
Iowa Washing Mach. Co. v. Montgomery Ward & Co. (227 Fed. Rep. 1007), 478.
Irish Industrial Assn. v. Barrett (186 O. G. 797), 570.
Iron Ox. Co. v. Co-op. Society (24 R. P. C. 425), 327.
v. Leeds (24 R. P. C. 434), 327.
Italian Swiss Colony v. Italian Vineyard Co. (158 Cal. 252), 112, 148.
v. Italian Vineyard Co. (158 Cal. 252), 5.
In re Adams' Trademarks (9 R. P. C. 174), 85.
Adriance, Platt & Co. (Comm. Decis., 1881, p. 52), 537.
Alden (15 Off. Gaz. 389), 102.
American Circular Loom Co. (28 App. D. C. 450), 101.
American Circular Loom Co. (C. D., 1901, p. 481), 562.
American Lubricating Oil Co. (9 Off. Gaz. 687), 129, 509.
American Sardine Co. (3 Off. Gaz. 495), 98, 507, 541.
American Saw Co. (58 Off. Gaz. 521), 541.
Ames (23 Off. Gaz. 344), 541.
In re Anglo-Swiss Condensed Milk Co. (20 R. P. C. 509), 136.
Anti-Cori-Zinc Chemical Co. (34 App. D. C. 191), 103.
Arbenz (L. R., 35 Ch. D. 248), 214.
Armstrong & Co. (26 MSS. D. 260), 538.
Artesian Mfg. Co. (37 App. D. C. 113), 563.
Atkins Filter Co. (3 P. R. 164), 110.
Australian Wine Importers Ltd. (41 Ch. D. 278-281), 9, 62.
Bagots, Hutton & Co., Ltd. (32 R. P. C. 333, 347), 135.
Baldwin (30 L. T. 354), 130.
Barker's Trademark (53 L. T. N. S. 23), 323.
Barrett Mfg. Co. (167 O. G. 513), 559.
Barrows (L. R. 5 Ch. D. 353), 340, 342.
Baschiera's Trademark (33 S. J. 469), 321.
Blakeslee & Co. (Comm. Decis., 1871, p. 284), 508.
Block & Co. (14 Off. Gaz. 235), 504, 509.
Boehm & Co. (Comm. Decis., 1875, p. 103), 537.
Boehm & Co. (8 Off. Gaz. 319), 503.
Bogardus (50 MSS. D. 2), 540.
Bole Bros. (12 Off. Gaz. 939), 507.
Bovril (L. R., 1896, 2 Ch. D. 600), 117.
Bowe (50 MSS. D. 168), 540.
Brand Stove Co. (62 Off. Gaz. 588), 507.
Brandreth (L. R. 9 Ch. D. 618), 98.
Brandreth (59 N. Y. Supp. 1092), 263.

References are to pages.

In re Brigham (Comm. Decis., 1881, p. 38), 507.
Brineat (233 Fed. Rep. 811, 816), 469.
Bromo-Celery Co. (Newton, Dig. 190), 137.
Brook (26 W. R. 791), 340.
Burgoyne (6 R. P. C. 227), 145.
Bush & Co. (10 Off. Gaz. 164), 117, 509.
Cahn, Belt & Co. (27 App. D. C. 173), 564.
California Fig Syrup Co. (L. R. 40 Ch. D. 620), 100.
Carl Lindstroem Aktiengesellschaft (31 R. P. C. 265), 142.
Charles Narcisse Ferre (Cert. No. 8939), 116.
Chetwood (165 U. S. 443-462), 476.
Chichester Chemical Co. (52 Off. Gaz. 1061), 541.
Christiansen (3 R. P. C. 54), 301, 468.
Coggin, Kidder & Co. (11 Off. Gaz. 1109), 509.
Consolidated Fruit Jar Co. (14 Id. 269), 509, 510.
Cornwall (12 Off. Gaz. 138), 129, 510, 541.
Cornwall & Co. (12 Off. Gaz. 312), 120, 507, 510.
Creedmore Cartridge Co. (56 Id. 1333), 509.
Crescent Typewriter Supply Co. (30 App. D. C. 324), 108, 561, 562.
Davis Trademarks (22 Trademark Record, 50), 118.
Densham (L. R., 1895, 2 Ch. D. 176), 144.
Dibble Mfg. Co. (18 MSS. D. 428), 537.
Dick & Co. (9 Off. Gaz. 538), 112, 508.
In re Dole Bros. (12 Off. Gaz. 939), 102, 510.
Dutcher Temple Co. (Comr. Dec., 1871, p. 248), 64.
Eagle Pencil Co. (10 Off. Gaz. 981), 341, 503, 508.
Eastman (W. N., 1880, p. 128), 124.
Edinburg Correspondent Newspaper (Ct. of Sess. Cas. 1st. ser. 1, new ed., 407 n.), 201.
English (Comm. Decis., 1870, 142), 503.
Excelsior Spring Co. (Newton, Dig. 153), 137.
Fairchild (21 Off. Gaz. 789), 542.
Farben-fabriken T. M. K. (L. R., 1894, 1 Ch. D. 645), 143.
Farina (29 W. R. 391), 399.
Farina (27 W. R. 456), 206.
Farina (44 L. T. N. S. 99), 33.
Farnum & Co. (Comm. Decis., 1880, p. 155), 537.
Finlayson, Bousfield & Co. (61 Off. Gaz. 152), 539.
Fitzpatrick, Davis & Co. (18 MSS. D. 278), 537.
Francis & Mallon (Comm. Decis., 1871, p. 283), 507.
Fremd Bros. & Co. (37 App. D. C. 109), 107.
Glines (8 Off. Gaz. 435), 129.
Godillot (6 Off. Gaz. 641), 501.
Goodall (42 Ch. D. 566), 136.
Goodyear Rubber Co. (11 Off. Gaz. 1062), 101, 507.
Gordon (12 Off. Gaz. 517), 508.
Gorham Mfg. Co. (41 App. D. C. 263), 581.
Graham (2 Off. Gaz. 618), 107.
Green (8 Off. Gaz. 729), 507.
Grossmith (60 L. T. N. S. 612), 120.
Grossmith (6 R. P. C. 180), 211.

References are to pages.

In re Grove (67 Off. Gaz. 1447), 137, 507, 541.
Haggenmacher (60 Off. Gaz. 438), 536.
Hall (13 Off. Gaz. 229), 214, 507.
Hankinson (8 Off. Gaz. 89), 503, 532, 538.
Hanson's Trademark (5 R. P. C. 130), 287.
Harden Fire Extinguisher Co.'s Trademark (55 L. J. Ch. 596), 104.
Hauthaway (1), (Comm. Decis., 1871, p. 97), 507.
Hauthaway (2), (Comm. Decis., 1871, p. 284), 507.
Hayward & Sons (54 L. J. Ch. 1003), 136.
Heaton's Trademark (L. R. 27 Ch. D. 570), 79.
Hendley (72 Off. Gaz. 1654), 541.
Holt & Co.'s Trademark, C. A. (L. R., 1891, 1 Ch. 711), 130.
Hopkins (29 App. D. C. 118), 108, 561, 562.
Horsburgh (53 L. J. Ch. 237), 113, 131, 301.
Horton (45 Law T., N.S., 541), 242.
Hudson's Trademark (3 R. P. C. 155), 63.
Hyde & Co. (7 Ch. D. 724), 136.
Imbs (10 Off. Gaz. 463), 510.
India Rubber Comb Co. (8 Off. Gaz. 905), 509, 510.
India Rubber Comb Co. (16 MSS. D. 38), 537.
Indian Portland Cement Co. (30 App. D. C. 463), 559.
Jackson Company's Trademark (6 R. P. C. 80), 145.
Jelley, Son & Jones (51 L. J. Ch. 639), 307, 467.
J. Marsching & Co. (15 Off. Gaz. 294), 541.
In re John C. Dowd & Co. (C. D., 1908, p. 134), 553.
Johnson (2 Off. Gaz. 315), 105, 108.
Jones (53 L. T. 1), 32.
Jordan (49 Fed. Rep. 238), 467.
Kampfe Bros. (58 MSS. D. 306), 537.
Kane & Co. (9 Off. Gaz. 105), 279, 508.
Keasbey & Mattison Co. (160 U. S. 221), 393, 394, 395, 415.
Kimball (Comm. Decis., 1887, p. 54), 538.
Kimball (11 Off. Gaz. 1109), 504.
Knight (38 MSS. D. 341), 537.
Kuhn & Co.'s Trademark (53 L. J. Ch. 238), 136, 443, 490.
La Société Anonyme des Verreries de l'Estoile (10 R. P. C. 436), 321.
Lawrence & Co. (10 Off. Gaz. 163), 148, 507.
Leonard & Ellis' Trademark (26 Ch. D. 288), 88.
Lisner (13 Off. Gaz. 455), 503.
Lisner (Comm. Decis., 1878, p. 46), 537.
Magnolia Metal Company's Trademarks (14 R. P. C. 621, 627), 165.
Maignen's Application (28 W. R. 759), 121.
Manny & Co. (17 MSS. D. 155), 537.
Manske & Co. (64 Off. Gaz. 858), 535.
Mark Cross Co. (116 O. G. 2534), 584.
Maw, Son & Thompson (22 MSS. D. 403), 537.
McMullen's Estate (157 N. Y. S. 655), 249.
Meyer Bros. Coffee & Spice Co. (32 App. D. C. 277), 98, 563.

References are to pages.

In re Meyer Bros. Coffee & Spice Co. (38 App. D. C. 520), 112.
Meyerstein (7 R. P. C. 114), 110.
Miller (54 L. J. Ch. 205), 436.
Mitchell (L. R. 28 Ch. D. 666), 399.
Mitchell (L. R. 7 Ch. D. 36), 340.
Moet & Chandon (18 MSS. D. 259), 535.
National Candy Co. (35 App. D. C. 351), 126.
National Chemical Co. (134 O. G. 1298), 575.
National Phonograph Co. (C. D., 1907, p. 550), 561.
National Phonograph Co. (29 App. D. C. 142), 111.
New South Brewery & Ice Co. (32 App. D. C. 591), 101.
O'Donnell (Fed. Case No. 10434), 531.
Palmer (24 Ch. D. 504), 91, 99, 136.
Palmer (L. R. 21 Ch. D. 47), 418.
Park (12 Off. Gaz. 2), 502, 508.
Parker (13 Off. Gaz. 323), 501, 508.
Perry Davis & Son (58 L. T. N. S. 695), 9.
Pierce (23 MSS. D. 16), 537.
Porter Blanchard's Sons (Comm. Decis., 1871, p. 97), 507, 509.
Pratt & Farmer (10 Off. Gaz. 866), 507.
Price's Patent Candle Co. (L. R. 27 Ch. D. 681), 107.
Proctor, Jr. (51 Off. Gaz. 1785), 541.
Rabone (Seb. 642), 307.
Rader (13 Off. Gaz. 596), 105, 508.
Rader & Co. (Comm. Decis., 1878, p. 67), 507.
In re Railton (25 MSS. D. 321), 541.
Railton (Newton, Dig. 213), 147.
Randall's Estate (8 N. Y. Supp. 652), 222, 240.
Richardson (3 Off. Gaz. 120), 109, 507.
Riviere's Trademark (L. R. 26 Ch. D. 53), 437.
Riviere (53 L. T. N. S. 237), 402.
Roach (10 Off. Gaz. 333), 101, 507.
Roberts (1), (Comm. Decis. 113), 509.
Roberts (2), (Comm. Decis. 100), 509.
Roberts (3), (Comm. Decis. 101), 509.
Roberts (4), (Comm. Decis. 100), 507.
Rohland (10 Off. Gaz. 980), 120, 507.
Rotherham (29 W. R. 503), 144.
Rothschild (7 Off. Gaz. 220), 502, 539.
Rubber Clothing Co. (10 Off. Gaz. 111), 510.
Rust (29 W. R. 393), 399.
Rowe & Post (9 Off. Gaz. 496), 509.
Safety Remedy Co. (35 App. D. C. 353), 99.
Sanitas Co. (4 R. P. C. 533), 143.
Saunion & Co. (Cox, Manual, No. 625), 79, 98.
S. C. Herbst Importing Co. (30 App. D. C. 297), 118, 559.
Schmidt (53 MSS. D. 7), 535.
Simpson & Sons (10 Off. Gaz. 333), 501.
Snook (2 Hilt. 566), 171.
Societe Anonyme Dubonnet (31 R. P. C. 453, 468), 141.
Speer's Trademark (4 R. P. C. 521), 321.

References are to pages.

In re Standard Underground Cable Co. (27 App. D. C. 320), 552.
Swezey (62 How. Pr. 215), 31.
Sykes (43 L. T. N. S. 626), 63.
Talbot (8 R. P. C. 149), 102.
Tampa Suburban R. Co. (168 U. S. 583), 466.
Thayer (54 Off. Gaz. 957), 539.
The Australian Wine Importers Ltd. (L. R. 41 Ch. D. 278, 281), 5.
Thewlis & Blakey's Trademark (10 R. P. C. 369), 323, 332.
Thomas (14 Off. Gaz. 821), 506, 508.
Thomas (35 Fed. Rep. 337), 485.
Tolle (2 Off. Gaz. 415), 159, 418, 507.
Vidvard & Sheehan (8 Off. Gaz. 143), 503, 505.
Volta Belt Co. (8 Off. Gaz. 144), 504, 537.
Walden Bros. Clothing Co. (199 Fed. Rep. 315), 469.
Warburg (13 Off. Gaz. 44), 100, 507.
Watson (16 MSS. D. 467), 538.
Weaver (10 Off. Gaz. 1), 125, 508, 540.
Weisman (Newton, Dig. 119), 147.
Welch (137 N. Y. S. 941), 249.
Wellcome (L. R. 32 Ch. D. 213), 27, 36.
Western Electric Co. (39 App. D. C. 420), 105.
Whitaker (Newton's Dig. 130), 279.
Whiteley (43 L. T. N. S. 627), 307.
Whyte (Comm. Decis., 1871, p. 304), 501.
Worthington's Trademark (L. R. 14 Ch. D. 8), 287, 323, 468.
In re Wright & Taylor (33 App. D. C. 510), 563.
Wright, Crossley & Co.'s Application (17 R. P. C. 386), 217.

J

Jackson v. Ashton (8 Pet. 148), 414.
v. Byrnes (103 Tenn. 698), 231.
v. Morgan (49 Ind. App. 376), 365.
Jacobs v. Beecham (221 U. S. 263), 82.
Jacoby & Co. v. Lopez & Co. (23 Off. Gaz. 342), 511, 545.
Jacoway v. Young (228 Fed. Rep. 630), 126, 266, 395.
Jaeger's Sanitary W. S. Co. v. Le Boutillier (47 Hun, 521), 26.
Jaffe v. Evans & Sons, Ltd. (75 N. Y. Supp. 257), 137.
James v. James (L. R. 13 Eq. 421), 106, 177, 253, 436.
v. Parry (3 R. P. C. 340), 141.
James B. Sipe Co. v. Columbia Refining Co. (171 Fed. Rep. 295), 266.
Jameson v. Dublin Distillers' Co. 1900 (Ir. Ch. 43), 176.
James Van Dyk Co. v. F. V. Reilly Co. (130 N. Y. S. 755), 221.
Janney v. Pan-Coast Ventilator Mfg. Co. (128 Fed. Rep. 121), 217, 329.
v. Pan-Coast Ventilator & Mfg. Co. (2), (131 Fed. Rep. 143), 476.
J. & P. Baltz Brew. Co. v. Kaiserbrauerei, Beck & Co. (20 C. C. A. 402), 105.
J. & P. Coats v. John Coates Thread Co. (135 Fed. Rep. 177, 179), 188.
J. & R. Carr v. Schollhorn Co. (C. D., 1912, p. 222), 572.

References are to pages.

Jaros Underwear Co. v. Fleece Underwear Co. (60 Fed. Rep. 622), 105, 405.
Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co. (65 Fed. Rep. 424), 440.
v. Simons (49 Fed. Rep. 276), 52.
J. A. Scriven Co. v. Girard Co. (140 Fed. Rep. 794), 326.
v. Morris (154 Fed. Rep. 914, 918), 139.
v. Towles Mfg. Co. (32 App. D. C. 321), 570.
Jay v. Ladler (6 R. P. C. 136), 152, 307.
J. C. Hubinger Bros. Co. v. Eddy (74 Fed. Rep. 551), 440.
Jefferson v. Market (112 Ga. 498), 242.
Jennings v. Johnson (37 Fed. Rep. 364), 29, 152.
Jerome v. Johnson (59 N. Y. Supp. 859), 303, 323.
Jewelers' Mercantile Agency v. Jewelers' Pub. Co. (155 N. Y. 241), 261.
Jewish Colonization Assn. v. Solomon (2), (154 Fed. Rep. 157), 162.
v. Solomon (125 Fed. Rep. 994, 995), 400.
v. Solomon & Germansky (154 Fed. Rep. 157), 147, 128.
J. F. Rowley Co. v. Rowley (154 Fed. Rep. 744), 128, 178.
J. G. Mattingly Co. v. Mattingly (96 Ky. 430), 28, 29, 39.
v. Mattingly (17 Ky. L. Rep. 1), 39.
J. I. Case Works v. J. I. Case Co. (162 Wis. 185), 354.
Job Printers' Union of Chicago v. Kinsley (107 Ill. App. 654), 301.
John Butt & Co. v. Dunnett (L. R., 1899, A. C. 428), 26.
John Jameson & Son v. Reilly (153 N. Y. S. 225), 756.
John T. Dyer Co. v. Schuylkill Stone Co. (185 Fed. Rep. 557), 99.
John T. Lewis Co. v. Phoenix Paint Co. (134 O. G. 1049), 572.
Johns-Manville Co. v. American S. P. Co. (33 App. D. C. 224), 570.
Johnson & Johnson v. Bauer & Black (27 C. C. A. 374), 286, 321, 323, 470.
v. Seabury & Johnson (71 N. J. Eq. 750), 445.
v. Seabury & Johnson (61 Atl. Rep. 5), 72, 446.
Johnson Educator Food Co. v. Sylvanus Smith & Co. (174 O. G. 1027), 567.
Johnson v. Brandau (32 App. D. C. 348), 99.
v. Brandau (134 O. G. 257), 568, 569.
v. Brunor (107 Fed. Rep. 466), 286.
v. Friedhoff (27 N. Y. Supp. 982), 249.
v. Hitchcock (3 N. Y. Supp. 680), 312, 319.
v. Moss (45 Cal. 515), 234.
v. Orr Ewing (7 App. Cas. 219, 228), 17, 43, 337.
v. Schenck (Fed. Cas. No. 7412), 8.
v. Seaman (108 Fed. Rep. 951), 93.
Johnson Steel Street Rail Co. v. North Branch Steel Co. (48 Fed. Rep. 191), 263.
Jones v. Andrews (10 Wall. 327), 414.
v. Goode (28 Ohio Cir. Ct. Rep. 475), 264.

References are to pages.

Jones v. Knowles (1 Crunch C. C. 523), 485.
Joseph Banigan Rubber Co. v. Bloomingdale (89 Off. Gaz. 1670), 114, 544.
Joseph Dixon Crucible Co. v. Benham (4 Fed. Rep. 527), 467.
Joseph v. Macowsky (96 Cal. 518), 79.
Joseph S. Baum Merc. Co. v. Levin (Mo. App.), (174 S. W. Rep. 442), 717.
Josselyn v. Swezey & Dart (15 Off. Gaz. 702), 510.
J. R. Watkins Medical Co. v. Sands (83 Minn. 326), 64, 253.
Juan F. Portuondo Cigar Mfg. Co. v. Vincente Portuondo Cigar Mfg. Co. (70 Atl. Rep. 968), 127.
Judson v. Malloy (40 Cal. 299), 216.
Julian v. Hoosier Drill Co. (78 Ind. 408), 70, 122, 213.
Julious Kessler & Co. v. Goldstrom (177 Fed. Rep. 392, 394), 454.
Jurgensen v. Alexander (24 How. Pr. 269), 490, 905.

K

Kahn v. W. A. Gaines & Co. (161 Fed. Rep. 495), 38, 446.
Kaiserbrauerie v. Baltz Brewing Co. (71 Fed. Rep. 695), 105, 124.
Kann v. Diamond Steel Co. (89 Fed. Rep. 706), 294, 321, 323, 332, 337.
Kassel v. Jeuda (70 N. Y. Supp. 480), 286.
Kathreiner's Malz Kaffee Fab. v. Pastor Kneipp Med. Co. (27 C. C. A. 351), 26.
Kaufmann v. Kaufmann (239 Pa. 42), 221.
Keasbey v. Brooklyn Chemical Works (142 N. Y. 467-476), 138, 195.
v. Brooklyn Chemical Works (37 N. E. Rep. 476), 117.
Keasbey Co. v. Portland Cementfabrik (133 O. G. 1936), 569.
Keller v. B. F. Goodrich Co. (117 Ind. 556), 450.
Kellog v. Totten (16 Abb. Pr. 35), 228.
Kelly v. Byles (40 L. T. 623), 109.
Kelso v. Reid (145 Pa. 606), 248.
Kennedy v. Dr. David Kennedy Corp. (66 N. Y. Supp. 225-229), 353.
Kennedy Corp. v. Kennedy (55 N. Y. Supp. 917), 353.
Kenny v. Gillet (70 Md. 574), 79.
Kentucky Distilleries & Warehouse Co. v. Old Lexington Club Dist. Co. (31 App. D. C. 223), 108, 560, 563.
v. Wathen (110 Fed. Rep. 641-644), 327.
Kerry v. Toupin (60 Fed. Rep. 272), 130, 286, 290.
Keuffel & Esser Co. v. H. S. Crocker Co. (118 Fed. Rep. 187), 324, 325, 326, 327, 329, 331.
Key West Cigar Mfrs. Assn. v. Rosenbloom (171 Fed. Rep. Rep. 296), 167.
Keystone Oil & Mfg. Co. v. Buzby (135 C. C. A. 185), 183.
Keystone Type Foundry v. Portland Pub. Co. (186 Fed. Rep. 690), 357.
v. Portland Pub. Co. (180 Fed. Rep. 301), 357, 454.
v. Portland Pub. Co. (108 C. C. A. 508), 370.
Kidd v. Horry (28 Fed. Rep. 773), 273.

References are to pages.

Kidd v. Johnson (100 U. S. 617), 22, 26, 34, 39, 68, 125, 181, 213, 223, 399.
Kidd & Co. v. Mills, Johnson & Co. (5 Off. Gaz. 337), 125, 399.
Kinahan v. Bolton (15 Ir. Ch. 75), 340, 341, 398.
v. Kinahan (15 Ir. Ch. 75), 294.
Kingsley v. Jacoby (20 N. Y. Supp. 44), 356.
Kinney v. Allen (1 Hughes 106), 339, 508.
v. Basch (Seb. 542), 39, 130, 341.
v. Basch (16 Am. Law Reg. N. S. 596), 329.
Kinney Tob. Co. v. Maller (53 Hun, 340), 130.
Kipling v. G. P. Putnam's Sons (120 Fed. Rep. 631), 8, 198.
Kirkpatrick v. Pope Mfg. Co. (61 Fed. Rep. 46), 472.
Kirstein Sons & Co. v. Cohen Bros. 9 Can. Sup. Ct. 286), 334.
Klotz v. Hecht (73 Fed. Rep. 822), 52, 167.
Knabe Bros. Co. v. American Piano Co. (229 Fed. Rep. 23), 176, 495.
Knickerbocker Chocolate Co. v. Griffing (144 Fed. Rep. 316), 314.
Knoedler v. Boussod (47 Fed. Rep. 465), 219, 223, 231, 240.
v. Glaenzer (55 Fed. Rep. 895), 219, 223, 230, 231, 232, 240.
Knott v. Morgan (2 Keen. 213), 50.
Knowles v. Jones (182 Ala. 187), 248.
Knox v. Columbia Liberty Iron Co. (42 Fed. Rep. 378), 467.
Koebel v. Chicago Landlord's Protective Bureau (210 Ills. 176), 328.
Kohler v. Sanders (122 N. Y. 65), 79, 105.
Kohler Mfg. Co. v. Beeshore (2), (59 Fed. Rep. 572-574), 27, 254, 334, 386.
v. Beeshore (8 C. C. A. 215), 217, 386.
v. Beeshore (1), (53 Fed. Rep. 262-264), 386, 537.
Kostering v. Seattle Brewing & Malting Co. (54 C. C. A. 76), 128, 307, 345.
Kramer v. Old (119 N. C. 1), 242, 248.
Krauss v. Jos. R. Peebles' Sons Co. (58 Fed. Rep. 585), 77, 316, 417, 442.
Kroegher v. McConway & Forley Co. (149 Pa. St. 444-457), 265.
Kronthal Waters v. Becker (137 Fed. Rep. 649, 652), 30.
Kroppf v. Furst (94 Fed. Rep. 150), 51, 52.
Kutroff v. Cassella Color Co. (129 O. G. 3159), 569.
Kyle v. Perfection Mattress Co. (127 Ala. 39), 127.

L

L. & B. Mfg. Co. v. Barthels Mfg. Co. (221 Fed. Rep. 456, 459), 8.
Labouchere v. Dawson (L. R. 13 Eq. 322), 240.
Laclaucha Battery Co. v. Western Electric Co. (21 Fed. Rep. 538), 451.
Lacroix v. Escobal (37 La. Ann. 533), 503, 539.
La Croix v. May (15 Fed. Rep. 236), 66, 68, 547.
v. Sarrazzin (15 Fed. Rep. 489), 467.
Lafayette Ins. Co. v. French (18 How. 404), 414.
Laird v. Wilder (2 Bush, Ky., 131), 79.

References are to pages.

Lalance & Grosjean Mfg. Co. v. National Enameling & Stamping Co. (109 Fed. Rep. 317), 286.
Lamb v. Evans (L. R., 1892, 3 Ch. 462), 258, 261.
Lambert Pharmacal Co. v. Bolton Chem. Corp. (219 Fed. Rep. 325), 125, 328.
v. Kalish Pharmacy (219 Fed. Rep. 323), 125, 328.
Lamont v. Leedy (88 Fed. Rep. 72), 101, 430.
Lamont, Corliss & Co. v. Hershey (140 Fed. Rep. 763), 53, 295.
Lampert v. Judge & Dolph Drug Co. (119 Mo. App. 693), 318, 419, 420.
v. Judge & Dolph Drug Co. (238 Mo. 409), 318, 419, 420.
Lamplough v. Balmer (W. N., 1867, p. 293), 82.
Lanahan v. John Kissel & Son (135 Fed. Rep. 899), 122, 449.
Lendreth v. Landreth (22 Fed. Rep. 41), 174, 177, 286.
Lane v. Smythe (46 N. J. Eq. 443-454), 222.
Lang v. Green River Dist. Co. (33 App. D. C. 506), 122, 560, 570.
Lantz Bros. & Co. v. Schultz & Co. (9 Off. Gaz. 791), 510.
Lare v. Harper & Bros. (86 Fed. Rep. 481), 452, 476.
La Republique Francaise v. Saratoga Vichy Springs Co. (99 Fed. Rep. 733), 473.
v. Saratoga Vichy Spring Co. (191 U. S. 427, 435), 192.
v. Saratoga Vichy Springs Co. (46 C. C. A. 418), 193.
v. Schultz (42 C. C. A. 233), 206.
v. Schultz (4), (115 Fed. Rep. 196), 35.
La Republique Francaise v. Schultz (57 Fed. Rep. 37), 8, 160.
v. Schultz (94 Fed. Rep. 500), 52.
Larkin Co. v. Pacific Coast Borax Co. (132 O. G. 679), 571, 573.
Larrabee v. Lewis (67 Ga. 561), 6, 111.
Lashus v. Chamberlain (6 Utah, 385), 223, 249.
Lauferty v. Wheeler (11 Abb. N. C. 220), 86, 114, 166.
Laughman's Appeal (128 Pa. 1), 30.
Lavanburg v. Pfeiffer (66 N. Y. Supp. 39), 318.
v. Pfeiffer (52 N. Y. Supp. 801), 318.
Lavergne v. Hooper (Ind. L. R. 8 Mad. 149), 210, 402, 417.
Lawlor v. Charles H. Merritt & Son (78 Conn. 630), 63.
v. Merritt (79 Conn. 399), 63.
Lawrence v. Times Printing Co. (90 Fed. Rep. 24-26), 252.
Lawrence Mfg. Co. v. Lowell (129 Mass. 325), 339, 341.
v. Tennessee Mfg. Co. (31 Fed. Rep. 776), 418.
v. Tennessee Mfg. Co. (138 U. S. 537), 42, 47, 51, 94, 134, 149, 157, 172, 193, 214, 294, 295, 537.
Lawson v. Bank of London (18 C. B. 84), 415.
Lazenby v. White (41 L. J. Ch. 354), 104, 213, 214.
Lea v. Deakin (Fed. Case No. 8154), 113, 159, 214.
v. Millar (Seb. 513), 213, 214.
v. Wolff (15 Abb. Pr. N. S. 1), 168, 442.
v. Wolff (13 Abb. Pr. N. S. 389), 159.
Leahy v. Glover (10 R. P. C. 141), 443, 469.

References are to pages.

Lean v. Fleming (96 U. S. 245), 174.
Leather Cloth Case (11 H. L. C. 523), 11, 33, 42, 182, 304.
Leather Cloth Co. v. American Leather Cloth Co. (4 DeG. J. & S. 137, 141), 16, 26, 27, 168, 424.
v. American Leather Cloth Co. (35 L. J. Ch. 61), 4.
v. American Leather Cloth Co. (11 Jur. N. S. 513), 79, 83, 213.
v. Hirschfeld (1 N. R. 551), 85.
v. Hirschfeld (2), (1 H. & M. 295), 471.
v. Lorsont (L. R. 9 Eq. 345), 82.
Leclanche Battery Co. v. Western Electric Co. (21 Fed. Rep. 538), 452, 476.
v. Western Elec. Co. (23 Fed. Rep. 276), 139.
Lee v. Haley (5 Ch. App. Cas. 155), 202, 442.
v. Haley (22 L. T. N. S. 251), 206.
v. Haley (21 L. T. N. S. 546), 39, 312.
Lehigh Valley Coal Co. v. Hamblen (23 Fed. Rep. 225, 226), 187.
Leidersdorf v. Flint (8 Biss. 327), 5, 378, 501.
v. Flint (2), (50 Wis. 401), 422.
Lemke v. Dietz (121 Wis. 102), 30.
Lemoine v. Gauton (2 E. D. Smith, 343), 22, 68, 213, 423.
Leonard v. Wells (L. R. 26 Ch. D. 288), 131.
v. White's Golden Lubricator Co. (38 Fed. Rep. 922), 131, 442.
Le Page Co. v. Russian Cement Co. (2 C. C. A. 555), 29, 417, 421, 423.
v. Russia Cement Co. (51 Fed. Rep. 941), 176.
Lepou v. Kottler (100 N. Y. Supp. 779), 32.
Leprince v. Iler & Morris (92 Off. Gaz. 189), 539.
Lester H. Greene Co. v. Scott & Bowne (159 O. G. 242), 563.
Lever v. Bedingfield (80 L. T. N. S. 100), 50, 152.
v. Goodwin (4 R. P. C. 492-506), 152.
Lever Bros. v. Pasfield (88 Fed. Rep. 484), 130, 331, 469.
Lever Bros., Ltd., Boston Works v. Smith (112 Fed. Rep. 998), 332.
Levy v. Waitt (1), (56 Fed. Rep. 1016), 26, 62, 116.
v. Waitt (2), (10 C. C. A. 227), 70, 72.
v. Waitt (21 U. S. App. 294), 17.
v. Waitt (61 Fed. Rep. 1008-1011), 26, 62, 64.
v. Walker (L. R. 10 Ch. D. 463), 29.
Levy & Co. v. Uri (31 App. D. C. 441), 561.
Levyeau v. Clements (175 Mass. 376), 260.
L. E. Waterman Co. v. Modern Pen Co. (235 U. S. 88), 176.
Lewis v. Bloede (202 Fed. Rep. 7, 24), 364.
v. Chapman (3 Beavan, 133), 148.
v. Goodwin (36 Ch. D. 1), 457.
v. Klapproth (11 Vict. L. R., E, 214), 418.
v. Langdon (7 Sim. 421), 29, 244.
Lewis & Nelson's Appeal (67 Pa. 153, 166), 445.
L. H. Harris Drug Co. v. Stucky (46 Fed. Rep. 624), 19, 101, 387, 532, 536, 540.
Lichtenstein v. Goldsmith (37 Fed. Rep. 359), 120, 216.

References are to pages.

Liebig's Extract Co. v. Hanbury (17 L. T. N. S. 298), 106, 214.
Liebig's Extract of Meat Co. v. Libby, McNeill & Libby (103 Fed. Rep. 87), 106.
v. Liebig Extract Co. (172 Fed. Rep. 158), 189.
v. Walker (115 Fed. Rep. 822), 106, 385.
Liggett & Myers Tob. Co. v. Finzer (128 U. S. 182), 311, 335, 346.
v. Hynes (20 Fed. Rep. 883), 19, 129, 279, 294, 302, 321, 345, 467, 508.
v. Sam Reid Tob. Co. (104 Mo. 53), 129, 311, 424.
Lilienthal v. Drucklieb (84 Fed. Rep. 918), 251.
Linde v. Bensel (22 Hun, 29 N. Y. Sup. Ct., 601), 398.
Linoleum Mfg. Co. v. Nairn (L. R. 7 Ch. D. 834), 88, 106, 137, 171.
Linton v. First National Bank of Kittanning (10 Fed. Rep. 894-897), 171.
Lippincott v. Hubbard (28 Pitts. L. J. 303), 28, 31.
Lippman v. People (175 Ill. 101). 668.
Listman Mill Co. v. Wm. Listman Mill Co. (88 Wis. 334), 28.
v. William Listman Milling Co. (60 N. W. Rep. 261), 125.
Little v. Gallus (38 N. Y. Supp. 487), 254, 256, 262.
v. Kellam (100 Fed. Rep. 353), 331.
Littlejohn v. Mulligan (3 New Zealand Rep. 446), 458.
Livermore v. White (74 Me. 452), 216.
Llewellyn v. Rutherford (L. R. 10 C. P. 456), 229.
Lockport Canning Co. v. Pusateri (139 N. Y. S. 640), 125.
Lockwood v. Bostwick (2 Daly, 521), 116, 324.
Loewe v. Lawlor (130 Fed. Rep. 633), 376.
v. Lawlor (208 U. S. 274), 376.
Longman v. Tripp (2 Bos. & P. N. R. 67), 31.
v. Winchester (16 Ves. 269), 199.
Lord v. Whitehead & Atherton Machine Co. (24 Fed. Rep. 801), 426, 472.
Lorillard v. Pride (28 Fed. Rep. 434), 89, 279, 281, 508, 538.
v. Wight (15 Fed. Rep. 383), 281, 286, 508.
Louis Bergdoll Brew. Co. v. Bergdoll Brew. Co. (218 Fed. Rep. 131, 132), 19, 581.
Louise & Co., Ltd. v. Gainsborough (20 R. P. C. 61), 217.
Love v. Stidham (18 App. D. C. 306), 242.
Lovell-McConnell Mfg. Co. v. American Ever-Ready Co. (195 Fed. Rep. 931), 371.
Loven v. People (158 Ills. 159), 361.
Low v. Fels (35 Fed. Rep. 361-363), 454.
v. Hall (47 N. Y. 104), 756.
v. Hart (90 N. Y. 457), 404, 443.
Lowe Bros. Co. v. Toledo Varnish Co. (168 Fed. Rep. 627), 122, 441.
Lowell Manufacturing Co. v. Larned (Fed. Case No. 8570), 508.
v. Larned (Cox, Manual, No. 428), 65.
Lucker v. Phoenix Assurance Co. (67 Fed. Rep. 18), 472.
Luddington Novelty Co. v. Leonard (119 Fed. Rep. 937.
Ludington Novelty Co. v. Leonard (127 Fed. Rep. 155, 157), 454.
v. Leonard (62 C. C. A. 269), 457.

References are to pages.

Ludlow Valve Mfg. Co. v. Pittsburg Mfg. Co. (166 Fed. Rep. 26, 29), 44.
Lumley v. Gye (2 El. & Bl. 216), 364.
Lumpkin v. Foley (204 Fed. Rep. 372), 469.
Luten v. Camp (221 Fed. Rep. 424), 488.
Lux v. Haggin (69 Cal. 255-269), 208.
Luyties v. Hollender (27 Blatchf. 413), 385, 392, 415.
v. Hollender (1), 21 Fed. Rep. 281), 379, 429, 547.
v. Hollender (2), 30 Fed. Rep. 632), 105, 393, 547.
Lyman v. Burns (47 Off. Gaz. 660), 127.
Lynch v. John Single Paper Co. (101 N. Y. Supp. 824), 63.
Lysney v. Selby (2 Ld. Raym. 1118), 251.

M

Macbeth-Evans Glass Co. v. General Electric Co. (231 Fed. Rep. 183), 358.
v. Schnelbach (239 Pa. 76), 257, 261, 267.
Macdonald v. Richardson (1 Giff. 81), 222.
Macmahan Pharmacal Co. v. Denver Chemical Mfg. Co. (113 Fed. Rep. 468), 26, 72.
Madame Irene v. Schweinburg (C. D., 1912, p. 114), 573.
Magee Furnace Co. v. LeBarron (127 Mass. 115), 315.
Magic Curler Co. v. Porter (128 O. G. 2088), 577.
Magnolia Metal Co.'s Trademarks (66 L. J. Ch. N. S. 312), 106.
Mahler v. Sanche (223 Ills. 136), 471.
Major Brothers v. Franklin (1908, 1 K. B. 712), 9.
Mandeville v. Harman (42 N. J. Eq. 185), 225.
Manhattan Medicine Co. v. Wood (108 U. S. 218), 29, 76, 77, 81, 132, 165, 214, 279.
v. Wood (Fed. Case No. 9026), 20, 58, 345.
Manitowoc Malting Co. v. Milwaukee Malting Co. (119 Wis. 543), 49, 51, 279, 311.
Manitowoc Mfg. Co. v. Dickerman (57 Off. Gaz. 1721), 69, 389, 544, 545.
Manitowoc Pea-Packing Co. v. William Numsen & Sons (93 Fed. Rep. 196), 168.
Manufacturing Co. v. Trainer (101 U. S. 51-64), 302.
Marconi Wireless Tel. Co. v. National Elec. Signaling Co. (206 Fed. Rep. 295), 431.
Marcovitch v. Bramble, Wilkins & Co. (Cox, Manual, No. 595), 474.
Marcus v. McFarland (119 Md. 269), 233.
Marcus Ward & Co. v. Ward (40 N. Y. State Rep. 792), 239.
v. Ward (15 N. Y. Supp. 913), 174.
Margarete Steiff v. Bing (124 C. C. A. 560), 291.
Margarete Steiff, Inc. v. Bing, D. C., (215 Fed. Rep. 204), 291, 371.
Market Co. v. Hoffman (101 U. S. 112), 393.
Marks v. Jaffa (26 N. Y. Supp. 908), 271.
Marlin Fire Arms Co. v. Shields (171 N. Y. 384), 56.
Marsh v. Billings (7 Cushing, 322, 332), 310, 355, 422.
v. Warren (14 Blatchf. 263), 514.

References are to pages.

Marsh, et al., v. Warren, et al. (14 O. G. 678), 516.

Marshall v. Hawkins (4 N. Z. L. R. Sup. Ct. 59), 301.
v. Pinkham (52 Wis. 572), 106, 214, 418.
v. Ross (L. R. 8 Eq. 651), 86, 331.

Marshall Engine Co. v. New Marshall Engine Co. (89 N. E. Rep. 548), 106.
v. New Marshall Engine Co. (203 Mass. 410, 422), 232.

Martell v. St. Francis Hotel Co. (51 Wash. 375), 183.

Martha Washington Creamery Buttered Flour Co. v. Martien (44 Fed. Rep. 473), 59, 449.

Martin v. Bowker (163 Mass. 461), 694.
v. Martin & Bowne Co. (27 App. D. C. 59), 565.
v. Murphy (129 Ind. 464), 225, 246, 247, 248.
v. Wright (6 Sim. 207), 53.

Marvel v. Jonah (81 N. J. Eq. 369), 248.

Marvel Co. v. Pearl (133 Fed. Rep. 160, 162), 113.
v. Pearl (66 C. C. A. 226), 292.
v. Tullar Co. (125 Fed. Rep. 829), 292.

Mass, Ratcliff & Gretton, Ltd., v. Feigenspan (96 Fed. Rep. 206), 546.

Massam v. Cattle Food Co. (L. R. 14 Ch. D. 748), 27.

Matsell v. Flanagan (2 Abb. Pr. N. S. 459), 200, 202.

Matter of Hondayer (150 N. Y. 37), 226.

Matthews v. Murchison (17 Fed. Rep. 760-766), 208.

Maxwell v. Hogg (L. R. 2, Ch. 307), 70, 436.

Maxwell Steel Vault Co. v. National Casket Co. (205 Fed. Rep. 515), 428, 435.

Mayer v. Flanagan (12 Tex. Civ. App. 405), 29.

Mayer Fertilizer & Junk Co. v. Virginia-Carolina Chem. Co. (35 App. D. C. 425), 71, 222.

McAndrew v. Bassett (4 DeG. J. & S. 380-386), 26, 64, 114, 490, 492.

McAuliffe v. Vaughan (135 Ga. 852), 248.

McCall v. Theal (28 Grant, Up. Can., Ch. 48), 99.
v. Wright (198 N. Y. 143), 257.

McCann v. Anthony (21 Mo. App. 83), 286, 306, 337, 399, 444.

McCardel v. Peck (28 How. Pr. 120), 209, 355.

McCaw, Stevenson & Orr, Ltd. v. Lee Bros. (23 R. P. C. 1), 333.
v. Nickols (21 R. P. C. 15), 330.

McCord v. Williams (96 Pa. St. 78), 242.

McCurry v. Gibson (108 Ala. 451), 248.

McElwee v. Blackwell (15 Off. Gaz. 658), 502, 505, 512.

McGowan v. McGowan (22 Ohio St. 370), 230, 243, 244.

McGraw Tire & Rubber Co. v. Griffith (198 Fed. Rep. 566), 123.

McGrew Coal Co. v. Menefee (162 Mo. App. 209), 43.
v. Menefee (144 S. W. Rep. 869), 102.

McIlhenny v. New Iberia Co. (30 App. D. C. 337), 577.
v. New Iberia Extract of Tabasco Pepper Co. (34 App. D. C. 430), 112.

McLean v. Fleming (96 U. S. 245), 4, 9, 29, 31, 42, 50, 132, 177, 182, 184, 206, 293, 294, 303, 304, 346, 424, 428, 442, 448, 451, 490, 494, 872.

References are to pages.

McLennan v. Railroad Co. (22 Fed. Rep. 198), 484.
McMurtrie v. Guiler (183 Mass. 451), 454), 239.
McVeagh v. Valencia Cigar Factory (32 Off. Gaz. 1124), 27.
McVey v. Brendel (144 Pa. St. 235), 62.
Medicine Co. v. Wood (108 U. S. 218, 222), 132.
Medlar & Holmes Shoe Co. v. Delsarte Mfg. Co. (N. J. Eq. 46 Atl. Rep. 1089), 119.
Meikle v. Williamson (27 R. P. C. 775), 388.
Melachrino v. Melachrino Cigarette Co. (4 R. P. C. 215), 172, 179, 215, 444.
Mellersh v. Keen (28 Beav. 453), 230, 249.
Mellin v. White, L. R. (1895, A. C. 154), 55.
Mellwood Dist. Co. v. Harper (167 Fed. Rep. 389), 125, 328.
Memphis Keeley Institute v. Leslie E. Keeley Co. (84 C. C. A. 112), 441.
v. Leslie E. Keeley Co. (75 C. C. A. 430), 465.
Meneely v. Meneely (62 N. Y. 427), 172.
v. Meneely (1 Hun, 367), 174.
Menendez v. Holt (128 U. S. 514), 9, 26, 28, 35, 62, 121, 124, 133, 144, 210, 211, 219, 222, 245, 294, 442.
Merchants' Ad-Sign Co. v. Sterling (124 Cal. 429), 236.
Meriden Britannia Co. v. Parker (39 Conn. 450), 79, 444.
Merriam v. Famous Shoe & Clothing Co. (47 Fed. Rep. 411), 99, 197.
v. Holloway Pub. Co. (43 Fed. Rep. 450), 197.
Merriam v. Saalfield (198 Fed. Rep. 369, 372), 18.
v. Texas Siftings Pub. Co. (49 Fed. Rep. 944), 113, 198.
Merriam Co. v. Oglivie (159 Fed. Rep. 638), 93.
v. Syndicate Pub. Co. (237 U. S. 618, 622), 91, 563.
Merry v. Hoopes (111 N. Y. 420), 28.
Merryweather v. Moore (L. R., 1892, p. 2), 257, 258.
Messer v. The Fadettes (168 Mass. 140), 180.
Messerole v. Tynberg (36 How Pr. 14), 170.
v. Tynberg (4 Abb. Pr. N. S. 410), 16, 116.
Metcalf v. Hanover Star Mill Co. (204 Fed. Rep. 211), 72.
Metropolitan Bank v. St. Louis Dispatch Co. (36 Fed. Rep. 722-724), 219, 226.
v. St. Louis Dispatch Co. (149 U. S. 436-446), 219, 221, 226.
Metzler v. Wood (L. R. 8 Ch. D. 606), 445.
Meyer v. Labau (51 La. Ann. 1726), 242.
v. Bull Medicine Co. (7 C. C. A. 558), 152.
v. Bull Medicine Co. (66 Off. Gaz. 197), 177.
Meyers v. Kalamazoo Buggy Co. (54 Mich. 215), 181.
v. Merillion (118 Cal. 352), 248.
Michigan Condensed Milk Co. v. Kenneweg Co. (30 App. D. C. 491), 111.
Milbank v. Milbank (1900, p. 1, Ch. 385), 435.
Mill Co. v. Alcorn (150 U. S. 460), 193.
Millbrae Co. v. Taylor, Cal. (37 Pac. Rep. 235), 80.

References are to pages.

Miller v. Beck, Iowa (72 N. W. Rep. 553), 250.
v. Keeler (9 Pa. Co. Ct. R. 274), 225.
Miller Tobacco Manufacturing Co. v. Commerce (45 N. J. Law, 18, 24), 296.
Mills v. Ressler (87 Kan. 549), 225.
Millington v. Fox (3 Mylne & Cr. 388), 293, 310, 340, 491, 493.
Milwaukee R. R. Co. v. Arms (91 U. S. 487, 492), 421.
Mines v. Scribner (147 Fed. Rep. 927), 376.
Miskell v. Prokop (58 Nebr. 628), 320.
Mississippi & Mo. R. R. Co. v. Ward (2 Black, 485), 393.
Mississippi Wire Glass Co. v. Continuous Glass Press Co. (81 Atl. Rep. 374), 113.
Missouri Pacific Railway v. Humes (115 U. S. 512, 521), 421.
Mitchell v. Henry (L. R. 15 Ch. D. 181), 468.
v. Read (84 N. Y. 556), 249.
M. J. Breitenbach Co. v. Spangenberg (131 Fed. Rep. 160), 127, 145, 329.
Modox Co. v. Moxie Nerve Food Co. (162 Fed. Rep. 649, 651), 477.
Moebius v. Louis De Jonge & Co. (215 Fed. Rep. 443), 334.
Moet v. Clybonn (Seb. 533), 340.
v. Couston (33 Beav. 578), 310, 491, 492.
v. Pickering (L. R. 8 Ch. D. 372), 340, 342, 405, 493.
v. Pickering (L. R. 6 Ch. D. 770), 404, 405.
Monarch v. Rosenfeld (19 Ky. Law Rep. 14), 187.
Monarch Tobacco Co. v. American Tobacco Co. (165 Fed. Rep. 774), 375, 376.
Monopol Tobacco Works v. Genisor (66 N. Y. Supp. 155), 467.
Monro v. Smith (13 N. Y. Supp. 708), 301.
Monroe Cattle Co. v. Becker (147 U. S. 47), 536.
Monson v. Boehm (L. R. 26 Ch. D. 398, 407, 408), 70, 211.
Montague & Co. v. Lowry (193 U. S. 38), 375.
Montgomerie v. Donald (Ct. Sess. Cas., 4th ser., 11506), 113.
Montgomery v. Thompson (1891, App. Cas. 217), 172.
Montgomery Ward & Co. v. South Dakota, etc., Assn. (150 Fed. Rep. 413), 56.
Moody v. Thomas (1 Disney, 294), 231.
Moore v. Rawson (199 Mass. 494), 225.
v. Rawson (185 Mass. 264), 34, 239.
v. Rugg (44 Minn. 28), 259.
v. Stevenson (27 Conn. 14), 216.
Moorehead v. Hyde (38 Iowa, 382), 250.
Moorman & Givens v. Parkerson (131 La. 204), 249.
v. Hoge (2 Sawyer, 78, 85), 19, 279, 503, 508, 536.
v. Hoge (Fed. Case No. 9783), 141, 418.
Moreau v. Edwards (2 Tenn. Ch. 347), 231.
Morgan v. McAdam (36 L. J. Ch. 228), 79, 82, 86.
v. Rogers (19 Fed. Rep. 596), 28, 30, 227.
v. Schuyler (79 N. Y. 490), 240, 244.
Morgan Envelope Co. v. Walton (30 C. C. A. 383), 152, 159.
v. Walton (82 Fed. Rep. 469), 321, 332.

References are to pages.

Morgan Sons Co. v. Troxell (Cox, Manual, 674), 317.
Morison v. Moat (21 L. J. Ch. 248), 256, 259.
Morris v. Alstedter (156 N. Y. S. 1103), 48.
v. Moss (25 L. J. Ch. 194), 222.
Morrison v. Case (9 Blatchf. 548), 129, 508, 540.
v. Salmon (2 Man. & G. 385), 293.
Morse v. Hutchins (102 Mass. 439), 251.
Morse v. Worrell (10 Phila. 168), 128, 444.
Morse Machine Co. v. Morse (103 Mass. 73-75), 253.
Morton v. Morton (82 Pac. Rep. 664), 126.
v. Morton (148 Calif. 142), 178.
Mossler v. Jacobs (65 Ill. App. 571), 129, 331.
Motion Picture Patents Co. v. Eclair Film Co. (208 Fed. Rep. 416), 435.
Motley v. Downman (3 My. & Cr. 1), 293, 340, 401.
Mouson & Co. v. Boehm (L. R. 26 Ch. D. 398), 217.
Moxie Co. v. Daoust (206 Fed. Rep. 434), 369.
v. Daoust (124 C. C. A. 434), 345.
Moxie Nerve Food Co. v. Baumbach (32 Fed. Rep. 205-210), 59, 290, 329, 448.
v. Beach (33 Fed. Rep. 248), 298, 329, 453, 473, 488.
v. Beach (35 Fed. Rep. 465, 466), 255.
v. Holland (141 Fed. Rep. 202, 205), 453.
v. Modox Co. (152 Fed. Rep. 493), 264, 417.
v. Modox Co. (2) (153 Fed. Rep. 487, 489), 446.
v. Modox Co. (3) (155 Fed. Rep. 304), 492.
Mullins v. People (23 How. Pr. 289), 755.
Mumm v. Kirk (40 Fed. Rep. 589), 52, 140.
Munden v. Harris (153 Mo. App. 652), 276.
Munro v. Smith (13 N. Y. Sup. 708), 306, 318.
v. Tousey (129 N. Y. 38), 306.
Munsay v. Butterfield (133 Mass. 492-495), 222, 240.
Murale Co. v. National Lead Co. (36 App. D. C. 541), 567.
Murray v. Engraving Co. (28 N. Y. Supp. 271), 272.
Musselman & Clarkson's Appeal (62 Pa. St. 81), 223.
Myers v. Baker (3 H. & N. 802), 293.
v. Kalamazoo Buggy Co. (54 Mich. 215), 240.
v. Theller (38 Fed. Rep. 607), 286, 314.

N

Nashville Syrup Co. v. Coca-Cola Co. (215 Fed. Rep. 527, 529), 564.
National Biscuit Co. v. Baker (95 Fed. Rep. 135), 9, 12, 131, 135, 344, 345, 349.
v. Ohio Baking Co. (127 Fed. Rep. 160), 123.
v. Swick (121 Fed. Rep. 1007), 286.
National Distilling Co. v. Century Liquor Co. (105 C. C. A. 638), 454.
National Fire Insurance Co. v. Sullard (97 N. Y. App. Div. 233), 362.
National Water Co. v. A. Kron Brewing Co. (197 O. G. 999), 568.
Native Guano Co. v. Sewage Manure Co. (8 P. R. 125), 107.

References are to pages.

National Gum & Mica Co. v. Braendly (51 N. Y. Supp. 93-97), 262.
National Starch Mfg. Co. v. Duryea (41 C. C. A. 244), 175.
v. Koster (146 Fed. Rep. 259), 452.
v. Hertz (177 Fed. Rep. 607), 131, 312.
v. O'Connell (159 Fed. Rep. 1001), 51, 131.
Natural Food Co. v. Williams (30 App. D. C. 348), 111, 567, 570.
Neilson v. Betts (L. R. 5 H. L. R. 1), 422.
Nelson v. Brassington (64 Wash. 180), 247.
v. J. H. Winchell & Co. (203 Mass. 75), 9, 60, 450, 462.
Neostyle Mfg. Co. v. Ellam's Duplicator Co. (21 R. P. C. 185), 315.
Nerve Food Co. v. Baumbach (32 Fed. Rep. 205), 150.
Nesne v. Sundet (101 N. W. Rep. 490), 179.
Neva Stearine Co. v. Mowling (9 Vict. L. R. 98), 214.
Newark Coal Co. v. Spangler (54 N. J. Eq. 354), 174.
Newbro v. Undeland (69 Neb. 821), 445.
Newby v. Railroad Co. (Fed. Case No. 10144), 184.
Newcomer & Lewis v. Scriven Co. (168 Fed. Rep. 621, 624), 88, 282.
New England Confectionery Co. v. National Wafer Co. (224 Fed. Rep. 344), 126.
v. National Wafer Co. (140 C. C. A. 30), 334.
New Home Sewing Machine Co. v. Bloomingdale (59 Fed. Rep. 284), 122, 327.
New Iberia Extract of Tabasco Pepper Co. v. E. McIlhenny's Son (61 So. Rep. 131), 112.
Newman v. Alvord (49 Barb. 588), 39, 95, 97, 164, 167.
v. Alvord (51 N. Y. 189, 193), 7, 21.
v. Pinto (4 R. P. C. 508), 79, 444, 492.
v. Wolfson (69 Ga. 764), 248.
New Orleans v. Steamship Co. (20 Wall. 387-392), 474.
Newport Sand Bank Co. v. Monarch Sand Mining Co. (144 Ky. 7), 14.
New York & Balto. Co. v. New York Co. (9 Fed. Rep. 578, 579), 486.
New York & New Jersey Lubricant Co. v. Young (77 N. J. Eq. 321), 107, 446.
v. O. W. Young, N. J. Ch. (94 Atl. Rep. 570), 107.
New York Asbestos Mfg. Co. v. Ambler Asbestos Air-cell Covering Co. (99 Fed. Rep. 85), 451, 452, 476.
New York Cement Co. v. Coplay Cement Co. (1), (44 Fed. Rep. 277), 110.
v. Coplay Cement Co. (2), (45 Fed. Rep. 212), 32, 58, 110, 164, 401.
New York Herald Co. v. Star Co. (146 Fed. Rep. 204), 202.
v. Star Co. (146 Fed. Rep. 1023), 117.
New York Life Insurance Co. v. Cravens (178 U. S. 389-401), 381.
New York Mackintosh Co. v. Flam (198 Fed. Rep. 571), 116.
Nicholls v. Kimpton (3 Times L. R. 674), 490.
Nicholson v. Wm. A. Stickney Cigar Co. (158 Mo. 158), 303.

References are to pages.

Nixey v. Roffey (W. N., 1870, p. 227), 82, 84.
N. K. Fairbank Co. v. Central Lard Co. (70 Off. Gaz. 635), 119, 215, 325, 442.
v. Dunn (126 Fed. Rep. 227), 318.
v. Luckel, King & Cake Soap Co. (102 Fed. Rep. 327, 331), 10, 52, 121, 206, 306, 327, 343, 440.
v. Ogden Packing Co. (220 Fed. Rep. 1002), 119, 325.
v. R. W. Bell Mfg. Co. (77 Fed. Rep. 869), 286, 307, 905.
v. Windsor (61 C. C. A. 233), 455, 457.
Noel v. Ellis (89 Fed. Rep. 978-981), 113, 331.
Noera v. Williams Mfg. Co. (158 Mass. 110), 290.
Nolan Bros. Shoe Co. v. Nolan (131 Calif. 271), 370, 637.
North v. Herrick (203 Fed. Rep. 591), 478.
Northeastern Awl Co. v. Marlborough Awl Co. (168 Mass. 147), 9.
Northwestern Consol. Mill Co. v. Wm. Callahan & Son (177 Fed. Rep. 786), 325.
Northwestern Knitting Co. v. Garon (112 Minn. 321), 311.
Northwestern Consolidated Milling Co. v. Mauser & Cressman (162 Fed. Rep. 1004), 117, 142, 325.
v. Wm. Callam & Son (177 Fed. Rep. 786), 117, 450.
Northcutt v. Turney (101 Ky. 314), 61, 116, 160, 164, 400.
N. R. Lynn Shoe Co. v. Auburn-Lynn Shoe Co. (100 Me. 461), 352.
Notaseme Hosiery Co. v. Straus (231 Fed. Rep. 243, 245), 448.
Nunn v. D'Albuquerque (34 Beav. 595), 491.
Nuthall v. Vining (28 W. R. 330), 279, 287.

O

Oakes v. St. Louis Candy Co. (146 Mo. 391), 10, 66.
v. Tonsmierre (4 Woods, 547), 27.
v. Tonsmierre (49 Fed. Rep. 447-453), 68, 454.
Oakey v. Dalton (L. R. 35 Ch. D. 700), 401.
Oakley & Co. v. Babcock (133 O. G. 761), 568.
O'Bear-Nester Glass Co. v. Anti-explo Co. (101 Tex. 431), 257.
O'Connell v. National Water Co. (161 Fed. Rep. 545), 51.
Oglivie v. G. & C. Merriam Co. (149 Fed. Rep. 858), 93.
O'Grady v. McDonald (72 N. J. Eq. 805), 355.
v. McDonald (66 Atl. Rep. 175), 119.
Ohio & Miss. Ry. Co. v. Press Pub. Co. (48 Fed. Rep. 206), 54.
Ohio Baking Co. v. National Biscuit Co. (62 C. C. A. 116), 123.
Old Corner Book Store v. Upham (194 Mass. 101, 105), 232.
Oldham v. James (13 Ir. Ch. 393), 418.
Old Lexington Club Dis. Co. v. Kentucky Distilleries & Warehouse Co. (234 Fed. Rep. 464), 574.
Olin v. Bate (98 Ill. 53), 171.
Oliphant v. Salem Flouring Mills (5 Sawyer 128), 82.
Oliver Chilled Plow Works v. Oliver Mfg. Co. (40 App. D. C. 125), 563, 568.

References are to pages.

Oliver Typewriter Co. v. American Writing Mach. Co. (156 Fed. Rep. 177), 321.
Omega Oil Co. v. Weschler (71 N. Y. Supp. 983), 126, 309.
Omo Mfg. Co. v. Mystic Rubber Co. (225 Fed. Rep. 92), 329.
Oneida Community v. Oneida Game Trap Co. (154 N. Y. S. 391), 565.
Onondaga Co. Milk Association v. Wall (17 Hun, 494), 234.
Opinions of the Attorney General (1889, p. 253), 535.
Oppermann v. Waterman (94 Wis. 583), 326.
Oregon Steam Nav. Co. v. Winsor (20 Wall. 64-72), 236.
Original LaTosca Social Club v. LaTosca Social Club (23 App. D. C. 96), 183.
O'Rourke v. Central City Soap Co. (26 Fed. Rep. 576), 70, 71, 115, 430.
Orr v. Diaper (L. R. 4 Ch. D. 92), 405, 471.
Orr-Ewing & Co. v. Grant (2 Hyde, 185), 294.
v. Johnston & Co. (40 L. T. N. S. 307), 322.
Orr-Ewing v. Chooneeloll Mullick (Cor. 150), 69.
v. Grant, Smith & Co. (2 Hyde, 185), 69.
v. Johnson (13 C. D. 434), 348.
v. Johnston (7 A. C. 219), 301.
Osgood v. Allen (1 Holmes, 185), 95, 158, 159.
v. Allen (Fed. Cas. No. 10603), 301.
v. Rockwood (Fed. Case No. 10605), 440.
v. Rockwood (11 Blatchf. 310), 122, 506, 511.
Outcalt v. New York Herald (146 Fed. Rep. 205), 356.
Outcault v. New York Herald Co. (136 O. G. 437), 578.
Oxypathor Co. v. De Cordero (149 N. Y. S. 513), 260, 267.
Ozo Remedy Co. v. Carnrick & Co., Ltd. (C. D., 1909, p. 162), 572.

P

Pabst Brewing Co. v. Ekers (Rap. Jud. Que. 21 C. S. 545), 69.
Pacific Coast Condensed Milk Co. v. Frye & Co. (85 Wash. 133), 293.
Palmer v. Graham (1 Pars. Eq. Cas. 476), 231.
v. Harris (60 Pa. St. 156), 79, 121, 443.
v. Travers (20 Fed. Rep. 501), 56.
Paris Medicine Co. v. W. H. Hill Co. (102 Fed. Rep. 148-151), 302, 345.
Parker v. Hulme (1 Fisher, 44), 419.
Parkhurst v. Broek (Vt. 47 Atl. Rep. 1068), 242.
Parkland Hill Blue Lick Water Co. v. Hawkins (26 S. W. Rep. 389), 116.
Parlett v. Guggenheimer (67 Md. 542), 79, 443.
Parsons v. Hayward (31 Beavan, 199), 222, 229.
Partlo v. Todd (17 Can. S. C. R. 196), 143, 145.
Partridge v. Menck (2 Sandf. Ch. 622), 78, 157, 442.
Patapasco Ins. Co. v. Southgate (5 Peters, 604, 616), 484.
Paton v. Majors (46 Fed. Rep. 210), 472.
Paul v. Barrows (4 DeG. J. & S. 150), 342.
v. Virginia (8 Wall. 168), 414.

References are to pages.

Pavesich v. New England Life Ins. Co. (50 S. E. Rep. 68), 272.
v. New England Life Ins. Co. (122 Ga. 190), 275.
Payton v. Snelling (1901, A. C. 308), 469.
v. Snelling (17 R. P. C. 635), 469.
v. Snelling (17 R. P. C. 628), 297.
v. Snelling (17 R. P. C. 48, 52), 297.
v. Ward (17 R. P. C. 58), 298.
P. C. Weist Co. v. Weeks (177 Pa. 412), 57, 387.
Peabody v. Norfolk (98 Mass. 452), 253, 254, 256, 258.
Pearlberg v. Rosenstone (70 N. J. Eq. 638), 52.
Peck v. Tribune Co. (214 U. S. 185, 190), 277.
Peerless Rubber Mfg. Co. v. Nichol (187 Fed. Rep. 238), 458.
Peerless Pattern Co. v. Pictorial Review Co. (132 N. Y. S. 37), 260.
Peltz v. Eichele (62 Mo. 171-180), 246.
Penberthy Injector Co. v. Lee (120 Mich. 174), 175.
Pence v. Langdon (99 U. S. 578-581), 209.
Pennell v. Lothrop (191 Mass. 357), 430.
Pennsylvania Co. v. Railroad Co. (118 U. S. 290), 414.
Pennsylvania Rubber Co. Dreadnaught Tire & Rubber Co. (225 Fed. Rep. 138), 113.
Pennsylvania Salt Mfg. Co. v. Meyers (79 Fed. Rep. 87), 128.
Pennsylvania Sugar Ref. Co. v. American Sugar Ref. Co. (166 Fed. Rep. 254), 376.
People v. Bartholf (66 Hun, 626), 756.
v. Cannon (139 N. Y. 32), 755, 756.
v. Elfenbein (20 N. Y. Supp. 364), 756.
v. Fisher (50 Hun, 552), 9.
v. Fisher (57 N. Y. Sup. Ct. 552), 62, 509.
v. Gluckman (70 N. Y. Supp. 173), 755.
v. Hilfman (70 N. Y. Supp. 621), 755.
v. Hogan (29 N. Y. St. 110), 755.
v. Krivitzky (168 N. Y. 182), 755.
v. Luhrs (89 N. E. Rep. 171), 756.
v. Molins (10 N. Y. Supp. 130), 30, 545.
v. Morgan (96 App. Div. 110), 226.
v. Roberts (159 N. Y. 70), 218, 226, 227.
People ex rel. Columbia Chem. Co. v. O'Brien (91 N. Y. Supp. 649), 189.
People ex rel. Power v. Rose (219 Ill. 46), 189.
Pepper v. Labrot (8 Fed. Rep. 29), 28, 29, 213, 337.
Perceval v. Phipps (22 Ves. & B. 19), 260.
Perfect Safety Paper Co. v. George La Monte & Son (122 O. G. 869), 569.
Perham v. Richman (158 Fed. Rep. 546), 190.
Perkins v. Apollo Bros. (197 Fed. Rep. 476), 126.
v. Heert (158 N. Y. 306), 755.
Perks v. Hill (W. N., 1881, p. 111), 444.
Perlberg v. Smith (70 N. J. Eq. 638), 52, 79.

References are to pages.

Perry v. Truefit (6 Beav. 66), 16, 42, 43, 78, 125.
P. E. Sharpless Co. v. Lawrence (130 C. C. A. 59), 459, 460.
Peter Schoenhofen Brew. Co. v. Maltine Co. (134 O. G. 1804), 559.
v. Maltine Co. (30 App. D. C. 340), 102.
Peterson v. Humphrey (4 Abb. Pr. 394), 29, 243.
Petrolia Mfg. Co. v. Bell & Bogart Soap Co. (97 Fed. Rep. 781), 36, 118.
Pettes v. American Watchman's Clock Co. (85 N. Y. Supp. 900), 755.
Peyton v. Desmond (63 C. C. A. 654), 414.
Pfeiffer v. Wilde (102 Fed. Rep. 658), 465.
v. Wilde (46 C. C. A. 415), 465.
Phalon v. Wright (5 Phila. 464), 79, 102, 444.
Phelan v. Collender (13 N. Y. Sup Ct. 244), 29.
Philadelphia Extracting Co. v. Keystone Extracting Co. (176 Fed. Rep. 830), 257, 267.
Philadelphia Nov. Co. v. Blakesley Nov. Co. (37 Fed. Rep. 365), 453.
Philadelphia Nov. Mfg. Co. v. Blakesley Novelty Co. (40 Fed. Rep. 588), 140, 286.
v. Rouss (40 Fed. Rep. 585, 587), 141.
Philadelphia R. R. Co. v. Quigley (62 U. S., 21 Howard, 213), 421.
Piaget v. Headley (68 N. Y. Supp. 351), 291.
Pickett v. Green (120 Ind. 584), 225, 246.
Pidding v. How. (8 Sim. 477), 78, 122.
Pierce v. Frank (15 L. J. Ch. 122), 490.
v. Fuller (8 Mass. 228), 222.
v. Guittard (68 Cal. 68, 71), 47, 637.
Pike Mfg. Co. v. Cleveland Stone Co. (35 Fed. Rep. 896), 122, 123, 124, 125, 131, 216, 324, 332.
Pillsbury v. Pillsbury (24 U. S. App. 395-404), 172.
v. Pillsbury-Washburn Mills Co. (12 C. C. A. 432), 444.
v. Pillsbury-Washburn Flour Mills Co. (64 Fed. Rep. 841-847), 30, 81, 302, 343, 345.
Pillsbury-Washburn Co. v. Eagle (86 Fed. Rep. 608), 10, 161, 166, 167.
Pillsbury-Washburn Flour Mills Co. v. Eagle (30 C. C. A. 386), 12, 162, 400.
Pilmore v. Hood (5 Bing. N. C. 97), 251.
Pinto v. Badman (8 R. P. C. 181), 26, 144.
v. Trott (8 P. R. 173), 326.
Pioneer Suspender Co. v. Louis Oppenheimer's Sons (128 O. G. 1293), 577.
Piso Co. v. Voight (4 Ohio N. P. 347), 79, 417.
Pittsburg Crushed Steel Co. v. Diamond Steel Co. (85 Fed. Rep. 637, 638), 217, 332, 386, 387.
Pittsburgh Water Heater Co. v. Beler Water Heater Co. (222 Fed. Rep. 950), 428, 434, 488.
Plant Seed Co. v. Michel Plant & Seed Co. (23 Mo. App. 579), 179.
Planten v. Canton Pharmacy Co. (33 App. D. C. 268), 99.
v. Gedney (211 Fed. Rep. 281), 395.
v. Gedney (140 C. C. A. 1), 395.

References are to pages.

P. Lorillard Co. v. Peper (86 Fed Rep. 956), 346, 467.
v. Peper (30 C. C. A. 496), 337.
v. Peper (65 Fed. Rep. 597), 337.
Plumley v. Massachusetts (155 U. S. 461, 467, 479), 76.
P. M. Co. v. Ajax Rail Anchor Co. (216 Fed. Rep. 634), 481.
Pocono Pines Assembly v. Miller (77 Atl. Rep. 1094), 109.
Pollard v. Photographic Co. (40 C. D., Eng., 345), 259.
Pollen v. LeRoy (30 N. Y. 549-561), 470.
Pomeroy Ink Co. v. Pomeroy (77 N. J. Eq. 293), 257, 265, 267.
Ponsardin v. Peto (33 Beav. 642), 404, 405.
Pontefact v. Isenberger (106 Fed. Rep. 499), 121, 313.
Pope v. Curl (2 Atk. 342), 260.
Pope A. M. Co. v. McCrum-Howell Co. (112 C. C. A. 391), 320.
Pope-Turnbo v. Bedford (147 Mo. App. 692), 225.
Popham v. Cole (66 N. Y. 69), 306.
v. Wilcox (14 Abb. Pr. N. S. 206), ...
v. Wilcox (66 N. Y. 69), 109, 304, 467, 507.
Porter v. Gorman (65 Ga. 11), 221, 231.
Portuondo v. Monne (28 Fed. Rep. 16), 301, 452.
Postal Tel. Cable Co. v. Netter (102 Fed. Rep. 691), 546.
Postum Cereal Co. v. American Health Food Co. (109 Fed. Rep. 898), 10, 333.
v. American Health Food Co. (56 C. C. A. 360), 284, 294.
Potter v. Ahrens (110 Cal. 681), 248.
v. Commissioners of Inland Revenue (10 Ex. 147), 222.
Potter Drug & Chem. Co. v. Miller (75 Fed. Rep. 656), 119, 323.
Potter D. & Chem. Corp. v. Pasfield Soap Co. (2), 106 Fed. Rep. 914), 119, 333.
v. Pasfield Soap Co. (102 Fed. Rep. 490), 119, 333.
Powell v. Birmingham Vinegar Brewery Co. (L. R., 1894, 3 Ch. D. 449-462), 152.
Pratt's Mfg. Co. v. Astral Refining Co. (27 Fed. Rep. 492-494), 99.
President Suspender Co. v. Macwilliam (233 Fed. Rep. 433, 437), 28.
Press Pub. Co. v. Monroe (73 Fed. Rep. 196, 201), 421.
Prest-O-Lite Co. v. Avery Lighting Co. (161 Fed. Rep. 648, 651), 314.
v. Bogen (209 Fed. Rep. 915, 916), 314.
v. Davis (209 Fed. Rep. 917, 92, 924), 314.
v. Davis (131 C. C. A. 491), 314.
v. Heiden (135 C. C. A. 515, 517), 314.
v. Post & Lester Co. (163 Fed. Rep. 63, 64), 314.
Preservaline Mfg. Co. v. Heller Chemical Co. (118 Fed. Rep. 103), 87.
Price v. Goodall (L. R., 1891, 1 Ch. D. 35), 9.
Price Baking Powder Co. v. Fyfe (45 Fed. Rep. 799), 119, 453, 488.
Prince Metallic Paint Co. v. Carbon Metallic Paint Co. (Sch. 573), 174.
v. Prince Mfg. Co. (6 C. C. A. 647), 209.
v. Prince Mfg. Co. (53 Fed. Rep. 493), 385, 393, 415, 547.

References are to pages.

Prince Mfg. Co. v. Prince's Metallic Paint Co. (2), 135 N. Y. 24), 75, 77, 166.
v. Prince's Metallic Paint Co. (15 N. Y. Supp. 249), 37.
v. Prince's Metallic Paint Co. (39 N. Y. S. R. 488), 28.
Probasco v. Bouyon (1 Mo. App. 241), 241.
Proctor v. McBride (Fed. Case No. 11441), 329.
Proctor & Collier Co. v. Mahin (93 Fed. Rep. 875, 876), 363.
Proctor & Gamble Co. v. Globe Refining Co. (92 Fed. Rep. 357-362), 326, 333, 343.
v. Globe Refining Co. (34 C. C. A. 405), 286, 337.
Provident Chemical Works v. Canada Chemical Mfg. Co. (2 Ont. Law Rep. 182), 100.
Prudential Assurance Co. v. Knott (L. R. 10 Ch. D. 142), 53.
Publishing Co. v. Dobinson (82 Fed. Rep. 56), 202.
v. Dobinson (72 Fed. Rep. 603), 189.
Puritan Cordage Mills v. Sampson Cordage Works (232 Fed. Rep. 138), 465.
Putnam Nail Co. v. Ausable Horse-nail Co. (53 Fed. Rep. 390), 52.
v. Bennett (43 Fed. Rep. 800), 294, 441, 538.
v. Dulaney (140 Pa. 205), 139.

Q.

Quaker City Flour Mills Co. v. Quaker Oats Co. (43 App. D. C. 260), 109.

R

Radam v. Capital Microbe Destroyer Co. (81 Texas, 122), 468.
v. Destroyer Co. (81 Texas, 122), 467.
Radde v. Norman (L. R. 14 Eq. 348), 61, 328.
Raggett v. Findlater (L. R. 17 Eq. 29), 108.
Rahtjen's Composition Co. v. Holzappel's Composition Co. (97 Fed. Rep. 949), 83.
v. Holzapfel's Composition Co. (41 C. C. A. 329), 83.
Railroad Co. v. Harris (12 Wall. 65), 414.
Rains v. White (21 Ky. L. R. 742), 286.
Raleigh v. Kinematograph Trading Co. (31 R. P. C. 143, 145), 205.
Ralli v. Fleming, Ind. (L. R. 3 Calc. 417), 339.
Ralph v. Taylor (L. R. 25 Ch. D. 194), 88.
Ralston Steel Car Co. v. National Dump Car Co. (222 Fed. Rep. 590), 433.
Rammelsberg v. Mitchell (29 Ohio St. 22), 245.
Ramsden v. Dyson (L. R. 1 H. L. 129), 209.
Ranft v. Reimers (200 Ill. 386), 231, 232.
Ransom v. Ball (7 N. Y. Supp. 238), 78.
v. Mayor (1 Fisher, 252), 419.
Ransome v. Bentall (3 L. J. Ch. 161), 305, 340, 341.
v. Graham (51 L. J. Ch. 897), 85, 340.
Rathbone, Sard & Co. v. Champion Steel Range Co. (110 C. C. A. 596), 370.

References are to pages.

Rawlinson v. Brainard & Armstrong Co. (59 N. Y. Supp. 880), 121, 335.
Rawson v. Pratt (91 Ind. 9), 249, 251.
Raymond v. Royal Baking Powder Co. (85 Fed. Rep. 231), 128.
v. Royal Baking Powder Co. (76 Fed. Rep. 465), 465.
Reach Co. v. Simmons Hdw. Co. (155 Mo. App. 412), 45.
Read v. Richardson (45 L. T. N. S. 54), 86, 322, 470.
Reading Stove Works v. S. M. Howes Co. (201 Mass. 437), 456.
v. S. M. Howes Co. (87 N. E. Rep. 751), 130.
Reddaway v. Banham (L. R., 1896, A. C. 199, 204, 205), 13, 40, 152, 153, 191, 194.
Reddaway & Co. v. Bentham Hemp Spinning Co. (9 R. P. C. 503), 151, 301.
Redgrave v. Hurd (L. R. 20 Ch. D. 1), 251.
Reed v. West (47 Tex. 240), 209.
Reeder v. Brodt, C. P., (4 Ohio N. P. 265), 114, 395.
Reeves v. Denicke (12 Abb. Pr. N. S. 92), 29, 230.
Regent Shoe Mfg. Co. v. Haaker (75 Nebr. 426), 446.
Regina v. Closs (D. & B. 460), 410.
v. Dundas (6 Cox, 380), 410.
v. Gray (Sev. 183), 410.
v. Smith (D. & B. 566), 410.
v. Sutter (10 Cox, 577), 410.
Regis v. J. A. Jaynes & Co. (185 Mass. 458), 294, 449.
v. Jaynes & Co. (191 Mass. 245, 251, 252), 455, 456, 462.
v. Jaynes (70 N. E. Rep. 480), 128.
v. Jaynes (77 N. E. Rep. 774), 109.
Registrar v. Du Cros, Ltd. (83 L. J. Ch. 1), 170.
Rehbein v. Weaver (133 Fed. Rep. 607), 384.
Reinhart v. Spaulding (49 L. J. Ch. 57), 121.
Republic of Peru v. Reeves (40 N. Y. Sup. Ct. 316), 402.
Reuter's Telegram Co. v. Byron (43 L. J. Ch. 661), 261.
Revere Rubber Co. v. Consolidated Hoof Pad Co. (139 Fed. Rep. 151, 154), 67.
Rey v. Lacouturier (L. R., 1908, 2 Ch. 726), 118.
Reymer & Bros. v. Huyler's (190 Fed. Rep. 83), 125.
Reynolds v. Bullock (47 L. J. Ch 773), 227.
R. Gaustavino Co. v. Comerma (180 Fed. Rep. 920), 11, 122.
v. Comerma (184 Fed. Rep. 549), 118, 129, 463.
R. Heinisch's Sons Co. v. Boker (86 Fed. Rep. 765), 49, 167, 179.
Rhodes v. Sperry & Hutchinson Co. (85 N. E. Rep. 1097), 278.
Ricard v. Caton College Co., Minn., (92 N. W. Rep. 958), 320.
Rice v. Standard Oil Co. (134 Fed. Rep. 464), 377.
Rice & Co. v. Redlich Mfg. Co. (122 C. C. A. 442), 370.
Rice-Stix Dry Goods Co. v. Scriven Co. (165 Fed. Rep. 639), 89.
Richards v. Butcher (L. R., 1891, 2 Ch. 522), 102.
v. Butcher (62 L. T. 867), 399.
v. Hunt (65 Ga. 342), 245.
Richardson & Boynton Co. v. Richardson & Morgan Co. (8 N. Y. Supp. 53), 202.
Richardson v. Peacock (33 N. J. Eq. 597), 242.
Richmond Nervine Co. v. Richmond 159 U. S. 293, 302), 20, 879.

References are to pages.

Richter v. Anchor Remedy Co. (52 Fed. Rep. 455, 458), 23, 69, 386, 387.
v. Reynolds (8 C. C. A. 220), 387.
v. Reynolds (59 Fed. Rep. 577), 23, 27, 69, 217, 386, 537.
Rillet v. Carlier (61 Barb. 435), 122, 147.
Rivero v. Norris (Seton, 4th Ed., 236), 405.
R. J. Reynolds Tobacco Co. v. Allen Bros. Tobacco Co. (151 Fed. Rep. 819), 30, 129, 296, 450.
Roberson v. Rochester Folding Box Co. (171 N. Y. 540), 268, 269, 272, 276.
Roberts v. Sheldon (8 Biss. 398), 330, 404.
v. Sheldon (Fed. Case No. 11916), 127.
Robertson v. Berry (50 Md. 591), 196, 290.
v. Quiddington (28 Beavan, 529), 226.
Robinson v. Finlay (L. R. 9 Ch. D. 487), 63, 215, 339.
v. Storm (103 Tenn. 40), 177.
Robison v. Texas Pine Land Assn. (Tex. Civ. App., 40 S. W. Rep. 843), 373.
Rubber & Celluloid H. T. Co. v. F. W. DeVoe & C. T. Reynolds Co. (233 Fed. Rep. 150, 154), 110, 192, 330, 458.
Rubber & Celluloid Harness Trimming Co. v. Rubber-Bound Brush Co. (81 N. J. Eq. 419), 194, 330.
Rumford Chemical Works v. Muth (35 Fed. Rep. 524), 98, 137.
Rupp v. Over (3 Brewst. 133), 231.
Rushmore v. Badger Brass Mfg. Co. (198 Fed. Rep. 379), 371.
Rushmore v. Manhattan Screw & Stamping Works (163 Fed. Rep. 939), 293, 369, 371.
v. Manhattan Screw & Stamping Works (90 C. C. A. 299), 103.
v. Saxon (158 Fed. Rep. 499, 509), 142, 152, 176, 178, 369.
v. Saxon (154 Fed. Rep. 213), 292.
Russell v. Lundeen (72 Off. Gaz. 420), 259.
Russia Cement Co. v. Frauenhar (66 C. C. A. 500), 317.
Russia Cement Co. v. Katzenstein (109 Fed. Rep. 314), 124, 316.
v. Lepage (147 Mass. 206), 29, 171, 177, 181, 227, 442.
v. Frauenhar (126 Fed. Rep. 228), 317.
Ryder v. Holt (128 U. S. 525), 385, 392, 415, 429, 547.
Rock v. Purssell (84 L. T. Jo. 45), 436.
Rock Springs Distillery v. Monarch (15 Ky. L. Rep. 866), 177.
Rocky Mountain Bell Telephone Co. v. Utah Telephone Co. (31 Utah, 377), 340.
v. Utah Independent Telephone Co. (88 Pac. Rep. 26), 114.
Rodgers v. Nowill (6 Hare 325), 174, 415, 490.
v. Nowill (5 C. B. 109), 293.
v. Nowill (2), (Cox, Manual, No. 115), 474, 475.
v. Philp (1 Off. Gaz. 29), 418.
v. Rodgers (31 L. T. N. S. 285), 311.
v. Rogers (53 Conn. 120), 172, 175, 177.
v. Taintor (97 Mass. 291), 30, 32, 174.
Rogers Co. v. Rogers Mfg. Co. (17 C. C. A. 576), 189.
v. Wm. Rogers Mfg. Co. (70 Fed. Rep. 1017), 177.

References are to pages.

Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co. (11 Fed. Rep. 495), 177, 179, 444.
Rolt v. Bulmer (Seb. 614), 227.
Roncoroni v. Gross (86 N. Y. Supp. 1112), 148.
Root v. L. S. & M. S. Ry. Co. (105 U. S. 189), 426), 458.
Ropes v. Upton (125 Mass. 258-261), 247.
Rose v. Loftus (47 L. J. Ch. 576), 310, 313, 337, 399, 492.
v. Henley (47 L. J. Ch. 577), 313.
v. Henly (Seb. 551), 337.
Rosenburg v. Fremont Undertaking Co. (114 Pac. Rep. 886), 121.
v. Fremont Undertaking Co. (63 Wash. 52), 183.
Rosenthal v. Blatt (N. J. Ch., 83 Atl. Rep. 387), 106.
Rosenzweig v. Forbes (121 O. G. 2667), 553.
Rosing v. Atkinson (27 Sol. J. 534), 120.
Rossman v. Garnier (128 C. C. A. 73), 384, 564.
v. Garnier (211 Fed. Rep. 401), 114, 586.
Rourke v. Elk Drug Co. (75 N. Y. App. Div. 145), 373.
Rowell v. Rowell (122 Wis. 1, 17), 221.
Rowland v. Mitchell (L. R., 1897, 1 Ch. D. 71, 74), 9.
Rowley v. Houghton (2 Brewst. 303), 122.
v. J. F. Rowley Co. (161 Fed. Rep. 94), 178.
v. Rowley (113 C. C. A. 386), 459.
Royal Baking Powder Co. v. Davis (26 Fed. Rep. 293), 286, 290.
v. Raymond (70 Fed. Rep. 376), 4, 128, 165, 210, 211.
Royal Baking Powder Co. v. Royal (58 C. C. A. 499), 177, 179.
v. Royal Chemical Co. (Price & Steuart, 1), 903.
Royal Ins. Co. v. Midland Ins. Co. (25 R. P. C. 728), 469.
Roystone v. Woodbury Dermatological Institute (122 N. Y. S. 444), 266.
Roy Watch-Case Co. v. Camm-Roy Watch-Case Co. (59 N. Y. Supp. 979), 330.

S

Saccharin Corp v. Wild, 1903 (1 Ch. 410), 431.
Safe-Cabinet Co. v. Globe-Wernicke Co. (3 Ohio App. 24), 293.
Sage v. Tauszky (Fed. Case No. 12214), 485.
Salinger v. Salinger (69 N. H. 589), 250.
Salomon v. Hertz (40 N. J. Eq. 400), 254, 255, 256.
Samson Cordage Works v. Puritan Cordage Mills (211 Fed. Rep. 603), 193.
Samuel v. Berger (24 Barb. 163), 418.
Samuel Bros. & Co. v. Hostetter Co. (55 C. C. A. 111), 313.
Samuels v. Spitzer (177 Mass. 226), 328.
Sanche v. Mahler (219 Ills. 349), 471.
Sanders v. Jacob (20 Mo. App. 96), 206.
San Francisco Natl. Bank v. Dodge (197 U. S. 70, 93), 221.
Sanitas Co. v. Condy (4 P. R. 195), 330.
Sanitas Nut Food Co. v. Cemer (134 Mich. 370), 257.
Santa Fe Electric Co. v. Hitchcock (9 New Mex. 156), 228.

References are to pages.

Sarrazin v. W. R. Irby Cigar & Tobacco Co. (93 Fed. Rep. 624-627), 17, 19, 28, 66, 124, 386, 536.
v. W. R. Irby Cigar Co. (35 C. C. A. 496), 31.
Sartor v. Schaden (125 Iowa, 697), 368.
v. Schaden (101 N. W. Rep. 511), 8, 110.
v. Smith (125 Ia. 665), 343.
Sauers Milling Co. v. Kehlor Flour Mills Co. (39 App. D. C. 535), 100.
Sawyer v. Horn (1 Fed. Rep. 24), 42, 291, 338, 455.
v. Horn (4 Hughes, 239), 279, 508.
v. Kellogg (7 Fed. Rep. 720), 179, 290, 330, 345, 444.
v. Kellogg (1), (7 Fed. Rep. 721), 73, 92, 403.
v. Kellogg (2), (9 Fed. Rep. 601), 210, 345, 404, 443, 455, 490, 491.
Sawyer Crystal Blue Co. v. Hubbard (32 Fed. Rep. 388), 299, 313, 337.
Saxby v. Easterbrook (Cox, Manual, 606), 53.
Saxlehner v. Apollinaris Co. (L. R., 1897, 1 Ch. 893), 494.
v. Eisner (77 C. C. A. 417), 403.
v. Eisner (140 Fed. Rep. 938), 403.
v. Eisner & Mendelson Co. (88 Fed. Rep. 61-70), 318, 493.
v. Eisner & Mendelson Co. (2), (91 Fed. Rep. 536), 22, 37.
v. Eisner & Mendelson Co. (3), (179 U. S. 19), 22, 37, 123, 208, 213, 216, 217, 444, 457, 884.
v. Eisner & Mendelson Co. (4), (138 Fed. Rep. 22, 24), 456, 457, 462.
Saxlehner v. Graef (81 Fed. Rep. 704), 296.
v. Neilson (34 C. C. A. 690), 208.
v. Neilson (88 Fed. Rep. 71), 208.
v. Nielson (179 U. S. 43), 208.
v. Siegel-Cooper Co. (179 U. S. 42), 295, 449.
v. Wagner (216 U. S. 375), 105, 358.
v. Wagner (85 C. C. A. 321), 105, 358.
Scanlan & Bartell v. Williams (114 S. W. Rep. 862), 178.
Scheer v. American Ice Co. (66 N. Y. Supp. 3), 243.
Schendle v. Silver (70 N. Y. Sup. Ct. 330), 329.
v. Silver (18 N. Y. Supp. 1), 126.
Schenker v. Awerbach (85 N. Y. Supp. 129), 282.
Schener v. Muller (20 C. C. A. 161), 48, 167.
v. Muller (74 Fed. Rep. 225), 51, 167.
Schinasi v. Schinasi (155 N. Y. S. 867), 175.
Schmalz v. Wooley (57 N. J. Eq. 303), 736.
Schmidt v. Brieg (100 Cal. 672), 110, 637.
v. Crystal Soda Water Co. (35 Pac. Rep. 855), 110.
v. Haake (35 Pac. Rep. 855), 110.
v. Liberty Soda Water Co. (35 Pac. Rep. 856), 110.
v. McEwen (35 Pac. Rep. 854), 110.
v. Steinke (35 Pac. Rep. 855), 110.
Schneider v. Williams (44 N. J. Eq. 391), 62, 76, 424, 509.
Schonwald v. Ragains (32 Okla. 223), 364.
v. Ragains (122 Pac. Rep. 203), 373.

References are to pages.

Schrauder v. Beresford & Co. (Browne, Trademarks, 661), 67.
Schumacher & Ettlinger v. Schwenke (2) (36 Off. Gaz. 457), 418, 429, 503, 546.
v. Wogram (35 Fed. Rep. 210), 502.
Schumacher v. Schwenke (1) (26 Fed. Rep. 818), 385, 392, 415, 429, 547.
Schuyler v. Curtis (19 N. Y. Supp. 264), 269.
v. Curtis (24 N. Y. Supp. 509-511), 271.
v. Curtis (42 N. E. Rep. 22-24), 272.
v. Curtis (64 Hun, 594), 271.
Schwarz v. Superior Court (111 Cal. 106), 475, 476.
Schweitzer v. Atkins (37 L. J. Ch. 847), 325.
Scott v. Mackintosh (1 V. & B. 503), 222, 242.
v. Rowland (20 W. R. 208), 29, 222.
v. Standard Oil Co. (106 Ala. 475), 103, 313.
Scriven v. North (67 C. C. A. 348), 51.
v. North (134 Fed. Rep. 366), 193.
v. North (124 Fed. Rep. 894, 896), 51, 102.
Seabury v. Grosvenor (Fed. Case No. 12576), 79.
v. Grosvenor (14 Blatchf. 262), 546.
Seaich v. Mason-Seaman Transp. Co. (156 N. Y. S. 579), 248.
Seaman v. Johnson (106 Fed. Rep. 915), 93.
Seamless Rubber Co. v. Star Rubber Co. (C. D., 1910, p. 44), 573.
Searchlight Gas Co. v. Prest-O-Lite Co. (131 C. C. A. 626), 314.
Searle v. Hereth Co. v. Warner (50 C. C. A. 321), 380.
Sears & Nichols Co. v. Brakeley (38 App. D. C. 530), 102.
Sears, Roebuck & Co. v. Elliott Varnish Co. (232 Fed. Rep. 588, 590), 334.
Seeger Refrigerator Co. v. White Enamel Refrigerator Co. (178 Fed. Rep. 567), 89, 112.
Seely v. Fisher (11 Sim. 581), 53.
Seigert v. Abbott (1) 61 Md. 276), 81.
Seixo v. Provezende (L. R. 1 Ch. D. 192), 160, 304, 321, 335.
Selchow v. Baker (93 N. Y. 59), 129, 214.
v. Chaffee & Selchow Mfg. Co. (132 Fed. Rep. 996), 108, 147.
Seltzer v. Powell (8 Phila. 296), 129.
Sen Sen Co. v. Britten (L. R., 1899, 1 Ch. D. 692), 83.
S. F. Myers Co. v. Tuttle (188 Fed. Rep. 532), 232.
v. Tuttle (183 Fed. Rep. 235), 226.
Shackle v. Baker (14 Ves. 468), 223.
Shaver v. Heller & Merz Co. (48 C. C. A. 48), 445.
v. Heller & Merz Co. (108 Fed. Rep. 821-824), 216.
v. Shaver (54 Iowa, 208, 209), 5, 64, 177, 424, 442.
Shaw v. Pilling (175 Pa. St. 78-84), 51, 293, 423, 470.
Shaw Stocking Co. v. Mack (12 Fed. Rep. 707), 6, 129, 330, 337, 339, 341.
Sheldon v. Houghton (5 Blatchf. 285, 291), 223.
Shelley v. Sperry (121 Mo. App. 429), 45, 159.
Sheppard v. Stuart (13 Phil. 117), 69, 121, 143, 216.

References are to pages.

S. Hernsheim Bros. & Co., Ltd. v. J. H. Hargrave & Son (81 Off. Gaz. 503), 544.
Sherwood v. Andrews (3 Am. Law Reg. N. S. 588), 104.
v. Andrews (5 Am. L. Reg. N. S. 588), 29, 30, 81, 214.
v. Horton, Cato & Co. (84 Off. Gaz. 2018), 66, 385, 388.
Shipwright v. Clements (19 W. R. 599), 28, 30, 212, 228.
Shook v. Rankin (6 Biss. 477, 480, 481), 477.
S. Howes Co. v. Howes Grain Cleaner Co. (24 Misc. Rep. 83), 455.
Shrimpton v. Laight (18 Beav. 164), 305, 444.
Sibley Soap Co. v. Lambert Pharmaceal Co. (103 Off. Gaz. 2172), 388.
Siegert v. Abbott (1) (61 Md. 276), 30, 447.
v. Abbott (1) (61 Md. 286), 417.
v. Abbott (2) (Cox, Manual, 718), 147.
v. Abbott (4) (25 N. Y. Supp. 590), 417.
v. Abbott (72 Hun, 243), 539.
v. Ehlers (Seb. 432), 147, 404.
v. Findlater (L. R. 7 Ch. D. 801), 98, 147, 253, 404.
v. Gandolfi (139 Fed. Rep. 917), 115.
v. Gondolfi (149 Fed. Rep. 100), 98, 115.
v. Lawrence (11 Vic. L. R. 47), 404, 443.
Simmons Hardware Co. v. Waibel (1 So. Dak. 488), 260.
Simmons Medicine Co. v. Simmons (81 Fed. Rep. 163), 254, 257, 258, 286.
Simplex Automobile Co. v. Kahnweiler (162 App. Div. 480), 367.
Simpson v. Wright (1) (15 Off. Gaz. 248), 511.
v. Wright (2) (15 Off. Gaz. 293), 506, 511.
Singer Mfg. Co. v. Bent (163 U. S. 169, 204), 92.
v. Bent (163 U. S. 205), 88, 137, 149, 151, 172.
v. Bent (41 Fed. Rep. 214), 88.
v. Brill (Cox, Manual, 672), 149.
v. British Empire Mfg. Co. (20 R. P. C. 313, 318, 319), 348.
v. Charlebois (16 Rap. Jud. Q. C. S. 167), 91.
v. Hipple (109 Fed. Rep. 152), 87.
v. James Spence & Co. (10 R. P. C. 297, 309), 347.
v. June (41 Fed. Rep. 208), 88.
v. June Mfg. Co. (163 U. S. 169, 186), 88, 90, 111, 137, 149, 151, 171, 178, 193, 216, 458.
v. Kimball & Morton (Ct. Sess. Cas., 3d ser., XI, 267), 69.
v. Larsen (8 Biss. 151), 88.
v. Larsen (Fed. Case No. 12902), 172.
v. Loog (18 Ch. D. 412), 294.
v. Loog (3) (L. R. 18 Ch. D. 395-404), 398, 399.
v. Loog (3) (8 App. Cas. 39), 335.
v. Loog (3) (L. R. 8 App. Cas. 15), 149, 412, 415, 442.
v. Riley (11 Fed. Rep. 706), 88.
v. Stanage (6 Fed. Rep. 279), 88.
v. Wilson (2 Ch. D. 434), 64, 65, 290, 306, 413.
v. Wilson (3 App. Cas. 376-391), 293.
Singleton v. Bolton (3 Doug. 293), 33, 49, 293.
S. Jarvis Adams Co. v. Knapp (58 C. C. A. 1), 265.
Skinner v. Oakes (10 Mo. App. 45), 27, 39, 181.

References are to pages.

Slack v. Suddoth (102 Tenn. 375), 227.
Slater v. Banwell (50 Fed. Rep. 150), 472.
v. Merritt (75 N. Y. 268), 475.
Slazenger v. Feltham (6 R. P. C. 531), 290, 323, 325.
Sleeper v. Baker (22 N. D. 386), 365.
Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co. (85 Off. Gaz. 1905), 66, 124, 385.
Small v. Sanders (118 Ind. 105), 395.
Smalley v. Greene (52 Ia. 241), 255.
Smith v. Adams (6 Paige, 435-443), 148.
v. Carron Co. (13 P. R. 108), 331.
v. David H. Brand & Co. (67 N. J. Eq. 529), 230.
v. Everett (27 Beav. 446), 222, 239.
v. Fair (14 Ont. Rep. 729), 28.
v. Gibbs (44 N. H. 335), 231.
v. Imus (32 Alb. L. J. 455), 28, 159, 342.
v. Kernan (8 Ohio Dec., reprint 32), 360.
v. Krause (160 Fed. Rep. 270, 271), 140.
v. Mason (W. R., 1875, p. 62), 127.
v. Reynolds (1) (10 Blatchf. 85), 504.
v. Reynolds (2) (3 Off. Gaz. 213), 503.
v. Reynolds (2) (10 Blatchf. 100), 503, 504, 506.
v. Reynolds (Fed. Case No. 13098), 440.
v. Sixbury (25 Hun, 232), 125, 138.
v. Walker (37 Mich. 456), 159.
Smith v. Webb (176 Ala. 596), 228, 248.
v. Woodruff (48 Barb. 438), 79, 130.
Smith & Davis Mfg. Co. v. Smith (89 Fed. Rep. 486), 339.
Smith-Dixon Co. v. Stevens (100 Md. 110), 451.
v. Stevens (59 Atl. Rep. 401), 689.
Snider v. McKelvey (27 Ont. App. 339), 247.
Snodgrass v. Wells (11 Mo. App. 590), 20, 26, 29.
Snow v. Holmes (71 Cal. 142), 240, 251.
Snowden v. Noah (Hopkins' Ch. 347), 4, 40, 199, 202.
Snyder Mfg. Co. v. Snyder (54 Ohio St. 86), 28, 244.
Snyder Pasteurized Milk Co. v. Burton (82 N. J. Eq. 185), 232.
Sohier v. Johnson (111 Mass. 238), 28, 34.
Sohl v. Geisendorf (1 Wills., Ind. 60), 211, 339.
Solis Cigar Co. v. Pozo (16 Colo. 388), 36, 144.
Somers v. Newman (31 App. D. C. 193), 127.
Somerville v. Schembri (L. R. 12 App. Cas. 453-457), 443.
Sooy v. State (41 N. J. Law, 394), 257.
Sorg v. Welsh (16 Off. Gaz. 910), 130, 502, 503.
South Carolina v. Seymour (153 U. S. 353), 532.
Southern White Lead Co. v. Cary (25 Fed. Rep. 125), 166, 168, 331.
v. Coit (39 Fed. Rep. 492), 167.
Southern (or Southerne) v. How (2 Popham, 144), 16, 40, 57.

References are to pages.

Social Reg. Assn. v. Murphy (128 Fed. Rep. 116), 201, 335.
v. Howard (60 Fed. Rep. 270), 129, 201.
Société Anonyme v. Baxter (14 Blatchf 261), 308.
v. Western Distilling Co. (46 Fed. Rep. 921), 462.
v. Western Distilling Co. (43 Fed. Rep. 416), 116, 147, 150.
v. Western Distilling Co. (42 Fed. Rep. 96), 475.
Société Anonyme Benedictine v. Hygrade Wine Co. (173 Fed. Rep. 796), 437.
Société Anonyme de la Distillerie de la Benedictine v. Micalovitch, Fletcher & Co. (36 Alb. Law J. 364), 116, 503.
Société de la Benedictine v. Micalovitch (36 Alb. L. J. 364), 539.
Société des Huiles D'Olive de Nice v. Rorke (31 N. Y. Supp. 51), 451.
Society of Accountants v. Corporation of Accountants (20 Scot. Sess. Cas., 4th ser. 750), 400.
Spalding & Bros. v. Gamage, Ltd. (32 R. P. C. 284), 46.
Spedding v. Fitzpatrick (38 C. D., p. 413), 435.
Sperry v. Percival Milling Co. (81 Cal. 252), 286, 290, 326, 468, 637.
Sperry & Hutchinson Co. v. Associated Merchants' Stamp Co. (208 Fed. Rep. 205), 365.
v. Fenster (219 Fed. Rep. 755), 938.
v. Pommer (199 Fed. Rep. 309, 314), 364.
Spice v. James (Seb. 46), 224.
Spiegel v. Zuckerman (175 Fed. Rep. 978), 68, 109.
Spieker v. Lash (102 Cal. 38-45), 106, 181, 637.
Spier v. Lambdin (45 Ga. 319), 234.
Spratt v. Jeffery (10 B. & C. 249), 222.
Sprigg v. Fisher (222 Fed. Rep. 964, 967), 395.
Spring Valley Water Works v. Schottler (62 Cal. 69, 118), 226.
S. R. Feil Co. v John E. Robbins Co. (136 C. C. A. 258), 142, 334.
S. S. White Dental Mfg. Co. v. Mitchell (188 Fed. Rep. 1017), 266.
Stachelberg v. Ponce (128 U. S. 686), 106, 301, 546.
v. Ponce (23 Fed. Rep. 430), 81, 124, 418.
Stamford Foundry Co. v. Thatcher Furnace Co. (200 Fed. Rep. 324), 129.
Stamping Co. v. Fellows (163 Mass. 191), 16.
Standard Cigar Co. v. Goldsmith (58 Pa. Super. Ct. 33), 454.
Standard Oil Co. v. Doyle (118 Ky. 662), 373.
Standard Paint Co. v. Rubberoid Roofing Co. (140 C. C. A. 235), 330.
v. Rubberoid Roofing Co. (224 Fed. Rep. 695), 193.
v. Trinidad Asphalt Mfg. Co. (90 C. C. A. 195), 110.
v. Trinidad Asphalt Co. (220 U. S. 446), 110, 193.
Standard Table Oil Cloth Co. v. Trenton Oil Cloth & Linoleum Co. (63 Atl. Rep. 846), 129.
v. Trenton Oil Cloth & Linoleum Co. (71 N. J. Eq. 555), 342.
Standard Varnish Works v. Fisher 153 Fed. Rep. 928, 930), 14, 130, 192.

References are to pages.

Standinger v. Standinger (19 Leg. Int. 85), 172.
Star Co. v. Colver Pub. House (141 Fed. Rep. 129), 453.
v. Wheeler Syndicate (155 N. Y. S. 782), 5.
Starey v. Chilworth Gunpowder Co. (L. R. 24 Q. B. D. 90), 77.
Star Milling Co. v. Metcalf (240 U. S. 403), 25.
State v. Barnett (159 Ind. 432), 673.
v. Baskowitz (156 S. W. Rep. 945), 708.
v. Berlinsheimer (62 Mo. App. 165), 62.
v. Bick (167 Mo. 272), 718.
v. Bishop (31 S. W. Rep. 9, 11), 9.
v. Bishop (128 Mo. 373), 63, 718.
v. Boyd, Del. (95 Atl. Rep. 232), 652.
v. Dinnisse (109 Mo. 434), 718.
v. Gibbs (56 Mo. 133), 22, 57, 68, 718.
v. Hagen (6 Ind. App. 167), 62, 673.
v. Hand Brewing Co. (32 R. I. 56), 790.
v. Mason (38 Pac. Rep. 130), 55.
v. McGrath (93 Mo. 357), 184.
v. Montgomery (106 Pac. Rep. 771), 821.
v. Niesmann (101 Mo. App. 507), 718.
v. Schmidt (48 Atl. Rep. 588), 736.
v. St. Clair (137 Mo. App. 183), 718.
v. Tetu (98 Minn. 351), 80.
v. Thierauf (167 Mo. 429), 718.
v. Wright (159 Ind. 394), 673.
State, ex rel., Spencerian Pen Co. v. Kelsey (105 App. Div. 132), 60.
State of Pennsylvania v. Wheeling & Belmont Bridge Co. (59 U. S. 421-433), 409.
Stegner v. Blake (36 Fed. Rep. 183, 184), 484.
Steiff v. Bing (215 Fed. Rep. 204), 369.
v. Gimbel Bros. (131 C. C. A. 21), 291.
Stein v. National Life Association (105 Ga. 821, 1899), 359, 361.
Steinthal v. Samson (Seb. 546), 143.
Steinway v. Henshaw (5 P. R. 77), 331.
Stephano v. Satmatopoulos (199 Fed. Rep. 451), 128.
Stephens v. DeConto (4 Abb. Pr. N. S. 47), 124, 202.
v. DeConto (7 Robertson, 343), 200.
v. Peel (16 L. T. N. S. 145), 331.
Sterling Remedy Co. v. Eureka Chemical & Mfg. Co. (80 Fed. Rep. 105), 115, 334.
v. Eureka Mfg. Co. (70 Fed. Rep. 704), 52, 126.
v. Gorey (110 Fed. Rep. 372), 324, 344.
v. Spermine Remedy Co. (50 C. C. A. 657), 325, 463.
Sterling Varnish Co. v. Macon (217 Pa. 7), 257.
Stern v. Barrett Chem. Co. (29 Misc. Rep. 609), 128.
Sternberg Mfg. Co. v. Miller, Du Brul & Peters Mfg. Co. (88 C. C. A. 398), 113.
v. Miller, Du Brul & Peters Mfg. Co. (161 Fed. Rep. 318), 386.
Sternberger v. Thalheimer (3 Off. Gaz. 120), 117, 505.
Stewart v. Gladstone (L. R. 10 Ch. D. 646), 227.
Stevens & Co. v. Stiles (29 R. I. 399), 257, 360.

References are to pages.

Stevens Linen Works v. William & John Don & Co. (121 Fed. Rep. 171), 48, 341, 469.
Stewart v. Challacombe (11 Ill. App. 379), 250.
v. Hook (118 Ga. 445), 254, 257.
v. Hudson (222 Fed. Rep. 584), 357, 369.
v. Smithson (1 Hilt. 119), 83, 85.
Steward v. Einstein (64 Off. Gaz. 1533), 400.
Stier v. Marburg Bros. (C. D., 1913, p. 234), 572.
Stirling Silk Mfg. Co. v. Sterling Silk Co. (46 Atl. Rep. 199), 87.
St. Louis Piano Mfg. Co. v. Merkel (1 Mo. App. 305), 65, 551.
St. Louis Stamping Co. v. Piper (33 N. Y. Supp. 443), 104.
St. Mungo Co. v. Viper Co. (27 R. P. C. 420), 333, 469.
Stokes v. Allen (9 N. Y. Supp. 846), 130.
v. Landraff (17 Barb. 608), 101, 103, 106, 107, 133.
Stokes Bros. Mfg. Co. v. Heller (56 Fed. Rep. 297), 255, 263.
Stone v. Carlan (Cox, Case No. 104), 355.
v. Goss (65 N. J. Eq. 756), 257.
Stonebraker v. Stonebraker (33 Md. 252), 177.
Stoughton v. Woodard (39 Fed. Rep. 902), 119.
Strasser v. Moonelis (108 N. Y. 611), 62, 509.
Straus v. Notaseme Hosiery Co. (240 U. S. 179), 448.
Strause v. Weil (191 Fed. Rep 527), 369.
Street v. Blay, 1831 (2 Barn. & Ad. 456), 434.
Street & Smith v. Atlas Mfg. Co. (231 U. S. 348), 205, 466, 581.
Streeter v. Rush (25 Cal. 67), 248.
S. T. Taylor Co. v. Nast (154 N. Y. Supp. 982), 124, 202.
Stuart v. F. G. Stewart Co. (91 Fed. Rep. 243), 178, 179, 182, 331, 344.
v. F. G. Stuart Co. (33 C. C. A. 480), 177.
Stuart & Co. v. Scottish Val de Travers Paving Co. (Ct. Sess. Cas., 4th ser. 13, 1), 104.
Stuckes v. National Candy Co. (158 Mo. App. 342), 267.
Summit City Soap Works v. Standard Soap Co. (37 App. D. C. 604), 125.
Supreme Court of Hamilton-Brown Shoe Co. v. Wolf Bros. & Co. (240 U. S. 641), 195.
Supreme Lodge K. of P. v. Improved Order K. of P. (113 Mich. 133), 190.
Swain v. Johnson (151 N. C. 93), 365.
Swift v. Dey (4 Robertson, 611), 306, 475.
v. Peters (11 Id. 1110), 510.
Swift & Co. v. Brenner (125 Fed. Rep. 826), 379.
v. Groff (114 Fed. Rep. 605), 440.
Sykes v. Sykes (3 B. & Cr. 541), 83, 293, 399, 413.
Symington v. Footman (56 L. T. N. S. 696), 104.
Symonds v. Greene (28 Fed. Rep. 834), 121, 392, 393, 415, 453, 473, 488, 546.
v. Jones (82 Me. 302), 29.

T

Tabor v. Hoffmann (118 N. Y. 30), 257.
Taendsticksfabriks Aktiebolaget Vulcan v. Myers (139 N. Y. 364), 131, 444, 449.
v. Myers (11 N. Y. Sup. 663), 318.

References are to pages.

Talbot v. Wehley (3 B. P. C. 276), 115.
Tallcot v. Moore (6 Hun, 106), 202, 492.
Tarrant & Co. v. Hoff (71 Fed. Rep 163), 78.
v. Hoff (22 C. C. A. 644), 176.
v. Hoff (76 Fed. Rep. 959), 29.
Taussig v. Taussig (118 O. G. 2251), 571.
Taylor v. Ashton (11 M. & W. 402), 293.
v. Bemis (4 Biss. 406), 20, 27.
v. Bothin (Fed. Case No. 13780), 31, 58.
v. Carpenter (3) (11 Paige, 292), 68, 421 442.
v. Carpenter (3) (2 Sandf. Ch. 603), 17, 22, 305, 338.
v. Carpenter (1) (3 Story, 458), 22, 127, 206, 443, 855.
v. Carpenter (2) (2 Wood. & M. 1), 22, 149, 206, 209, 211, 338, 416, 419.
v. Gillies (59 N. Y. 331), 103.
v. Howard (110 Ala. 468), 249.
v. Taylor (L. R. 2 Eq. 290), 177, 300, 344.
Taylor Iron & Steel Co. v. Nichols (70 N. J. Eq. 541), 255, 257.
Taylor Provision Co. v. Gobel (180 Fed. Rep. 938), 73, 109.
T. B. Dunn Co. v. Trix Mfg. Co. (63 N. Y. Supp. 33), 470.
Telephone Mfg. Co. v. Sumter Mfg. Co. (63 S. C. 313), 160.
Tennessee Coal Co. v. Kelly (163 Ala. 348), 365.
Terry Steam Turbine Co. v. B. F. Sturtevant Co. (204 Fed. Rep. 103), 434.
Tetlow v. Savournin (15 Phila. 170), 256.
v. Tappan (85 Fed. Rep 774), 26, 64, 70, 72, 130, 213.
Texas & P. R. Co. v. Wilder (92 Fed. Rep. 953), 485.
Thackeray v Saxlehner (60 C. C. A. 562), 208.
Thaddeus Davids Co. v. Davids (233 U. S. 461), 384.
v. Davids (165 Fed. Rep. 792), 564
v. Davids (190 Fed. Rep. 285), 564.
v. Davids (102 C. C. A. 249), 564.
The Amiable Nancy (16 U. S., 3 Wheat. 546, 558), 421.
The Collins Co. v. Oliver Ames & Son Corporation (18 Fed. Rep. 561-571), 495.
Thedford Medicine Co. v. Curry (96 Ga. 89), 398.
The Fair v. Jose Morales & Co. (82 Ill. App. 499), 26.
The Merchandise Marks Acts, 1887-1894 (50 and 51 Vict., c. 28), 20.
Theodore Rectanus Co. v. United Drug Co. (226 Fed. Rep. 545), 109, 128.
v United Drug Co. (141 C. C. A. 301), 450.
The Peck Bros. & Co. v. Peck Bros. Co. (51 C. C. A. 251), 189.
Thermogene Co. v. Thermozine Co. (225 Fed. Rep. 446), 112.
Thomas G. Carroll & Son Co. v. McIlvaine & Baldwin (171 Fed. Rep. 125, 129), 73.
Thomas G. Plant Co. v. May Co. (44 C. C. A. 534), 10, 127, 195.
v. May Co. (100 Fed. Rep. 72), 127.
v. May Merc. Co. (153 Fed. Rep. 229), 127, 448.
Thompson v. Andrus (73 Mich. 551), 222.
v. Mackinnon (2 Steph. Dig. 726), 28.

References are to pages.

Thompson v. Montgomery (1891, App. Cas. 217), 162.
v. Montgomery (41 Ch. D. 354), 194.
v. Montgomery (6 R. P. C. 404), 551.
v. Winchester (36 Mass. 214), 112.
v Winnebago County (48 Iowa, 155), 222.
Thompson & Co. v. Robertson (Ct. Sess. Cas., 4th ser., XV, 880), 62.
Thomsen v. Union Castle Mail S. S. Co. (166 Fed. Rep. 251), 376.
Thomson v. Winchester (19 Pick. 214), 41.
Thorley's Cattle Food Co. v. Massam (42 L. T. N. S. 851), 177.
v. Massam (L. R. 46 L. J. Ch. 713), 53.
Thornbury v. Bevill (1 Y. & C. Ch. 554), 224.
Thornton v. Crowley (47 N. Y. Super. Ct. 527), 301.
Thum v. Andrews (53 Fed. Rep. 84, 85), 484.
Thum Co. v. Tloczynski (114 Mich. 149), 254, 256.
Thynne v. Shove (89 L. T. Jour. 84), 29.
v. Shove (L. R., 1890, 45 Ch. D. 577-582), 174, 181, 230.
Tichenor v. Newman (186 Ill. 264), 225.
Tim & Co. v. Cluett, Peabody & Co. (42 App. D. C. 212), 564.
T. M. Kildow Cigar Co. v. Geo. B. Sprague Cigar Co. (35 App. D. C. 345), 104.
Tobacco Co. v. Polacsek (170 Fed. Rep 117), 308.
Todd v. Whitaker (217 Fed. Rep. 319), 481.
Tode v. Gross (127 N. Y. 485), 246, 254.
Tonge v. Ward (21 L. T. N. S. 480), 331, 404, 443, 492.
Towle v. Spear (7 Penn. L. J. 176), 113.
Town v. Stetson (3 Daly, 53), 101.
v. Stetson (5 Abb. Pr. N. S. 218), 134.
Townsend v. Hurst (37 Miss. 679), 252.
Tracy v. Banker (170 Mass. 266), 62, 694.
Trademark Cases (100 U. S. 82), 17, 19, 64, 70, 378, 379, 407, 501, 531.
Trask Fish Co. v. Wooster (28 Mo. App. 408), 110.
Travelers' Insurance Machine Co. v. Travelers' Insurance Co. (134 S. W. Rep. 877), 112.
v. Travelers' Ins. Co. (143 Ky. 216), 187.
Trego v. Hunt (65 L. J. Ch. 1), 230, 240.
Trinidad Asphalt Co. v. Standard Paint Co. (163 Fed. Rep. 977), 193.
Trisdorfer & Co. v. Estate of Bassett (60 MSS. D. Sept. 1896), 70.
Tuck & Sons v. Priester (19 Q. B. D. 629) 260.
Tucker Mfg. Co. v. Boyington (Fed. Cas. No. 14229), 88.
v. Boyington (9 Off. Gaz. 455), 112, 301.
Tuerk Power Co. v. Tuerk (36 N. Y. Supp 384), 177.
Turner v. Evans (2 El. & El. 512), 242
v. Major (3 Giff. 442), 29, 222.
Turton & Sons, Ltd., v. Turton (42 Ch. D. 128), 175.
Tussaud v. Tussaud (38 W. R. 440), 29, 175, 177.
Tuttle v. Blow (176 Mo. 158, 173), 38.

References are to pages.

Twentsche Stoom Bleekery Goor v. Ellinger (26 W. R. 70), 404, 443, 444.

U

Ubeda v. Zialcita (226 U. S. 452), 437.
Udell-Predock Mfg. Co. v. Udell Works (32 App. D. C. 282), 121, 570.
Ullman v. Leviba (1908, A. C. 443), 9.
Underwood Typewriter Co. v. A. B. Dick Co. (163 Off. Gaz. 730), 390.
v. A. B. Dick Co. (36 App. D. C. 175), 567.
Ungles-Hoggette Mfg. Co. v. Farmers' Hog & Cattle Powder Co. (232 Fed. Rep. 116), 95.
Union Electric Co. v. Creamery Package Mfg. Co. (203 Fed. Rep. 53), 374.
Union Pacific Coal Co. v. United States (173 Fed. Rep. 737), 156.
Union Paper Collar Co. v. Metropolitan Collar Co., Ltd. (3 Daly, 171), 472.
Union Switch & Signal Co. v. Sperry (169 Fed. Rep. 926), 257.
United Lace Mfg. Co. v. Barthels Mfg. Co. (217 Fed. Rep. 175), 486.
United Lace & Braid Mfg. Co. v. Barthels Mfg. Co. (213 Fed. Rep. 535), 435.
v. Barthels Mfg. Co. (221 Fed. Rep. 456), 5, 116, 193, 324.
United States v. Braun (39 Fed. Rep. 775), 66, 386, 408, 531.
v. Campe (89 Fed. Rep. 697), 409, 410.
v. Duell (17 App. D. C. 478), 545.
v. Forty Barrels (241 U. S. 265), 155.
United States v. Freight Assn. (166 U. S. 290, 329), 247.
v. Holliday (3 Wall. 407), 535.
v. Julian (162 U. S. 324), 485.
v. Koch (40 Fed. Rep. 250-252), 408.
v. Loed (49 Fed. Rep. 636).
v. Marble (22 Id. 1366), 502.
v. National Lead Co. (75 Fed. Rep. 94), 472.
v. 132 Packages of Spirituous Liquors and Wines (76 Fed. Rep. 364, 368), 409, 410.
v. 132 Packages of Spirituous Liquors and Wines (22 C. C. A. 228), 409.
v. Roche (1 McCrary, 385), 501, 511.
v. Sandefuhr (145 Fed. Rep. 49), 410.
v. Seattle Brew. Co. (135 Fed. Rep. 597), 410.
v. Seymour (66 Off. Gaz. 1167), 539, 543.
v. Steffens (100 U. S. 82), 511.
v. Thirty Cases (199 Fed. Rep. 932), 152.
v. Thirty-Six Bottles (205 Fed. Rep. 111), 154.
v. Twenty Boxes (67 C. C. A. 214), 410.
v. Upham (43 Fed. Rep. 68), 536.
United States Cordage Co. v. Wm. Wall's Sons Rope Co. (35 N. Y. Supp. 978), 252.
United States Expansion Bolt Co. v. Kroncke Hdw. Co. (225 Fed. Rep. 383), 369.
United States, ex rel., Schumacher v. Marble (3 Mackey, 32), 515.
United States, ex rel., Wilcox & Gibbs Sewing Machine Co. v. Marble (1 Mackey, 284), 515.
United States Frame & Picture Co. v. Horowitz (100 N. Y. Supp. 705), 312.

References are to pages.

United States L. & H. Co. v. United States L. & H. Co. (181 Fed. Rep. 182, 184), 221.
United States Playing Card Co. v. C. M. Clark Pub. Co. (30 App. D. C. 208), 111.
v. Clark Pub. Co. (126 O. G. 2190), 573.
United States Tobacco Co. v. American Tobacco Co. (163 Fed. Rep. 701), 376.
v. McGreenery, 144 Fed. Rep. 531, 532), 297.
Universal Motor Truck Co. v. Universal Motor Co. (197 O. G. 533), 568.
Upmann v. Curry (29 Sol. J. 735), 405, 442.
v. Elkan (L. R. 12 Eq. 140), 302, 403, 405, 443, 491.
v. Forester (L. R. 24 Ch. D. 231), 302, 405, 438, 442, 443, 490.
Upper Assam Tea Co. v. Herbert (7 R. P. C. 183), 323.
Uri v. Hirsch (123 Fed. Rep. 568), 80.

V

Vacuum Oil Co. v. Climax Refining Co. (120 Fed. Rep. 254, 256), 193.
v. Climax Refining Co. (56 C. C. A. 90), 192.
v. Eagle Oil Co. (122 Fed. Rep. 105), 349.
Valentine v. Valentine (31 L. R. Ir. 488), 494.
Van Beil v. Prescott (82 N. Y. 630), 110.
Van Camp Packing Co. v. Cruikshanks Bros. Co. (90 Fed. Rep. 814), 279, 290, 451.
Vander Bergh & Co. v. Belmont Distilling Co. (99 Off. Gaz. 1624), 389.
Vanderbilt v. Mitchell (72 N. J. Eq. 910), 276.
Van Dyke v. Jackson (1 E. D. Smith, N. Y., 419), 245.
Van Hoboken v. Mohns & Kaltenbach (112 Fed. Rep. 528), 115, 313, 468.
Van Horn v. Coogan (52 N. J. Eq. 380), 127, 152, 329.
v. Coogan (52 N. J. Eq. 588), 127.
Van Houten v. Hooton Cocoa & Chocolate Co. (130 Fed. Rep. 600, 603), 354.
Van Kannel Revolving Door Co. v. American Revolving Door Co. (135 C. C. A. 439), 98, 261.
Van Raalt v. Schneck (159 Fed. Rep. 248), 426, 448, 458.
v. Schneck (95 C. C. A. 672), 426.
Van Stan's Stratena Co. v. Van Stan (209 Pa. 564), 320.
Van Zile v. Norub Mfg. Co. (228 Fed. Rep. 829), 126, 334.
Vassar College v. Loose-Wiles Biscuit Co. (197 Fed. Rep. 982), 278.
Verges v. Forshee (9 La. Ann. 294), 250.
Viano v. Baccigalupo (183 Mass. 160), 312.
Vickery v. Welsh (19 Pick. 523-527), 253.
Victor Safe & Lock Co. v. Deright (77 C. C. A. 437), 56.
Victor Talking Machine Co. v. Armstrong (132 Fed. Rep. 711), 279, 282.
Virginia Baking Co. v. Southern Biscuit Works (68 S. E. Rep. 261), 119.

References are to pages.

Virginia Hot Springs Co. v. Hegeman & Co. (138 Fed. Rep. 855, 862), 207.
Vitascope Co. v. United States Phonograph Co. (83 Fed. Rep. 30), 52, 131.
Vogt v. People (59 Ill. App. 684), 411.
v. People (57 Ill. App. 684), 668.
Volger v. Force (71 N. Y. S. 209), 326.
Von Bremen v. MacMonnies (200 N. Y. 41), 232.
Vonderbank v. Schmidt (44 La. Ann. 264), 239, 355.
Von Faber v. Faber (124 Fed. Rep. 603), 102, 175, 181.
Von Faber-Castell v. Faber (71 C. C. A. 383), 175, 181.
v. Faber (139 Fed. Rep. 257), 102.
v. Faber (2), (76 C. C. A. 538), 181.
Von Mumm v. Frash (56 Fed. Rep. 830-839), 168, 286, 306, 467.
v. Kirk (40 Fed. Rep. 589), 286.
v. Steinmetz (137 Fed. Rep. 168), 207.
v. Witteman (2), (33 C. C. A. 404), 279.
v. Wittemann (85 Fed. Rep. 966), 279, 290, 299.
Von Thodorovich v. Beneficial Assn. (154 Fed. Rep. 911), 277.
Vose v. Roebuck, etc., Co. (210 Fed. Rep. 687), 432.
Vulcan Detinning Co. v. American Can Co. (67 N. J. Eq. 243), 254, 265.
v. American Can Co. (70 N. J. Eq. 588), 257.
v. American Can Co. (72 N. J. Eq. 387), 257, 265.
v. American Can Co. (80 N. J. Eq. 443), 267.

W

W. A. Gaines & Co. v. E. Whyte Grocery, Fruit & Wine Co. (107 Mo. App. 507), 126.
v. Kahn (155 Fed. Rep. 639), 38, 217.
v. Knecht & Son (120 Off. Gaz. 1163), 390.
v. Leslie (54 N. Y. Supp. 421), 126, 329.
v. Rock Spring Dis. Co. (141 C. C. A. 287), 38, 119, 266, 564.
v. Rock Springs Dis. Co. (179 Fed. Rep. 544), 441.
v. Rock Spring Distilling Co. (226 Fed. Rep. 531, 537), 64, 488.
v. Rock Spring Distilling Co. (226 Fed. Rep. 538), 25.
v. Turner-Looker Co. (123 C. C. A. 79), 327, 447.
Wagner v. Daly (97 Hun, 477), 71.
Wagner Typewriter Co. v. F. S. Webster Co. (144 Fed. Rep. 405), 406.
Walker v. Alley (13 Grant Up. Can. Ch. 366), 319.
v. Mikolas (79 Fed. Rep. 955), 324.
v. Reid (Fed. Case No. 17084), 111, 342.
Wallace v. D. Appleton & Co. (161 Fed. Rep. 884), 477.
Wallach v. Wigmore (87 Fed. Rep. 469), 59, 399, 417.
Wallis v. Wallis (4 Dr. 458), 443.
Walter v. Ashton (L. R., 1902, 2 Ch. 282), 348.
Walter Baker & Co. v. Baker (87 Fed. Rep. 209), 442.
v. Delapenha (160 Fed. Rep. 746), 69, 115, 324.
v. Harrison (32 App. D. C. 272), 567.

References are to pages.

Walter Baker & Co. v. Puritan Pure Food Co. (139 Fed. Rep. 680, 683), 306.
v. Sanders (80 Fed. Rep. 889, 891), 40, 462, 473.
v. Sanders (26 C. C. A. 220), 176, 449.
v. Slack (130 Fed. Rep. 514, 519), 457, 461, 462.
Walton v. Crowley (3 Blatch. 440), 68.
v. Crowley (Fed. Case No. 17133), 36, 305.
Warren v. Warren Thread Co. (134 Mass. 247), 30, 386.
Wellman & Dwire Tob. Co. v. Ware Tob. Works (46 Fed. Rep. 289), 112.
Wamsutta Mills v. Allen (12 Phila. 535), 308, 332.
Wandt v. Hearst's Chicago American (129 Wis. 419), 276.
Ward v. Drat (Cox, Manual, 607), 53.
v. Robinson (L. R. 9 Ch. D. 487), 32, 215.
Warfield v. Booth (33 Md. 63), 225.
Waring v. Cox (1 Camp. 369), 17.
Warner v. Roehr (Fed. Case No. 17189A), 416, 420, 852.
v. Searle & Hereth Co. (191 U. S. 195), 380, 392, 429, 550.
Warner Bros. Co. v. Wiener (218 Fed. Rep. 635), 13, 131.
v. Wiener (134 C. C. A. 393), 332.
v. Wiener (130 C. C. A. 424), 332.
Warren Bros. v. Barber Asphalt Paving Co. (145 Mich. 79), 52.
Warren Featherbone Co. v. American Featherbone Co. (72 C. C. A. 571), 89.
Warwick Tyre Co. v. New Motor Co. (1910, 1 Ch. 248), 399.
Washburn v. Dosch (68 Wis. 436), 231.
v. National Wall Paper Co. (81 Fed. Rep. 17-20), 220, 226.
Washburn & Moen Mfg. Co. v. Freeman Wire Co. (41 Fed. Rep. 410), 472.
v. Haish (Fed. Case No. 17217), 87.
Washington Medallion Pen Co. v. Easterbrook (Fed. Case No. 17246a), 281.
Waterman v. Shipman (130 N. Y. 301), 92, 123.
Waterman Co. v. Modern Pen Co. (235 U. S. 88, 94), 187.
Watkins v. Landon (52 Minn. 389), 214, 253, 708.
Watt v. O'Hanlon (4 P. R. 1), 108, 136.
Waukesha H. M. Springs Co. v. Hygeia S. D. Water Co. (11 C. C. A. 277), 58.
Waukesha Hygeia Mineral Springs Co. v. Hygeia Sparkling Distilled Water Co. (63 Fed. Rep. 438), 123.
v. Hygeia Distilled Water Co. (70 Off. Gaz. 1319), 536, 547.
v. Hygeia Sparkling Distilled Water Co. (11 C. C. A. 282), 123.
Wayne County Preserving Co. v. Olney Canning Co. (32 App. D. C. 279), 563.
Weber Medical Tea Co. v. Kirchstein (101 Fed. Rep. 580), 318.
v. Weber (102 Fed. Rep. 156), 463.
Webster v. Webster (3 Swanst. 490), 29, 424.
v. Williams (62 Ark. 101), 225.
Wedderburn v. Wedderburn (22 Beavan, 84-104), 220.

References are to pages.

Weed v. Peterson (12 Abb. Pr. N. S. 178), 29, 230, 310, 490, 492.
Weener v. Brayton (152 Mass. 101), 4, 9, 62, 424, 490.
Weinstock, Lubin & Co. v. Marks (109 Cal. 529), 328, 346, 537, 637.
Welch v. Knott (4 K. & J. 747), 313, 337.
Weldon v. Dick (L. R. 10 Ch. D. 247), 206.
Wellcome v. Baum (135 O. G. 894), 566.
v. Thompson & Capper (1 L. R. Ch. Div., 1904, p. 736, 742, 749, 750, 754), 195.
Wellman & Dwire Tobacco Co. v. Ware Tobacco Works (46 Fed. Rep. 289), 286.
Wells v. Ceylon Perfume Co. (105 Fed. Rep. 621), 335.
Wells & Richardson Co. v. Siegel, Cooper & Co. (106 Fed. Rep. 77), 117.
Welsbach Light Co. v. Adam (107 Fed. Rep. 463), 64, 332, 350, 545.
Welz v. Rhodius (87 Ind. 1), 234.
Wentzel v. Barbin (189 Pa. 502), 232.
Wertheimer v. Bacheller Importing Co. (185 Fed. Rep. 850), 123.
v. Stewart, Cooper & Co. (23 R. P. C. 481), 348.
Wessell v. Havens (91 Neb. 426), 231
Western Grocer Co. v. Caffarelli Bros. (108 S. W. Rep. 413), 8, 119.
Westervelt v. National Paper Co. (154 Ind. 673), 256, 257, 258.
Westminster Laundry Co. v. Hesse Envelope Co. (174 Mo. App. 238), 367.
Weston v. Hemmons (2 Vict. L. R. Eq. 121), 256.
v. Ketchum (1), (39 N. Y. 54), 26, 29, 399.
v. Ketchum (2), (51 How. Pr. 455), 26, 34.
Wetmore v. Scovell (3 Edw. Ch. 515), 260.
Weyman v. Soderberg (108 Fed. Rep. 63), 101, 159, 311.
Whann v. Whann (116 La. 690), 89.
Wharton v. Thurber (Cox, Manual, 663), 491.
W. H. Baker v. Baker (C. D., 1906, p. 337), 565.
Wheeler v. Johnston (3 L. R. Ir. 284), 61.
Wheeler & Wilson Mfg. Co. v. Shakespear (39 L. J. Ch. 36), 88.
Wheeler-Stenzel Co. v. American Window Glass Co. (202 Mass. 471), 364, 365.
v. National Window Glass Assn. (152 Fed. Rep. 864), 376.
White v. Jones (1 Abb. Pr. N. S. 337), 231.
v. Trowbridge (216 Pa. 11), 174, 220.
v. Wagar (83 Ill. App. 592), 410, 668.
v. Wagar (185 Ill. 195), 410, 668.
Whitcomb v. Converse (119 Mass. 38), 28.
Whitehead v. Kiston (119 Mass. 484), 56.
Whitford v. County of Clark (119 U. S. 522), 480.
Whitfield v. Loveless (64 Off. Gaz. 442), 355.
Whiting Mfg. Co. v. Jos. H. Bauland Co. (56 N. Y. Supp. 114), 452.

References are to pages.

Whitman v. Hubbell (30 Fed. Rep. 81), 393.
Whitney v. Robertson (124 U. S. 190-194), 535.
Whittaker v. Howe (3 Beavan, 383), 224.
Whittemore Bros. & Co. v. Hauthaway (132 O. G. 233), 564, 577.
Whittier v. Dietz (66 Cal. 78), 19, 396, 637.
Whitwell v. Continental Tobacco Co. (125 Fed. Rep. 454), 375.
Wickers v. Weinwurm (C. D., 1907, p. 219), 572.
Wightman v. Wightman (111 N. E. Rep. 881), 225.
Wilcox & Gibbs Sewing Machine Co. v. Gibbons' Frame (21 Blatchf. 431), 279, 508.
v. The Gibbens Frame (17 Fed. Rep. 623), 88.
Wilkinson v. Greely (Fed Case No. 17671), 470.
v. Griffith (8 R. P. C. 370-374), 307, 321.
William Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co. (11 Fed. Rep. 495), 185.
Williams v. Adams (8 Biss. 452), 131.
v. Brooks (50 Conn. 278), 444, 468.
v. Farrand (88 Mich. 473), 220, 231, 232, 243.
v. Johnson (2 Bos. 1), 131, 177, 284, 444.
v. Mitchell (45 C. C. A. 265), 117, 463.
v. Mitchell (106 Fed. Rep. 168), 457.
v. Osborne (13 L. T. N. S. 498), 444.
v. Pope (215 Fed. Rep. 1000), 435, 436.
v. Spence (25 How. Pr. 366), 131.
Williams v. Williams (3 Mer. 157), 254.
v. Wilson (4 Sandf. Ch. 379), 229.
Williams Mfg. Co. v. Noera (158 Mass. 110), 149.
Wilmer v. Thomas (74 Md. 485), 30, 386.
Wilson v. American Ice Co. (206 Fed. Rep. 736), 428.
v. Delaney (137 Ia. 636), 248.
v. Singer Mfg. Co. (12 Fed. Rep. 57), 84.
Winchester Repeating Arms Co. v. Butler Bros. (128 Fed. Rep. 976), 394.
v. Peters Cartridge Co. (30 App. D. C. 505), 110.
v. Peters Cartridge Co. (C. D., 1908, p. 401), 562.
Winn v. Gilmer (27 Fed. Rep. 817), 536.
Winsor v. Clyde (9 Phila. 513), 403.
Wirtz v. Eagle Bottling Co. (50 N. J. Eq. 164), 296, 306.
Witkop & Holmes Co. v. Boyce (112 N. Y. S. 874), 257.
v. Boyce (118 N. Y. Supp. 461, 464), 363.
v. Boyce (61 N. Y. Misc. 126), 361.
v. Great Atlantic & Pacific Tea Co. (124 N. Y. Supp. 956), 360.
Witt v. Reed Electric Co. (187 Pa. 424), 263.
Witthaus v. Braun (44 Md. 303), 25, 27, 28, 227.
Wolfe v. Alsop (2) (12 Vict. L. R., E., 421), 418.
v. Alsop (10 V. L. R. Eq. 41), 110.
v. Barnett (24 La. Ann. 97), 213, 444.
v. Burke (56 N. Y. 115), 174.

References are to pages.

Wolfe v. Burke (7 N. Y. Sup. Ct.), 151), 79.
v. Goulard (18 How. Pr. 64), 110, 159.
v. Hart (4 V. L. R. Eq 125), 110, 346.
v. Lang (13 Vict. L. R. 752), 110, 418.
Wolf Bros. & Co v. Hamilton-Brown Shoe Co. (165 Fed. Rep. 413), 195, 324.
v. Hamilton-Brown Shoe Co. (125 O. G. 667), 559.
Wood v. Burgess (L. R. 24 Q. B. D. 162), 411.
v. Butler (3 R. P. C 81), 79.
v. Hinchman (110 Off. Gaz. 600), 336.
v. Lambert (L. R. 32 Ch. D. 247), 9, 62, 215.
Woodcock v. Guy (33 Wash. 234), 66, 821.
Woodman v. United States (15 Ct. of Cl. 541), 501.
Woods v. Sands (Fed. Case No. 17963), 181, 355.
Woodward v. Lazar (21 Cal. 448), 355, 637.
Woolf v. Woolf (43 Sol. J. 127), 490.
Woolner v. Rennick (170 Fed. Rep. 662), 410.
Woolsey v. Judd (4 Duer. 379).
Wooster v. Kisch (26 Hun, 61), 246.
Worcester Brewing Corporation v. Reuter & Co. (157 Fed. Rep. 217), 129.
v. Reuter & Co. (84 C. C. A. 665), 111, 206, 458.
Worden v. California Fig Syrup Co. (102 Fed. Rep. 334), 100.
Worden & Co. v. California Fig Syrup Co. (187 U. S. 515), 100, 447.
Wormser v. Shayne (11 Ill. App. 556), 445.
Wotherspoon v. Curie (22 L. T. N. S. 260), 39.
v. Currie (L. R. 5 H. L. 508), 121, 171, 194, 293, 295.
v. Gray (Ct. Sess. Cas., 3d ser., 2, 38), 113.
Woven Steel Co. v. Keasbey & Mattison Co. (41 App. D. C. 247), 566.
Wm. A. Rogers, Ltd. v. Cohannet Silver Co. (186 Fed. Rep. 241), 177.
Wm. G. Rogers Co. v. International Silver Co. (55 C. C. A. 83), 179.
Wm. J. Moxley Co. v. Braun & Fitts Co. (93 Ill. App. 183), 17.
Wm. Rogers Mfg. Co. v. Rogers (73 Off. Gaz. 970), 179.
v. Rogers (84 Fed. Rep. 639), 174.
v. Rogers & S. Mfg. Co. (11 Fed. Rep. 495), 64, 159, 174, 181.
v. R. W. Rogers Co. (66 Fed. Rep. 66), 174, 175, 177.
v. Simpson (54 Conn. 527), 175.
Wm. Wrigley, Jr., & Co. v. Grove Co. (161 Fed. Rep. 885), 111.
v. Norris (34 App. D. C. 138), 111.
W. N. Sharpe, Ltd. v. Solomon Bros. (31 R. P. C. 441, 450), 97.
Wright v. Simpson (15 Off. Gaz. 968), 32, 502, 518.
Wright & Taylor v. Bluthenthal & Bickert (119 O. G. 2234), 571.
W. R. Lynn Shoe Co. v. Auburn-Lynn Shoe Co. (62 Atl. Rep. 499), 115.
Wyckoff v. Howe Scale Co. (100 Fed. Rep. 520), 66.
Wyckoff, Seamans & Benedict v. Howe Scale Co. (58 C. C. A. 510), 66.

References are to pages.

Y

Yale & Towne Mfg. Co. v. Alder (154 Fed. Rep. 37), 379, 371.
v. Alder (83 C. C. A. 149), 292.
Yale Mfg. Co. v. Yale (30 Off. Gaz. 1183), 122, 502, 511, 512, 543, 544.
Yonkers Brewery v. Iler & Burgweger (143 O. G. 258), 572.
Young v. Jones (3 Hughes, 274), 29.
v. Jones (Fed. Case No. 18159), 31, 58.
Young v. Macrae (9 Jur. N. S. 322), 88, 108.

Z

Zanturjian v. Boornazian (25 R. I. 151), 232, 240.
Zittlosen Mfg. Co. v. Boss (135 C. C. A. 551), 193.
Zych v. American Car & Foundry Co. (127 Fed. Rep. 723, 727), 485.

HOPKINS ON TRADEMARKS

CHAPTER I.

PREFATORY.

§ 1. **Primitive merchandise marks.**—The history of commerce is the history of civilization. The hinterland is but a fairy net-work of legend and fable, of myth that involves itself with a precarious entanglement of possible facts.

Just as the refinements of modern thought have produced the juristic science of unfair competition, the vanity, superstition, or forethought of the primitive trader led him to imprint upon his wares his name, some symbol associated with the religion that calmed his fear of the hereafter, or, finally, a mark to point out the origin of his goods.

The idler, scrawling his name with rude *graffiti* on the walls of Rome or Pompeii, made as near an approach to a trademark as did the kings who pressed their names and titles on the bricks of Babylon.

The worshipper of Mithras imprinted on his bricks the sacred symbol of water, as did the early Christians their favored emblems, the palm-branch and the fishes.

But among the very earliest brick-stamps there are specimens which bear not merely the maker's name, or a picture of religious significance, but fanciful designs whose object was commercial identification unless, indeed, it was purely artistic.

So, too, we find upon the lead water-pipes exhumed at Ostia symbols to which we may reasonably attribute true trademark quality.

Maker's names, in the early centuries of the Christian era, are almost universally used. The charred loaves of bread excavated at Pompeii are so marked, and it is generally so

with the bricks of Babylon and Rome, and lead pipe wherever produced. Other markings by way of lettering have a wide range of significance, frequently indicating ownership of the particular article and nothing more.

We walk in almost absolute darkness along these dim historic trails. On every hand are signs that show the coming importance of trademarks. But Rome is to reach her zenith and her debacle, the Middle Ages are to intervene, the new world beyond the Atlantic is to be discovered, modern Europe is to be reorganized by states and peoples, before we next reach traces of the use of identifying marks in trade. Even then the law of trademarks will not come into existence until generations of traders have come and gone.

The history of the law of trademarks is pretty accurately at our service. The history of the early use of trademarks has never been written, and most of its evidences have crumbled into dust. For those illuminating examples of ancient marks preserved to us, the labor of the archæologist alone is responsible, and to him our appreciation is due.

§ 2. The need of legal restraint of unfair trade.—It is not the spirit of our laws to interfere with fair competition. It is for the best interests of society that prices should be adjusted by the economical laws of supply and demand. With limitations that have been imposed by varying local conditions, tempered by the caprices of legislation and the idiosyncrasies of judges, our common and statutory law alike condemn contracts in restraint of trade, and monopolies, complete or partial. But, on the other hand, there are recognized property rights which are of necessity monopolistic in their character. The most notable are those created by the patent and copyright laws, which grant, for a limited time, a monopoly in the production of the brain of the author or inventor. The value of these laws in the advancement of science, manufacture and art is universally recognized. Closely allied to these rights is the right of those engaged in commerce to be subjected to none but fair competition.

Unfair competition consists in passing off one's goods as the goods of another, or in otherwise securing patronage that should go to another, by false representations that lead the

patron to believe that he is patronizing the other person. It is of vital importance to healthy business conditions that such competition should be suppressed. It is equally important, however, that fair competition shall not be interfered with. Whether the competitive acts complained of are fair or unfair is the controlling issue in each litigated case.

It is apparent that the simplest means of depriving another of the trade he has built up is to copy the marks he places on his merchandise. This is the easiest method of stealing his trade, and most universal because of the general use of marks or brands upon personal property. The use of such marks runs far back into the shadows of history, and to the period when a knowledge of written language was unusual among tradesmen. It is only natural that these marks used in trade, or trademarks, should have first become the subjects of judicial consideration, and that the law concerning them should have reached a state of comparatively complete development before infringers began to employ other and more obscure means to divert trade.

It is true, as well, that the development of the law of the technical trademark tended to encourage the buccaneers of commerce to invent new and subtler means of stealing another's trade without trespassing upon his trademark rights. But the law, steadily though slowly, extended its bulwark of protection about the legitimate trader, until at length he was afforded legal redress in some form, not always adequate or complete, against the fraudulent diversion of his trade, in whatever form it might appear.

In the light of these facts it is self evident that the law of the technical trademark must first be mastered before the student can with understanding study the gradual evolution, from this protoplasm, of the larger law regulating all unfair competition in trade.

From the early days of commerce, probably from its beginning, the keen rivalry of competing merchants has led to the use of unfair and dishonest methods of diverting custom. With the growth of commerce has come a corresponding increase of fraudulent competition and its attendant evils. The English speaking people were slow to realize that some legal

restraint should be imposed upon the dealer who seeks to secure patronage by dressing his goods in a manner calculated to deceive the public into a belief that they are the goods of another. There are a few unimportant unfair trade cases in the English reports of the eighteenth century; the first reported American decision was rendered in 1825.[1] The law as it is administered by the courts of the United States today is almost wholly the product of the last half century.

The purpose of this treatise is to discuss the law of unfair trade in its broadest sense, including not only the law of trademarks, but also the principles applicable to the restraint of fraudulent competition in cases where no trademark is involved. "The law of trademarks is but part of the law of unfair competition in trade."[2]

§ 3. Trademark defined.[3]—A trademark is a distinc-

1—Snowden v. Noah, Hopkins Ch. 347.

2—Bradford, J., in Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651, 659.

3—*Judicial definitions.* — "A trademark may consist of a name, symbol, letter, form or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, to distinguish the same from those manufactured or sold by another, to the end that the goods may be known in the market as his, and to enable him to secure such profits as result from his reputation for skill, industry, and fidelity." Mr. Justice Clifford in McLean v. Fleming, 96 U. S. 245, 254, 24 L. Ed. 832, and in Amoskeag Mfg. Co. v. Trainer, 101 U. S. 51, 60, 25 L. Ed. 993.

"A trademark, properly so called, may be described as a particular mark or symbol, used by a person for the purpose of denoting that the article to which it is affixed is sold or manufactured by him or by his authority, or that he carries on business at a particular place." Lord Cranworth in Leather Cloth Co. v. American Leather Cloth Co., 35 L. J. Ch. 61.

"A trademark is a mere notice, an arbitrary mark or sign put on an artificial product, whereby any person interested in the information may be assured as to the origin of said product." Showalter, J., in Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376, 380.

"A trademark is a peculiar name or device, by which a person dealing in an article designates it as of a peculiar kind, character or quality, or as manufactured by or for him, or dealt in by him, and of which he is entitled to the exclusive use." Devens, J., in Weener v. Brayton, 152 Mass. 101, 102.

"A trademark is a form, symbol or name appropriated by one who produces or deals in a particular thing, or conducts a particular business, to designate the origin or

ownership thereof." Sloss, J., in Italian Swiss Colony v. Italian Vineyard Co., 158 Cal. 252, 110 Pac. Rep. 913.

"A trademark is a distinctive mark of authenticity through which the products of a particular manufacturer may be distinguished from others." Veeder, J., in United Lace & Braid Co. v. Barthels Mfg. Co., 221 Fed. Rep. 457, 459.

"A trademark has been very well defined as one's commercial signature to his goods." Dyer, J., in Leidersdorf v. Flint, 8 Biss. 327, Fed. Case No. 8,219. For the origin of this definition, see Browne on Trademarks, § 130, n. 2 (2d Ed.).

The same definition occurs in Star Co. v. Wheeler Syndicate, 155 N. Y. S. 782.

"It is a mode of designating goods as being the goods which have been, in some way or other, dealt with by A. B., the person who owns the trademark." Kay, J., *In re* The Australian Wine Importers (Ltd.), L. R. 41 Ch. D. 278, 281.

"Symbols or devices used by a manufacturer or merchant to distinguish the products, manufactures, or merchandise which he produces, manufactures or sells, from that of others, are called and known by the name of trademarks. They are used in order that such products, manufactures or merchandise may be known as belonging to the owner of the symbol or device, and that he may secure the profits from its reputation or superiority." Mr. Justice Clifford in Amoskeag Mfg. Co. v. Trainer, 101 U. S. 51, 56, 25 L. Ed. 993.

"Any name, symbol, letter, figure or device adopted by the persons manufacturing or selling goods, and used and put upon such goods to distinguish them from those manufactured or sold by others, and employed so often and for such a length of time, as to raise the presumption that the public would know that it was used to indicate ownership of the goods in the person manufacturing or selling them, constitutes his trademark." Rhodes, J., in Derringer v. Plate, 29 Cal. 292; Cox, 324.

"A trademark is a symbol arbitrarily selected by a manufacturer or dealer, and attached to his wares to indicate that they are his wares." Douglas, J., in Cady v. Schultz, 19 R. I. 193; 61 Am. St. Rep. 763, 765.

"It is a sign or mark by which the manufactured articles produced by one person, or firm, or maker are distinguishable from those produced by rival manufacturers." Williams, J., in Hoyt v. Hoyt, 143 Pa. St. 623; 24 Am. St. Rep. 575.

"A trademark consists of a word, mark or device adopted by a manufacturer or vendor to distinguish his productions from other productions of the same article." Gilfillan, C. J., in Cigarmakers' Protective Union v. Conhaim, 40 Minn. 243; 12 Am. St. Rep. 726.

"A trademark is a name, sign, symbol, mark, brand, or device of any kind, used to designate the goods manufactured or sold, or the place of business of the manufacturer or dealer in such goods." Beck, J., in Shaver v. Shaver, 54 Iowa, 208; Price & Steuart, 395.

"A trademark may consist of anything, marks, forms, symbols,

which designated the true origin or ownership of the article." Monell, J., in Godillot v. Hazard, 44 N. Y. Sup. Ct. 427.

"A trademark is . . . the name, symbol, figure, letter, form, or device used by a manufacturer or merchant to designate the goods he manufactures or sells, to distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and to secure such profits as result from a reputation for superior skill, industry or enterprise." Crawford, J., in Larrabee v. Lewis, 67 Ga. 562.

"A trademark is an arbitrary character or characters without special meaning, adopted by persons, firms or corporations for the purpose of identifying the goods manufactured by them or of which they have the sale." Marble, Commissioner, in *Ex parte* Freiberg & Workum, 20 Off. Gaz. 1164.

"Broadly defined, a trademark is a mark by which the wares of the owner are known in trade. Its object is two-fold: First, to protect the party using it from competition with inferior articles; and second, to protect the public from imposition. . . . Anything which can serve to distinguish one man's productions from those of another may be used. The trademark brands the goods as genuine, just as the signature to a letter stamps it as authentic." Coxe, J., in Shaw Stocking Co. v. Mack, 12 Fed. Rep. 707, 710.

"A trademark is any proper mark by which goods and wares of the owner or manufacturer are known in the trade. Courts of equity have two objects in view in granting injunctions against their imitation: 1. To secure to the individual adopting one the profits of his skill, industry and enterprise; 2. To protect the public against fraud." Nixon, J., in Humphreys' Specific Med. Co. v. Wenz, 14 Fed. Rep. 250, 252.

"A trademark is a sign or symbol primarily confined exclusively to the indication of the origin or ownership of the goods to which it may be attached and it may be composed of any name, device, line, figure, mark, word, letter, numeral or combination or arrangement of any or all of these, which will serve the sole purpose of a trademark, and which no other person can adopt or use with equal truth." Hargis, J., in Avery v. Meikle, 81 Ky. 73.

"A trademark consists of a word, mark, or device adopted by a manufacturer or vendor to distinguish his production from other productions of the same article." Wallace, J., in Hostetter v. Fries, 17 Fed. Rep. 620, 622.

"A trademark, as defined by Bouvier, is a sign, writing or ticket put on manufactured goods, to distinguish them from others. It has, by a commentator on trademarks, been more fully explained as a name, symbol, figure, letter, form, or device, adopted and used by a manufacturer or merchant to designate the goods he manufactures or sells to distinguish them from the goods of another." Allison, P. J., in Ferguson v. Davol Mills, 2 Brewst. 314.

"A trademark is some arbitrary or representative device attached to or sold with merchandise and serving to designate the origin or manufacture of that merchandise."

Carpenter, J., in Davis v. Davis, 27 Fed. Rep. 490, 491.

"What is a trademark? A 'mark' means to make a visible sign upon something, to affix a significant mark to; to draw, cut, fasten, brand; a token upon, indicating or intimating something; to affix an indication to; to attach one's name or initials to. A trademark, therefore, consists of the use in trade of such a mark, placed upon goods manufactured by a particular person and placed in the market with such marks, for sale and trade." Welker, J., in Adams v. Heisel, 31 Fed. Rep. 279, 280.

"A trademark is properly defined by Upton (Upton's Trademarks, 9) as 'the name, symbol, figure, letter, form or device adopted and used by a manufacturer or merchant, in order to designate the goods that he manufactures or sells, and distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry or enterprise.' The trademark must be used to indicate not the quality, but the origin or ownership of the article to which it is attached. It may be any sign, mark, symbol, word or words, which others have not an equal right to employ for the same purpose." Earl, Commissioner of Appeals, in Newman v. Alvord, 51 N. Y. 189, 193.

"Every one is at liberty to affix to a product of his own manufacture any symbol or device, not previously appropriated, which will distinguish it from articles of the same general nature manufactured or sold by others, and thus secure to himself the benefits of increased sale by reason of any peculiar excellence he may have given to it. The symbol or device thus becomes a sign to the public of the origin of the goods to which it is attached, and an assurance that they are the genuine article of the original producer. In this way it often proves to be of great value to the manufacturer in preventing the substitution and sale of an inferior and different article for his products. It becomes his trademark, and the courts will protect him in its exclusive use." Mr. Justice Field in Amoskeag Mfg. Co. v Trainer, 101 U. S. 51, 53; 25 L. Ed. 993.

"*Trademark.*—An arbitrary symbol affixed by a manufacturer or merchant to a vendible commodity. The principal purpose of a trademark is to guarantee the genuineness of a product. It is, in fact, the commercial substitute for one's autograph. In all ages it has been used to denote origin, and thus protect the purchaser as well as the vendor. All countries protect the integrity of trademarks, and nearly all civilized nations have treaties or conventions securing reciprocity of protection. The tests of a trademark are: 1. Universality; that is, commonly recognized as such. 2. Exclusiveness; in the possession of the owner. 3. Individuality; must indicate origin and ownership. 4. Must be for merchandise. 5. Must be in a lawful business. 6. Must be distinct and invariable." Knight's Mechanical Dictionary, title "Trademark," p. 2609.

"Our word 'trademark' comprehends both the *marque de fabrique*

and *marque de commerce* of France." Townsend, J., in La Republique Francaise v. Schultz, 57 Fed. Rep. 37, 41.

"A distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others." Mr. Chief Justice Fuller in Elgin Nat. Watch Co. v. Illinois Watch Case Co. (2), 179 U. S. 665, 673, 45 L. Ed. 365.

"A trademark is a name or a mark or a device which is attached to the article to point out its origin." Shipman, J., in Adee v. Peck Bros. & Co., 39 Fed. Rep. 209, 210.

"A trademark is a word, a symbol or device by which the wares of the owner are known in trade." Coxe, J., in Kipling v. G. P. Putnam's Sons, 120 Fed. Rep. 631, 57 C. C. A. 295.

"A trademark is an arbitrary, distinctive name, symbol, or device, to indicate or authenticate the origin of the product to which it is attached." Deemer, C. J., in Sartor v. Schaden, 101 N. W. Rep. 511, 125 Iowa, 696.

"A trademark is a notice, a medium of information touching origin or ownership." Showalter, J., in Beadleston & Woerz v. Cooke Brewing Co., 20 C. C. A. 405; 74 Fed. Rep. 229, 234.

"A trademark is a means of authenticating or indicating the origin of an article." Billings, J., in Johnson v. Schenck, Fed. Case No. 7,412.

"A trademark is a distinctive mark of authenticity through which the products of a particular manufacturer may be distinguished from others." Veeder, J., in United L. & B. Mfg. Co. v. Barthels Mfg. Co., 221 Fed. Rep. 456, 459 (obviously too limited because it does not cover natural products, selectors' marks, etc.).

"A trademark is a guaranty that the goods to which it is attached are made by its owner." Coxe, J., in American Tobacco Co. v. Polacsek, 170 Fed. Rep. 117, 120.

"A trademark is a distinctive name, word, mark, emblem, design, symbol, or device used in lawful commerce to indicate or authenticate the source from which has come, or through which has passed, the chattel on or to which it is affixed." Fly, J., in Western Grocer Co. v. Cafferelli Bros. (Tex.), 108 S. W. Rep. 413, 414, (not officially reported) adopting the definition of the author.

"A trademark is something used on salable articles to designate them as the articles made by A., and to distinguish them from similar articles made or sold by B." Torrance, J., in Hygeia Distilled Water Co. v. Hygeia Ice Co., 40 Atl. 534, 540; 70 Conn. 516.

"The only recognized indication of a trademark is the source, origin or ownership of an article of merchandise on which it is placed. Caswell v. Davis, 58 N. Y. 223; 17 Am. Rep. 233. This means that the mark is calculated to distinguish the articles which bear it from those of other makers or vendors. It need not indicate any particular person as maker, manufacturer, or vendor, or give the name or address of either. When the mark has become recognized by purchasers as a distinctive designation of a particular manufacturer, maker, or seller of a certain quality of goods, it will be a suf-

tive[4] name, word, mark, emblem, design, symbol or device, used in lawful commerce to indicate or authenticate the source from which has come, or through which has passed,[5] the chattel upon or to which it is applied or affixed.[6]

ficient indication of the origin or ownership, within the rule requisite to its protection as such, though purchasers may not, from the words or otherwise, be able to tell who is the particular maker or seller of the articles. Its value is in its employment, marking the goods on which it is placed. This gives it the character of property. It is, then, a symbol of reputation or good will." People v. Fisher, 50 Hun, 552; 3 N. Y. Supp. 786; adopted in State v. Bishop, 31 S. W. Rep. 9, 11; 128 Mo. 373; 29 L. R. A. 200; 49 Am. St. Rep. 569.

4—By the word "distinctive," as used in our definition, is meant that the mark must be something which "shall be capable of distinguishing the particular goods in relation to which it is to be used from other goods of a like character belonging to other people." Lord Chief Justice Russell, in Rowland v. Mitchell, L. R. (1897) 1 Ch. D. 71, 74; Wood v. Lambert, L. R. 32 Ch. D. 247; 54 L. T. N. S. 314; 3 P. R. 81; (Court of Appeals) L. R. 32 Ch. D. 257; 55 L. J. Ch. 277; 54 L. T. N. S. 317; 3 P. R. 88; *Re* Perry Davis & Son, 58 L. T. N. S. 695; 5 P. R. 333, and many similar English cases treat of the word "distinctive" as used in the English Patents, Designs and Trademarks Act of 1883, section 64, subsection 1, c. But the word is used with the same significance by our own leading jurists, as for example, by Mr. Chief Justice Fuller, in Elgin National Watch Co. v. Illinois Watch Case Co. (2), 179 U. S. 665, 673; 45 L. Ed. 379; by Justice Holmes, in Northeastern Awl Co. v. Marlborough Awl Co., 168 Mass. 147; 60 Am. St. Rep. 373; and by Judge Lacombe in National Biscuit Co. v. Baker, 95 Fed. Rep. 136. For this reason the word is incorporated in the definition given in the text.

5—"The use of a trademark does not necessarily and as a matter of law import that the articles upon which it is used are manufactured by its user. It may be enough that they are manufactured for him; that he controls their production, or even that they pass through his hands in the course of trade, and that he gives to them the benefit of his reputation, or of his name and business style." Sheldon, J., in Nelson v. J. H. Winchell & Co., 203 Mass. 75; 89 N. E. Rep. 180; citing Weener v. Brayton, 152 Mass. 101, 102; 25 N. E. Rep. 46; 8 L. R. A. 640; McLean v. Fleming, 96 U. S. 245, 253; 24 L. Ed. 828; Menendez v. Holt, 128 U. S. 514, 520; 32 L. Ed. 526; Godillot v. Harris, 81 N. Y. 263, 266; *In re* Australian Wine Importers, L. R. 41 Ch. D. 278, 280, 281; Major Brothers v. Franklin (1908), 1 K. B. 712; Ullman v. Leviba (1908), A. C. 443.

6—The mode in which the mark is applied or affixed is immaterial. It may be water-marked in translucent fabrics. Price v. Goodall, L. R. (1891) 1 Ch. D. 35. It has been held to be a sufficient method

§ 4. Tradename defined.—The word "tradename" as used in the decisions has two different meanings. Standing alone, and separate from the word "trademark" it includes all business names; while in the expression "trademarks and tradenames" it means all business names which are not technical trademarks.[7]

Mr. Browne, in his valuable treatise on trademarks (sec. 91) uses the following language: "the distinction will be readily comprehended, when it is remembered that a trademark owes its existence to the fact that it is actually affixed to a vendible commodity. A tradename is more properly allied to the goodwill of a business." This distinction is of itself decidedly misleading. Many tradenames are "actually affixed to a vendible commodity,"[8] and as both trademarks and other tradenames are a constituent part of the goodwill of the business in which they are used, it is not possible for one class of names to be more properly allied to the goodwill than the other, nor is it proper to say of either that it is "allied" to something of which it is a component part.

A name is frequently referred to as a "trademark" and as a "tradename" in the same opinion.[9] Some of our ablest judges treat the words "tradename" and "trademark" as synonymous.[10]

Some of the cases dealing with tradenames are fairly bewildering to one who endeavors to reconcile them or deduce

of affixing the mark, to use it in advertising, and to place a lithographed fac-simile of it on a card, in a box containing a quantity of the goods. Hay & Todd Mfg. Co. v. Querns Brothers, 86 Off. Gaz. 1323. It has been held that to display the mark on a show-card placed on lots of candy in a show window, is not sufficient to establish a trademark right therein. Oakes v. St. Louis Candy Co., 146 Mo. 391; 48 S. W. Rep. 467.

7—N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 102 Fed. Rep. 327, 331; 42 C. C. A. 376; 92 Off. Gaz. 1437.

8—As "Minnesota Patent," in Pillsbury-Washburn Co. v. Eagle, 86 Fed. Rep. 608; 30 C. C. A. 386; and "Waltham," in American Waltham Watch Co. v. United States Watch Co., 173 Mass. 85; 53 N. E. Rep. 141.

9—Opinion of Seaman, J., in Postum Cereal Co. v. American Health Food Co., 109 Fed. Rep. 898.

10—Thomas G. Plant Co. v. May Co., 44 C. C. A. 534; 105 Fed. Rep. 375.

a general definition of "tradename" from them. In a Massachusetts case, for example, the court found that the defendant had acquired the right to the use of the name "John G. Loring & Co." as a "trademark" on goods, but had no right to use it as a tradename.[11]

This confusion is not lessened by those opinions in which the courts seek to point out functions common to trademarks and tradenames. For example, "a 'trademark' or 'tradename' is some symbol by which one man's manufacture is differentiated from another's." [12]

As a proper name can not be a trademark, under principles discussed elsewhere is this book, while the meaning of the word as used by the court is clear, the opinion lends no assistance to the distinction between "trademark" and "tradename."

Historically, this confusion probably arose in the English decisions. In one of the leading cases we find that Lord Chancellor Westbury said "a name or the style of a firm may by long usage become a mere trademark," [13] and in the same case, in the House of Lords, Lord Cranworth referred to the difficulties which "may arise where the trademark consists merely of the name of the manufacturer." [14]

Lord Romilly said in another case "the name or style of the firm of 'Banks & Co.' was an asset of the partnership, and if the whole concern and the good will of a business have been sold, the name, as a trademark, would have been sold with it." [15]

With this loose use of the word trademark by such eminent judges some forty years since, it is not remarkable that the bench and the profession have not yet drawn the line separating trademarks from tradenames with any degree of lucidity. The question of mere definition is nearly always a matter of secondary importance in the progress of any science. The want of an accurate distinction between trademarks and trade-

11—Bowman v. Floyd, 85 Mass. 76.

12—Hand, J., in R. Guastavino Co. v. Comerma, 180 Fed. Rep. 920.

13—Leather Cloth Co. v. American Leather Co., 4 DeG. J. & S. 141, 144.

14—Leather Cloth Co. v. American Leather Cloth Co., 11 H. L. C. 523, 533.

15—Banks v. Gibson, 34 Beav. 566.

names has not hampered the growth of this branch of the law; if it had, the distinction would long since have been drawn by the courts. The principles involved in trademark cases and tradename cases have been substantially identical. But with their development it has been necessary to sharply define the technical trademark, and if it were possible to draft as accurate a definition of tradename the result would be to measure the metes and bounds of the field of cases in which relief will be granted against the fraudulent use of a word or phrase used as the distinguishing identification mark of a commercial enterprise or article of trade.

It is clear that words of common right ought not to be called tradenames. Thus, the word "cracker" imprinted on a soda cracker indicates merely that it is a soda-cracker. As the article itself conveys that knowledge, the word is superfluous. Mark the cracker "Uneeda," and an entirely different result follows. The word is a trademark.[16] The word, so affixed, meets the requirements of all the definitions given herein. It is a distinguishing indication of origin and ownership. But take an example of another kind of word applied to a common staple article of merchandise. "Flour" stamped on a sack of flour is meaningless. "Patent Flour" means something more. "Minnesota Patent Flour" means patent flour made in Minnesota. Clearly the word "flour" alone, and the words "Patent Flour" together, can not be called tradenames, though they are names used in trade. They are of common right. They can be truthfully applied to flour regardless of the place where, or the person by whom, it is produced. "Minnesota Patent Flour" is not a trademark. It is of common right to all persons producing patent flour in Minnesota. But it is a tradename, because it will be a medium of fraud if persons producing flour elsewhere than in Minnesota are permitted to apply it to their flour.[17]

To use another example of a very common class. Any one can make soap and mark it "Soap." Any soap manufacturer can call his soap "Best Soap." A particular manufacturer adds his name to this mark and produces "Babbitt's Best

16—National Biscuit Co. v. Baker, 95 Fed. Rep. 135.

17—Pillsbury-Washburn Flour Mills Co. v. Eagle, 30 C. C. A. 386; 86 Fed. Rep. 608.

Soap.'' He has not made a trademark but he has made a tradename.[18] Another person named Babbitt entering the market subsequently must clearly distinguish his soap from that of the other Babbitt.

An example of a word descriptive of the composition of the article itself is ''Cellular Cloth,'' a cloth fabric having cells in its texture. This is not a tradename,[19] while ''Camel's Hair'' belting is.[20]

The reason for the distinction lies solely in the fact that the latter words became established in the trade as designating the goods of the first introducer. While the two marks on their faces are in identically the same category, the circumstances surrounding their commercial use have rendered the first strictly of common right, and the second that sort of quasi-trademark which for convenience, and because of the inadequacy of our vocabulary, we are constrained to call a tradename.

With all of these distinctions before us, and having regard solely to the meaning which should attach to the word ''tradename'' if it is to be accurately differentiated from the technical trademark, on the one hand, and the names completely *publici juris* employed in commerce on the other, the author submits the following definition: A tradename is a word or phrase by which a business enterprise or business location or specific articles of merchandise from a specific source are known to the public, and which when applied to merchandise is generic or descriptive and hence not susceptible of appropriation as a technical trademark.

This definition, the author confidently believes, will aid the reader in properly classifying and distinguishing the ''trademark'' and ''tradename'' cases, and that it properly includes not only commercial names other than those applied to mer-

18—Babbitt v. Brown, 68 Hun, 515. Other examples are the case of the "Dr. A. Reed Cushion Shoe." Dr. A. Reed Cushion Shoe Co. v. Frew, 162 Fed. Rep. 887; 89 C. C. A. 577, modifying Dr. A. Reed Cushion Shoe Co. v. Frew, 158 Fed. Rep. 552; the "Warner Corset" case, Warner Bros. Co. v. Wiener, 218 Fed. Rep. 635.

19—Cellular Clothing Co. v. Maxton, L. R. (1899) App. Cas. 326.

20—Reddaway v. Banham, L. R. (1896) App. Cas. 199.

chandise, but those names applied to merchandise which though they are not trademarks have acquired a secondary meaning in the trade and hence are protected in equity against their use by another in fraudulent competition.[21]

Thus Judge Wolverton, speaking of the words "Turpentine Shellac" applied to a wood filler, has said, "As a tradename, it may be properly so employed, but within itself it is inapt for exclusive appropriation as a trademark. Beyond this, however, words or symbols naturally descriptive of the product, while not adapted for exclusive use as a trademark, may yet acquire, by long and general usage in connection with the preparation and by association with the name of the manufacturer, a secondary meaning or signification, such as will express or betoken the goods of that manufacturer only, and in this sense he will be entitled to protection from an unfair use of the designation or tradename by others that may result in his injury and in fraud of the public." [22]

It has been asserted that "as a general rule a trademark has reference to the thing sold, while a tradename embraces both the thing sold and the individuality of the seller." [23]

This may be true if the tradename happens to be a proper name; otherwise it is an absolute mis-statement. No such distinction can be found in the cases, or in reason. A trademark concerns the individuality of the dealer quite as much as a tradename.

As to the relative scope of tradenames as compared with trademarks, the question presented is wholly academic. From a careful study of the cases it would seem clear that the trademark right is the broader and by far the more valuable; though the Kansas court has held the contrary.[24]

21—"A tradename does not have to be identical with that of another in order to justify a court in denying its use because calculated to produce unfair competition." Lansing, J., in Newport Sand Bank Co. v. Monarch Sand Mining Co., 144 Ky. 7; 137 S. W. Rep. 784.

22—Standard Varnish Works v. Fisher, 153 Fed. Rep. 928, 930.

23—Gose, J., in Eastern Outfitting Co. v. Manheim, 59 Wash. 428; 110 Pac. Rep. 23; following Armington v. Palmer, 21 R. I. 109; 42 Atl. Rep. 308; 43 L. R. A. 95; 79 Am. St. Rep. 786.

24—"The difference between a trademark and a tradename is emphasized in some of the authorities. The former relates chiefly to the

The English text-writer, Mr. Kerly, has included this class of words in his treatment of "tradenames." He says: 'A name which is applied or attached to a trader's goods when they are offered for sale, so as to distinguish them from similar goods, and to identify them with him, or with his successors as the owners of a particular business, as being made, worked upon, imported, selected, certified, or sold by him or them, is a trademark. And if it is within any of the classes enumerated in sec. 64 (of the British Patents, Designs and Trademarks Acts), it may be registered as a trademark. But whether or not the name is applied or attached to the goods, so as to conform to the definition just stated, or registered as a trademark, if it is in fact known in the market as the distinctive name of the goods of a particular trader, no one else may use it for dealings in other goods of the same class as those in connection with which it has acquired its distinctive significance. * * * The qualified right in the tradename—a right to prevent a defendant from passing off his goods as those of the plaintiff by the use of it—exists only with regard to goods of the kind for which the plaintiff uses it, and to which the connection with his business suggested by the use of the name extends." [25]

§ 5. **Earliest recognition of trademarks.**—While the reports of the first English trademark case are not harmonious, it is probable that the report of Popham is substantially correct. It is as follows: "An action upon the case was brought into the common pleas by a clothier that whereas he had gained great reputation for his making of his cloth by reason of which he had great utterance to his great benefit and profit, and that he used to set his mark to his cloth whereby it should be

thing sold, and the latter involves also the individuality of the maker both for protection in trade and to avoid confusion in business, as well as securing the advantages of a good reputation. It is said that a tradename, therefore, has a broader scope than a trademark. These observations are found, in substance, in the opinion in Armington v. Palmer, 21 R. I. 109; 42 Atl. 308; 43 L. R. A. 95; 79 Am. St. Rep. 786. That opinion is authority for the proposition that, in seeking an injunction in such cases, it is not necessary to show damages nor fraudulent intent." Benson, J., in Harryman v. Harryman, 144 Pac. Rep. 262; 93 Kas. 223.

25—Kerly on Trademarks, 2nd ed., London, 1901, p. 475.

known to be his cloth; and another clothier perceiving it used the same mark to his ill-made cloth on purpose to deceive him, and it was resolved that the action did well lie."[26]

§ 6. The evolution of the law of trademarks.—This decision, rendered in 1590, was the first legal recognition of trademarks. The growth of that recognition was very gradual, however, for as late as 1742 we find Lord Hardwicke saying that he "knew no instance of restraining one trader from making use of the same mark with another,"[27] although the learned chancellor takes judicial cognizance of the wide-spread use of trademarks, observing that "every particular trader had some particular mark or stamp." And a century later Lord Langdale said: "It does not seem to me that a man can acquire property merely in a name or mark."[28]

§ 7. The relative protection given by patents and trademarks.—"Usually the protection given by the patent is far greater, though of less duration in time, than that obtained by the use of a trademark, because if an article is patented, nobody but the owner of the patent can without his consent make or sell anything embodying the same principles or elements, while a trademark only secures one in the use of the name or emblem adopted by him and applied to the article."[29]

26—Southern (or Southerne) v. How, 2 Popham, 144; Cro. Jac. 471; 2 Rolle, 28; Cox, 633; Seb. Dig. 1.

27—Blanchard v. Hill, 2 Atk. 484; Cox, 633; Seb. Dig. 2. Mr. Sebastian observes of this decision: "The decision seems in a great measure to have been founded upon a dread of setting up a monopoly, the distinction between a trademark and a patent not being clearly present to his lordship's mind." Sebastian, Trademarks (4th ed.), p. 6.

28—1842. Perry v. Truefitt, 6 Beav. 66; 1 L. T. N. S. 384; Seb. 73; Cox, 644, 646. It is now clearly established that the right to a trademark is a property right. Hall v. Barrows, 4 DeG. J. & S. 150; 33 L. J. Ch. 204; 10 Jur. N. S. 55; 9 L. T. N. S. 561; Cox, Manual, Case No. 215. Opinion of Westbury, L. C., in Leather Cloth Co. v. American Leather Cloth Co., 4 DeG. J. & S. 141; Lord Cranworth, in House of Lords, s. c., 11 H. L. C. 533; Lord Kingsdown, in House of Lords, s. c., 11 H. L. C. 544; Messerole v. Tynberg, 4 Abb. Pr. N. S. 410; 36 How. Pr. 14; Cox, 479; Gilman v. Hunnewell, 122 Mass. 139; Cox, Manual, Case No. 541; Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co., 95 Fed. Rep. 457, 461; 37 C. C. A. 146.

29—Allen, J., in Dover Stamping Co. v. Fellows, 163 Mass. 191; 40 N. E. Rep. 105; 47 Am. St. Rep. 448; 28 L. R. A. 448.

§ 8. Trademarks distinguished from patents and copyrights.—While trademarks to a degree partake of the nature of both patents and copyrights, and the three have many governing legal principles in common, there are wide differences separating each from the others. As stated by Mr. Justice Miller in *Trademark Cases*,[30] "the ordinary trademark has no necessary relation to invention or discovery. The trademark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of congress it is sought to establish it by registration, neither originality, invention, discovery, science or art is in any way essential to the right conferred by that act. If we should endeavor to classify it under the head of writings of authors, the objections are equally strong. In this, as in regard to inventions, originality is required. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, etc., it is only such as are *original*, and are founded in the creative powers of the mind." And in the House of Lords, in 1882, Lord Blackburn said,[31] "trademarks have sometimes been likened to letters patent and sometimes to copyrights, from both of which they differ in many respects. And I think, to borrow a phrase used by Lord Ellenborough in *Waring v. Cox*,[32] with reference to a different branch of the law, 'much confusion has arisen from similitudinary reasoning on the subject.'"

§ 9. Function.—The function of a trademark is to convey to the purchaser knowledge of the origin, source, ownership or manufacture of the article to which it is applied.[33] The

30—100 U. S. 82, 94; 25 L. Ed. 550. See also Taylor v. Carpenter, 2 Sandf. Ch. 603; 11 Paige, 292; Cox, 45; Cox, Manual, Case No. 84; Levy v. Waitt, 21 U. S. App. 294; 61 Fed. Rep. 1008; 10 C. C. A. 227; Hoyt v. Hoyt, 143 Pa. St. 623; 24 Am. St. Rep. 575; Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624, 626; 35 C. C. A. 496. A trademark "may be, and usually is, wholly destitute of originality." Mr. Justice Brown in Duer v. Corbin Cabinet Lock Co., 149 U. S. 216, 223; 37 L. Ed. 707. To the same effect, see Wm. J. Moxley Co. v. Braun & Fitts Co., 93 Ill. App. 183.

31—Johnston v. Orr Ewing, 7 App. Cas. 219, 228.

32—1 Camp. 369.

33—"The function of a trademark is to indicate to the public

trademark need neither indicate the manufacturer or the place of the article's manufacture,[34] but may indicate either a natural product of the earth, or the handling or selection of the goods, or some labor that has been performed in connection therewith. It serves solely to guide the public to the goods it wants to buy, acting as a perpetual means of identification and advertisement of goods of repute.

§ 10. Nature of the right to a trademark.—The right to a trademark is a right of property,[35] which the state may, in the exercise of its police power, protect by appropriate penal legislation. This right of property is, in the United

the origin, manufacture or ownership of articles to which it is applied, and thereby secure to its owner all benefit resulting from his identification by the public with the articles bearing it. No person other than the owner of a trademark has a right, without the consent of such owner, to use the same on like articles, because by so doing he would in substance falsely represent to the public that his goods were of the manufacture or selection of the owner of the trademark, and thereby would or might deprive the latter of the profit he otherwise might make by the sale of the goods which the purchaser intended to buy. Where a trademark is infringed the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and it is on this ground that a court of equity protects trademarks. It is not necessary that a trademark should on its face show the origin, manufacture or ownership of the articles to which it is applied. It is sufficient that by association with such articles in trade it has acquired with the public an understood reference to such origin, etc." Bradford, J., in Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651, 656.

"The sign, symbol or mark may be purely fanciful, and convey no information as to the name of the producer. But the essential thing is that it shall be designed and used to indicate the origin of the article and that all articles having the same mark come from a common source." Lurton, J., in Deering Harvester Co. v. Whitman & Barnes Mfg. Co., 91 Fed. Rep. 376, 380; 33 C. C. A. 558; affirming Deering Harvester Co. v. Whitman & Barnes Mfg. Co., 86 Fed. Rep. 764.

"A trademark is a trademark because it is indicative of the origin of the goods." Denison, J., in Merriam v. Saalfield, 198 Fed. Rep. 369, 372; 117 C. C. A. 245, 248; followed in DeVoe Snuff Co. v. Wolff, 124 C. C. A. 302; 206 Fed. Rep. 420, 423.

34—"It is not essential to property in a trademark that it should indicate any particular person as the maker of the article to which it is attached." Danforth, J., in Godillot v. Harris, 81 N. Y. 263.

35—Derringer v. Plate, 29 Cal. 292; 87 Amer. Dec. 170; R. Cox, 324; Seb. 249; Bass, Ratcliff &

States, treated as a common-law right, and in no wise dependent upon statutory law for its inception.[36]

"Property in trademarks is recognized at common-law, and may be and has been made the subject of legislation in the states. It does not owe its existence as a right to any act of congress. Legislation, therefore, by congress, is the mere regulation of a pre-existing right, and is based upon the interstate character of the act."[37]

Lord Cranworth referred to this right as "a right which can be said to exist only and can be tested only by its violation."[38] While it is true that the right can only be tested after it has been violated, or its violation has been threatened, it is certainly untrue that it exists "only by its violation," because there is no violation of a right not pre-existing. Judge Folger, speaking for the New York Court of Appeals, criticised this dictum, saying, "but its violation is when one adopts or imitates, and applies to an article of his manufacture the name or mark previously used by another as a designation for his production. * * * It is a matter of property, and the profitable use of property."[39]

Much legislation has taken place tending to aid the common-law remedies and afford more effective redress against trademark piracy, but with the solitary exception of California[40] it has nowhere been held in the United States that

Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206, 212; Boston Diatite Co. v. Florence Mfg. Co., 114 Mass. 69; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537, 548; 34 L. Ed. 997; Liggett & Myer Tobacco Co. v. Hynes, 20 Fed. Rep. 883; G. G. White Co. v. Miller, 50 Fed. Rep. 277, 279.

36—Trademark Cases, 100 U. S. 82; 25 L. Ed. 550; Derringer v. Plate, *supra;* Moorman v. Hoge, 2 Sawyer, 78, 85; Fed. Case No. 9783; L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624, 626; Battle v. Finlay, 50 Fed. Rep. 106; Hennessy v. Braunschweiger, 89 Fed. Rep. 664; Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624, 627; 35 C. C. A. 496.

37—Dickinson, J., in Louis Bergdoll Brew. Co. v. Bergdoll Brew. Co., 218 Fed. Rep. 131, 132.

38—Farina v. Silverlock, 6 DeG., M. & G. 214, 217.

39—Congress & Empire Spring Co. v. High Rock Congress Spring Co., 45 N. Y. 291.

40—Whittier v. Dietz, 66 Cal. 78. The evil effect of this decision has since been obviated by the enactment of the present section 3199 of the Political Code of California, which provides that "any person who has first adopted and used a trademark or name, whether within or beyond the limits of this state, is its original owner."

compliance with a statute is a prerequisite to the acquisition of a trademark. The contrary rule obtains in England; registration being necessary to entitle the owner to sue for infringement.[41] A peculiar element of the trademark right is that it must be used as an entirety.[42] The owner of a trademark can not convey to others territorial rights to its use,[43] and a partner's interest in the trademarks owned by the partnership can not be levied upon by or subjected to the payment of claims of his personal creditors.[44]

§ 11. **The test of exclusiveness.**—The trademark right must be exclusive; by this test it stands or falls. As Judge Cochran has said, "what makes a mark affixed by a seller to goods produced or selected by him a technical trademark (*i. e.*, one whose exclusive use by him in marking goods of the same or like character will be protected) is that when it is affixed to goods of that character it amounts to a representation that they are the goods of the person who has adopted it as his trademark. If it does not amount to such a representation, it is not a technical trademark."[45]

§ 12. **Requisites of a valid trademark.**—As seen in our definition, a trademark must

(a) Be used in lawful commerce;

(b) Be in some way applied or affixed to a subject of lawful commerce;

(c) Be distinctive, identifying the character of the article to which it is so affixed.

As comprehensive and concise a statement of the requisites of a valid trademark as can be found in the books is as follows: "The trademark must be used to indicate not the quality, but the origin or ownership of the article to which it is attached. It may be any sign, mark, symbol, word or

41—The Merchandise Marks Acts, 1887-1894 (50 and 51 Vict., c. 28).

42—Manhattan Med. Co. v. Wood, Fed. Case No. 9026; 4 Cliff. 461.

43—Snodgrass v. Wells, 11 Mo. App. 590. Per *contra* as to the title of a periodical publication (not a technical trademark), see Estes v. Williams, 21 Fed. Rep. 189.

44—Taylor v. Bemis, 4 Biss. 406; Cox, Manual, 132; Fed. Case No. 13779.

45—Bissell Chilled Plow Works v. T. M. Bissell Plow Co., 121 Fed. Rep. 357, 364.

words, which others have not an equal right to employ for the same purpose."[46]

These are fundamental conditions which are never varied, and to which there can be no exception. There are further conditions which we will examine in detail in a subsequent chapter.

§ 13. Perpetual existence.—The life of a trademark is as long as its continuous use by the owner or his assignees. It is only terminated by abandonment, which we will deal with later.

"A trademark may increase in value to its owners by use, and the law could not put a time limit on the owner's right to it any more than it could put a limit upon his right to use any other article of property."[47]

The act of 1881 provided (§ 5) that a certificate of registry shall in the case of articles manufactured in this country remain in force for thirty years from its date, subject to renewal for a like period at any time during the six months prior to the expiration of the term of thirty years; so that all protection and benefit of that act will be lost by failure to renew within the period stated. But congress was careful to provide further (§ 11 act of 1881) that nothing in the act shall be construed as unfavorably affecting a claim to a trademark after the term of registration shall have expired.

By the act of 1905 (§ 12), the force of the certificate is limited to twenty years' duration with renewal privileges, and § 23 provides that nothing in the act "shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trademark might have had if the provisions of this act had not been passed."

§ 14. Territorial limitation.—Unlike a patent, a trademark knows no territorial limitation.

The right of a trademark can not be "limited to any place, city or state and therefore must be deemed to extend every-

46—Earl, Commissioner of Appeals, in Newman v. Alvord, 51 N. Y. 189, 193.

47—Hoyt v. Hoyt, 143 Pa. 623, 22 Atl. Rep. 755.

where."[48] The fact that a corporation owning a trademark fails to comply with the foreign corporation law of a state is no justification for infringement by another within such state,[49] and, more broadly stated, "the fact that complainant has not up to this time (*i. e.* of the suit) extended its trade to the locality occupied by the respondent," is no defense to a charge of trademark infringement.[50]

The courts of the United States, and those of the several states, are open to the owners of trademarks of whatever citizenship or nationality who may seek to protect their trademarks against piracy.[51] The act of congress of 1881 provided for the registration of trademarks owned by aliens located "in any foreign country, or tribe, which, by treaty, convention or law, affords similar privileges to citizens of the United States" (Act of 1881, sec. 1), and substantially the same provision is contained in the Act of 1905, sec. 1. The acquisition of a valid trademark in any place carries with it the right to use the mark everywhere.[52] This is subject to the exception that a foreigner doing business in his own country under the trademark has no common law right to that trademark in

48—Kidd v. Johnson, 100 U. S. 619; 25 L. Ed. 769; followed in Consolidated Ice Co. v. Hygeia Distilled Water Co., 80 C. C. A. 506; 151 Fed. Rep. 10, 12.

49—Consolidated Ice Co. v. Hygeia Distilled Water Co., 80 C. C. A. 506; 151 Fed. Rep. 10, 12.

50—Hygeia Distilled Water Co. v. Consolidated Ice Co., 144 Fed. Rep. 139, 142.

51—State v. Gibbs, 56 Mo. 133; Taylor v. Carpenter (1), 3 Story, 458; Cox, 14; Seb. 78; Coats v. Holbrook, 2 Sandf. 586; Cox, 20; Seb. 79, Taylor v. Carpenter (2), 2 Wood. & M. 1; Cox, 32; 9 L. T. 514; Seb. 83; Taylor v. Carpenter (3), 2 Sandf. 603; 11 Paige, 292; Cox, 45; Seb. 84; Lemoine v. Ganton, 2 E. D. Smith, 343; Cox, 142; Seb. 125; Derringer v. Plate, 29 Cal. 292; Cox, 324; Seb. 249; Collins Co. v. Brown, 3 K. & J. 423; 2 Jur. N. S. 929; 30 L. T. 62; Seb. 151; Collins Co. v. Cohen, 3 K. & J. 428; 3 Jur. N. S. 929; 29 L. T. 245; 30 L. T. 62; 5 W. R. 676; Seb. 152; Collins Co. v. Reeves, 28 L. J. Ch. 56; 4 Jur. N. S. 865; 33 L. T. 101; 6 W. R. 717; Seb. 164; Collins Co. v. Walker, 7 W. R. 22; Seb. 171; Atlas Assur. Co. v. Atlas Ins. Co., 138 Iowa, 228; 112 N. W. Rep. 232.

52—Except that an alien who abandons his trademark in this country is not revested with the right to use it, by the force of subsequent legislation in his own country. Saxlehner v. Eisner & Mendelson Co., 91 Fed. Rep. 536, 539; Saxlehner v. Eisner & Mendelson Co. (2), 179 U. S. 19, 36; 45 L. Ed. 60.

the United States, as against a domestic firm which has established business under a similar trademark, adopted in good faith, before the alien had sold any goods in this country.[53]

In a recent case, an assignment of a trademark limited to certain specified states has been sustained and an infringer enjoined as to those states. The doctrine of this section was not invoked, however, as far as the opinion discloses.[54] As to a corporate name, the injunction has been limited in its operation, to exclude a defendant from doing business in the state of New York.[55]

In a case involving the use of the word "Lilliputian" in a mail-order business, a Chicago defendant was enjoined at the instance of a New York complainant because of the occupancy by each through the mails of a common business territory.[56]

The right of property in a trademark is a unique right. The question of the extent of territory in which its owner will be afforded relief in equity against an infringer, must have its answer based upon the fundamental weaknesses attaching to trademarks as property. To understand how, in many cases, relief may be denied to the owner, requires that it be kept in mind, as Lord Parker, of Waddington, has recently said, in the House of Lords, that "even in the case of what are sometimes referred to as Common-Law Trademarks the property, if any, of the so-called owner is in its nature transitory, and only exists so long as the mark is distinctive of his goods in the eyes of the public or a class of the public."[57]

If this is true as to the duration of the life of the trademark right, it is equally true of the birth of that right. Possibly it will not do, in view of the public interest, to permit the mere local user of a trademark to enjoin its use by another who has adopted the same or substantially the same mark in good faith in another locality where consumers have

53—Richter v. Anchor Remedy Co., 52 Fed. Rep. 455; affirmed in Richter v. Reynolds, 59 Fed. Rep. 577; 8 C. C. A. 220.

54—Griggs, Cooper & Co. v. Erie Preserving Co., 131 Fed. Rep. 359.

55—Employers' Liability Assur. Corp., Ltd., v. Employers' Liability Ins. Co., 16 N. Y. Supp. 397, 400.

56—Ball v. Best, 135 Fed. Rep. 434.

57—A. G. Spalding & Bros. v. A. W. Gamage, Ltd., 32 R. P. C. 284.

no knowledge or means of knowledge of the prior use. But we are dangerously close to the border-land of doubt when we attempt to define precisely what the small, local user of a trademark does acquire by that limited and meager use, considered as a matter of pure legal right.[58] There are, as Judge Denison has put it, "two conflicting theories of trademark origin and right, * * * and we speak now only of marks which are so-called 'technical' trademarks. One theory is that the right arises from adoption, * * * from a kind of creation or discovery followed by appropriation. Whether the right is perfect at the instant of adoption, or whether there first must be sufficient use upon the goods to create for the mark a meaning among that part of the public which begins to purchase, is a detail which would not usually be important. According to this theory, if the right is once acquired by prior adoption, it is by its very nature exclusive of all later similar rights which might otherwise be acquired by similar adoption; and from that theory it would seem to follow that one who first adopts the mark and applies it to his goods in interstate commerce, and who extends his business into new localities, until, in regular course, his business may cover the country, may prevent the use of the mark by another later user, even though that other has adopted the mark in good faith, and in his particular field has given it identity with his goods. How much diligence on this theory the first user must employ in extending his business to get the full benefit of his initial right need not now be considered. The other theory is that no right is perfected until the mark has been used to such an extent that it has come to have a meaning to the particular purchasing public as to which a controversy arises, and that the duty of the courts of equity to enforce such rights depends essentially upon the duty of protecting this public against being misled. From this theory it will follow, or it may follow, that the later adopter, who has brought it about

58—That a trademark is not property as such until it has become associated with and forms part of the business in which it is employed, and that a naked license to use a trademark is, therefore, void, see Detroit Creamery Co. v. Velvet Brand Ice Cream Co. (Mich.), 153 N. W. Rep. 664.

in a given locality that the mark indicates to the public that the goods are of his manufacture, may thereby himself acquire a trademark right or its equivalent, affirmatively enforceable in that locality and among that public, even against the first proprietor."[59]

This latter theory has now received the sanction of the United States Supreme Court, which has declared that "where two parties independently are employing the same mark upon goods of the same class, but in separate markets wholly remote the one from the other, the question of prior appropriation is legally insignificant; unless, at least, it appear that the second adopter has selected the mark with some design inimical to the interests of the first user, such as to take the benefit of the reputation of his goods, to forestall the extension of his trade, or the like."[60]

The danger of the doctrine thus announced is manifest, its practical application will be interesting to observe. When a California dealer appropriates the mark of a New York dealer, who is to determine, and by what proof, whether the act was done "to forestall the extension" of the first user's trade? Under the rule so stated, the only safety for the adopter of a trademark in the United States is to immediately occupy every market in the country, an operation calling for an immense expenditure, and impossible to any but the vastly wealthy corporations which are the target for our anti-trust laws.

§ 15. The necessity of user.—There can, finally, be no right in or to a trademark apart from its use. "The mere sale of a trademark apart from the business in which it has been used confers no right of ownership, because no one can claim the right to sell his goods as goods manufactured by another. To permit this to be done would be a fraud upon the public."[61] To quote from a New York court, "There is no such thing as a trademark 'in gross,' to use that term by analogy. It

59—W. A. Gaines & Co. v. Rock Spring Distilling Co., 226 Fed. Rep. 538; 141 C. C. A. 287, 294.

60—Mr. Justice Pitney, in Hanover Star Milling Co. v. Metcalf, 240 U. S. 403; 60 L. Ed. —.

61—Witthaus v. Braun, 44 Md. 303; 22 Am. Rep. 44.

must be 'appendant' of some particular business in which it is actually used upon, or in regard to specified articles."[62] It follows, therefore, that the owner of a trademark can not sell territorial rights in a trademark to different persons, so as to enable them to make and sell goods as being made by him.[63] "It goes without saying that a trademark or tradename can only be acquired by adoption accompanied with actual use."[64] The inventor of a system of manufacturing garments, who has never engaged in their actual manufacture and sale, has no trademark right in a mark to be applied to such garments.[65]

§ 16. How trademark rights may be acquired.—A mere casual use, interrupted, or for a brief period, will not suffice to establish a trademark right in the mark;[66] there must be such a user, as to its length and publicity, as will show an

62—Weston v. Ketcham (2), 51 How. Pr. 455; Seb. 487; Pinto v. Badman, 8 R. P. C. 181; Cartmell, 270; Dixon Crucible Co. v. Guggenheim, 7 Phila. 408; 2 Brewst. 321; 3 Am. L. T. 288; Cox, 559; Seb. 331; Cotton v. Gillard, 44 L. J. Ch. 90; Seb. 447; McAndrew v. Bassett, 4 DeG. J. & S. 380; 33 L. J. Ch. 566; 10 Jur. N. S. 550; 10 L. T. N. S. 442; 12 W. R. 777; 4 N. R. 123; Seb. 234; Kidd ' v. Johnson, 100 U. S. 617; 25 L. Ed. 769; Weston v. Ketcham (1), 39 N. Y. 54; Leather Cloth Co. v. American Leather Cloth Co., 4 DeG. J. & S. 137; 11 H. L. C. 523; The Fair v. Jose Morales & Co., 82 Ill. App. 499.

63—Snodgrass v. Wells, 11 Mo. App. 590. But in another case the assignment by the English publisher of "Chatterbox" of the right to publish a "Chatterbox" in the United States was sustained. Estes v. Williams, 21 Fed. Rep. 189. The name, being that of a periodical publication, was not a technical trademark.

64—Kathreiner's Malz Kaffee Fab. v. Pastor Kneipp Med. Co., 27 C. C. A. 351; 82 Fed. Rep. 321, 325; per Jenkins, J.

65—Jaeger's Sanitary W. S. Co. v. Le Boutillier, 47 Hun, 521. Thus under the English statutes a registrant is not entitled to register a mark for goods in which he does not deal and in which he does not actually intend to deal. John Batt & Co. v. Dunnett, L. R. (1899) A. C. 428.

66—Menendez v. Holt, 128 U. S. 514; Levy v. Waitt (1), 56 Fed. Rep. 1016; Levy v. Waitt (2), 61 Fed. Rep. 1008; 10 C. C. A. 227; Brower v. Boulton (1), 53 Fed. Rep. 389; Brower v. Boulton (2), 7 C. C. A. 567; 58 Fed. Rep. 888; Macmahan Pharmacal Co. v. Denver Chemical Mfg. Co., 113 Fed. Rep. 468; 51 C. C. A. 302; Tetlow v. Tappan, 85 Fed. Rep. 774; Heublein v. Adams, 125 Fed. Rep. 782.

intention to adopt the mark as a trademark for a specific article.[67]

§ 17. Trademarks as subjects of sale, assignment or bequest.—In the early adjudications the assignability of trademarks was not clearly established.[68]

It can now be said, however, that trademarks are generally assignable during the life time of the owner of the mark, and capable of transmission at his death. Indeed, this rule is the necessary and indispensable correlative of the rule that trademarks have perpetual existence. But there is the necessary qualification that with the trademark must go the goodwill of the business, the right to select or manufacture the article to which the former owner has been in the habit of affixing the trademark in use.[69] Any other course would tend to mislead the public. It is provided by section 70 of the

67—Kohler Mfg. Co. v. Beeshore, 59 Fed. Rep. 572, 576; 8 C. C. A. 215; Richter v. Reynolds, 59 Fed. Rep. 577, 579; 8 C. C. A. 220.

68—See Corwin v. Daly, 7 Bos. 222; Cox, 265, where the court says, referring to a name used as a trademark: "The employer of it can neither give any special right to another, nor abandon it to the community so as forever to take away the right of employing it to designate his wares." In another case it has been held that one can so sell his name as to deprive himself of the right to use it for his own manufacture, and give the right to another." Probasco v. Bouyon, 1 Mo. App. 241. In a later case before the same court, however, the court said: "We think the answer to this question depends upon the effect which the use of the name, in each particular instance, is shown to have upon the minds of the public," and concluded that if the public would be led to believe the assignor was still manufacturing the goods, when they were the manufacture of another, the transaction would be a fraud upon the public and the use of the assigned name would not be protected. Skinner v. Oakes, 10 Mo. App. 45; Cox, Manual, 680. This dictum was quoted with approval in Oakes v. Tonsmierre, 4 Woods, 547; Price & Steuart, 817; 49 Fed. Rep. 447.

69—Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 217; Massam v. Cattle Food Co., L. R. 14 Ch. D. 748; *Ex parte* Lawrence, 44 L. T. N. S. 98; Seb. 630; *In re* Wellcome, L. R. 32 Ch. D. 213; Leather Cloth Co. v. American Leather Cloth Co., 4 DeG. J. & S. 137; 33 L. J. Ch. 199; Seb. 223; Goodman v. Meriden Brittania Co., 50 Conn. 139; Witthaus v. Braun, 44 Md. 303; 22 Am. Rep. 44; Seb. 492; Skinner v. Oakes, 10 Mo. App. 45; Taylor v. Bemis, 4 Biss 406, Fed. Case 13779; McVeagh v. Valencia Cigar Factory, 32 Off. Gaz. 1124; Price & Steuart, 970; Oakes v. Tonsmierre, 4 Woods, 547, 49 Fed. Rep. 447; Price & Steuart, 817; Baldwin v.

English Patents, Designs and Trademarks Act of 1883 that "A trademark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with the goodwill." No corresponding provision existed in the act of congress of 1881. The Act of 1905, sec. 10, provides "that every registered trademark . . . shall be assignable in connection with the goodwill of the business in which the mark is used."

Inasmuch as there can be no title in a trademark apart from the goodwill of the business in which it is used, it follows that, in an assignment of the business and goodwill of the owner of the mark, the title to the trademark, without being specially mentioned, passes to the assignee.[70] It is not so clear, however, that the purchaser acquires the right to use

Von Micheroux, 25 N. Y. Supp. 857; Morgan v. Rogers, 19 Fed. Rep. 596; 12 Off. Gaz. 1113; Smith v. Imus, 32 Alb. L. J. 455; Cotton v. Gillard, 44 L. J. Ch. 90; Smith v. Fair, 14 Ont. Rep. 729; Burton v. Stratton, 12 Fed. Rep. 696; Price & Steuart, 668; Pepper v. Labrot, 8 Fed. Rep. 29; Chadwick v. Covell, 151 Mass. 190; 23 N. E. Rep. 1068; Cox, Manual, 716; Cooper v. Hood, 26 Beav. 293; Churton v. Douglas, Johns. 174; Shipwright v. Clements, 19 W. R. 599; Sohier v. Johnson, 111 Mass. 238; Gregg v. Bassett, 3 Ont. L. Rep. 263; Dant v. Head, 90 Ky. 255; 13 S. W. Rep. 1073; J. G. Mattingly Co. v. Mattingly, 96 Ky. 430; 31 S. W. Rep. 985; Covert v. Bernat, 156 Mo. App. 687; 138 S. W. Rep. 103.

70—Shipwright v. Clements, 19 W. R. 599; Seb. 350; Congress & Empire Spring Co. v. High Rock Congress Spring Co., 57 Barb. 526; Cox, 599; 45 N. Y. 291; 10 Abb. Pr. N. S. 348; 6 Am. Rep. 82; 4 Am. L. T. 168; Cox, 624; Seb. 354; Witthaus v. Braun, 44 Md. 303; 22 Am. Rep. 44; Seb. 492; Morgan v. Rogers, 19 Fed. Rep. 596; 26 Off. Gaz. 1113; Cox, Manual, 692; Merry v. Hoopes, 111 N. Y. 420; Churton v. Douglas, Johns. 174; Fulton v. Sellers, 4 Brewst. 42; Thompson v. Mackinnon, 2 Steph. Dig. 726; Lippincott v. Hubbard, 28 Pitts. L. J. 303; Burkhardt v. Burkhardt Co., 4 Ohio N. P. 358; Listman Mill Co. v. Wm. Listman Mill Co., 88 Wis. 334; Prince Mfg. Co. v. Prince's Metallic Paint Co., 39 N. Y. S. R. 488; Menendez v. Holt, 128 U. S. 514; 32 L. Ed. 526; Hegeman v. Hegeman, 8 Daly, 1; Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624; 35 C. C. A. 496; Allegretti v. Allegretti Chocolate Cream Co., 177 Ill. 129; 53 N. E. Rep. 487; affirming s. c. 76 Ill. App. 581; Snyder Mfg. Co. v. Snyder, 54 Ohio St. 86; 43 N. E. Rep. 325; Whitcomb v. Converse, 119 Mass. 38; 20 Am. Rep. 311. Above text cited and approved. President Suspender Co. v. Macwilliam, 233 Fed. Rep. 433, 437.

the name of the vendor, this right being affirmed in some cases[71] and negatived in others.[72] It would seem to be the law that a territorial right to use a trademark can not be assigned [73] though in the case of the name of a periodical publication the contrary rule has been announced.[74]

The fact of a trademark containing the name or initials of a former owner of a business will not disentitle an assignee of the business from its use, because the proper name is treated as indicative of the business rather than the present owner of the business.[75] But the courts of the United States are inclined to insist that the public be notified of the change of ownership, and this is now the safer rule,[76] particularly

71—Banks v. Gibson, 34 Beav. 566; Levy v. Walker, L. R. 10 Ch. D. 463; Webster v. Webster, 3 Swanst. 490; Clark v. Leach, 32 Beav. 14; Bond v. Milbourn, 20 W. R. 197; Tussaud v. Tussaud, 38 W. R. 440; Phelan v. Collender, 13 N. Y. Sup. Ct. 244; Hoff v. Tarrant & Co., 71 Fed. Rep. 163; affirmed in Tarrant & Co. v. Hoff, 76 Fed. Rep. 959; 22 C. C. A. 644; J. G. Mattingly Co. v. Mattingly, 96 Ky. 430.

72—Scott v. Rowland, 20 W. R. 208; Lewis v. Langdon, 7 Sim. 421; Turner v. Major, 3 Giff. 442; Dence v. Mason, 41 L. T. N. S. 573; Dickson v. McMaster, 18 Ir. Jur. 202; Reeves v. Denicke, 12 Abb. Pr. N. S. 92; Howe v. Searing, 10 Abb. Pr. 264; Cox, 244; Petersen v. Humphrey, 4 Abb. Pr. 394; Cox, 212; Thynne v. Shove, 89 L. T. Jour. 84; Mayer v. Flanagan, 12 Tex. Civ. App. 405; Sherwood v. Andrews, 5 Am. L. Reg. N. S. 588; Seb. 263.

73—Snodgrass v. Wells, 11 Mo. App. 590.

74—Estes v. Williams, 21 Fed. Rep. 189.

75—Pepper v. Labrot, 8 Fed. Rep. 29; LePage Co. v. Russia Cement Co., 2 C. C. A. 555; 51 Fed. Rep. 941; Jennings v. Johnson, 37 Fed. Rep. 364; Frazer v. Frazer Lubricator Co., 121 Ill. 147; 13 N. E. Rep. 639; McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 832; Symonds v. Jones, 82 Me. 302; 8 L. R. A. 570; Filkins v. Blackman, 13 Blatchf. 440; Fed. Case No. 4786; Weed v. Peterson, 12 Abb. Pr. N. S. 178; Young v. Jones, 3 Hughes, 274; Fed. Case No. 18,159; Fulton v. Sellers, 4 Brewst. 42; Weston v. Ketcham (1), 39 N. Y. 54; Clark v. Ins. Co., 7 Mo. App. 71; Frank v. Sleeper, 150 Mass. 583; 23 N. E. Rep. 213; Hoxie v. Chaney, 143 Mass. 592; Russia Cement Co. v. LePage, 147 Mass. 206; 17 N. E. Rep. 304; Brown Chemical Co. v. Meyer, 139 U. S. 540; 35 L. Ed. 247; Bulte v. Ingleheart Bros., 70 C. C. A. 76; 137 Fed. Rep. 492, 499. The fact that a trademark includes the name and portrait of the first owner does not render it unassignable to another. Richmond Nervine Co. v. Richmond, 159 U. S. 293, 302; 40 L. Ed. 155.

76—Manhattan Med. Co. v. Wood, 108 U. S. 218; 27 L. Ed. 706; Horton Mfg. Co. v. Horton Mfg. Co., 18

where the trademark is a mark of special qualities, due to superior material, processes, care and skill exercised by the originator thereof, or the mark bearing his name "would, or at least might, imply that his personal work or supervision was employed in the manufacture; and in such cases it would be a fraud upon the public if the trademark should be used by other persons, and for this reason such a trademark would be held to be unassignable. * * * But, on the other hand, the usages of trade may be such that no such inference would naturally be drawn from the use of a trademark which contains a person's name, and that all that purchasers would reasonably understand is that goods bearing the trademark are of a certain standard, kind or quality, or are made in a certain manner, or after a certain formula, by persons who are carrying on the same business that formerly was carried on by the person whose name is on the trademark."[77] In the sale of a business, then, the general rule is that the trademarks connected with the business will pass to the purchaser without being specified in the bill of sale,[78] and in case of a general assignment or bankruptcy the trademarks also pass, to inure to the benefit of the creditors[79] The exception to each of

Fed. Rep. 816; Alaska Packers' Ass'n v. Alaska Imp. Co., 60 Fed. Rep. 103; Siegert v. Abbott (1), 61 Md. 276; Sherwood v. Andrews, 5 Am. L. Reg. N. S. 588; Seb. 263; Carmichael v. Latimer, 11 R. I. 395; Seb. 521; Pillsbury v. Pillsbury-Washburn Flour Mills Co., 64 Fed. Rep. 841; 12 C. C. A. 432; People v. Molins, 10 N. Y. Supp. 130; Lemke v. Dietz, 121 Wis. 102; 98 N. W. Rep. 936.

77—Charles Allen, J., in Hoxie v. Chaney, 143 Mass. 592, 10 N. E. Rep. 713.

78—Shipwright v. Clements, 19 W. R. 599; Wilmer v. Thomas, 74 Md. 485; 13 L. R. A. 380; Solis Cigar Co. v. Pozo, 16 Colo. 388; 25 Am. St. Rep. 279; Laughman's Appeal, 128 Pa. 1; 18 Atl. Rep. 415; 5 L. R. A. 599; Morgan v. Rogers, 19 Fed. Rep. 596. Trademarks "pass under a sale of the 'assets and goodwill' of the business, whether specially mentioned or not." Holland, J., in Kronthal Waters v. Becker, 137 Fed. Rep. 649, 652. A conveyance of "all of the business and assets" transfers the trademark of that business without special mention. R. J. Reynolds Tobacco Co. v. Allen Bros. Tobacco Co., 151 Fed. Rep. 819, 823. In a conveyance, the expression "trade rights" will suffice to convey tradenames used in the business. Hering-Hall Marvin Safe Co. v. Hall's Safe Co., 208 U. S. 554, 560; 52 L. Ed. 616, 620.

79—Hegeman v. Hegeman, 8 Daly, 1; Rogers v. Taintor, 97 Mass. 291; Warren v. Warren Thread Co., 134 Mass. 247; Hudson v. Osborne,

these rules arises where the trademark depends upon the secret processes or individual skill of its owner for its value.[80]

Trademarks may, in connection with the goodwill of the business wherewith they are connected, be transmitted by bequest.[81] This naturally leads to the result that several persons may by bequest (as they may upon dissolution of a co-partnership) become possessed of the right to use the same trademark. As where a decedent, a watchmaker using "Dent, London" as a mark on watches which he manufactured at three several shops in London, bequeathed the business of two of these shops to one person and the third shop to another. It appears to have been held here that each legatee had a several right to the use of the trademark.[82] The rights of the partners in the use of the firm trademarks upon dissolution have been thus defined by Judge Hughes: "Rights in trademark are analogous to rights in the good will of a partnership. In the absence of express stipulation at the time of dissolution, each partner may go on and use the trademark of the firm."[83] It is clear, however, that where a mark is a common design for the pur-

39 L. J. Ch. 79; Cotton v. Gillard, 44 L. J. Ch. 90; *Ex parte* Foss, 2 DeG. & J. 230; Bury v. Bedford, 4 DeG. J. & S. 352; *Ex parte* Young, Seb. 537; Longman v. Tripp, 2 Bos. & P. N. R. 67; Hammond v. Brunker, 9 R. P. C. 301; Cartmell, 142; Lippincott v. Hubbard, 28 Pitts. L. J. 303; Burkhardt v. Burkhardt Co., 4 Ohio N. P. 358; Batchellor v. Thomson, 86 Fed. Rep. 630; Sarrazin v. W. R. Irby Cigar Co., 35 C. C. A. 496; 93 Fed. Rep. 624, 626. The Bankruptcy Act of 1898, § 70a, provides that the trustee in bankruptcy shall be vested by operation of law with the title of the bankrupt, as of the date he was adjudged a bankrupt, to all "interests in patents, patent rights, copyrights, and trademarks."

80—*Re* Swezey, 62 How. Pr. 215.

81—McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 832; Huwer v. Dannenhoffer, 82 N. Y. 499, 502.

82—Dent v. Turpin, 2 J. & H. 139; 30 L. J. Ch. 495; 7 Jur. N. S. 673; 4 L. T. N. S. 637; 9 W. R. 548. Mr. Cox observes, "This case is to be taken as of an exceptional character; it is not in accord with settled principles." Cox, Manual, 196.

83—Young v. Jones, Fed. Case No. 18,159 3 Hughes, 274; Price & Steuart, 150. And to the same effect, see Caswell v. Hazard, 121 N. Y. 484; 24 N. E. Rep. 707; Hazard v. Caswell, 93 N. Y. 259, 262; Huwer v. Dannenhoffer, 82 N. Y. 499, 502; Banks v. Gibson, 34 Beav. 566; 34 L. J. Ch. 591; 6 N. R. 373; 13 W. R. 1012; 11 Jur. N. S. 680; Seb. 248; Condy v. Mitchell, 37 L. T. N. S. 268; 37 L. T. N. S. 766; 26 W. R. 269; Seb. 561; Taylor v. Bothin, Fed. Case No. 13,780, 15 Off. Gaz. 968; Price & Steuart, 5 Sawy. 584; Wright v. Simpson, 165. In this connection Mr. Justice

pose of a common adventure used by several independent dealers or manufacturers in a joint enterprise, a mark belonging to neither individually, but representing the enterprise of all concerned, for the purposes of their joint adventure, the trademark can be used only so long as all the parties remain interested in the enterprise; when it terminates the function and life of the trademark also terminate.[84] If the business and goodwill of a partnership are sold upon dissolution the trademark goes with the other assets.[85] Another question is presented where one partner retires from the firm. If the retiring partner re-engages in business and continues to use the trademark, it has been held that that fact, even if the mark is applied by him to a spurious article, is evidence of his intention to retain his interest in the trademark.[86] If upon dissolution one partner takes the whole business by agreement, the valuation of the retiring partner's interest must include his interest in the trademarks of the partnership, which pass with the goodwill.[87]

Bradley said: "In holding that it is necessary to the validity of a trademark that the claimant of it must be entitled to an exclusive right to it, or property in it, we do not mean to say that it may not belong to more than one person, to be enjoyed jointly or severally. Copartners, upon a dissolution of partnership, may stipulate that each of them may use the trademarks of the firm, and there may be many other cases of joint and several ownership; but such coowners will together be entitled to the exclusive use of the trademark, and perhaps each of them will be entitled to such exclusive use as to all other persons except their associates in ownership." New York Cement Co. v. Coplay Cement Co., 45 Fed. Rep. 212; to the same effect, Lepon v. Kottler, 100 N. Y. Supp. 779.

84—*Re* Jones, 53 L. T. 1, Cartmell, 189; Robinson v. Finlay, and Ward v. Robinson, L. R. 9 Ch. D. 487; 39 L. T. 398; 27 W. R. 294; Cartmell, 295. These cases arose between merchants in Manchester and corresponding houses in Manilla and Rangoon. The trademarks were composite marks, containing crests, names of the individuals written in Chinese characters, coats of arms, and other personal *indicia* of the parties interested.

85—Armistead v. Blackwell, 1 Off. Gaz. 603; Seb. 399; Rogers v. Taintor, 97 Mass. 291; Seb. 283; Bradbury v. Dickens, 27 Beav. 53; 28 L. J. Ch. 667; 33 L. T. 54; Seb. 173; Banks v. Gibson, 34 Beav. 566; 11 Jur. N. S. 680; 34 L. J. Ch. 591; 13 W. R. 1012; 6 N. R. 273.

86—Wright v. Simpson, 15 Off. Gaz. 968; Price & Stewart, 165.

87—Banks v. Gibson, 34 Beav. 566; 11 Jur. N. S. 680; 34 L. J. Ch. 591; 12 W. R. 1012; 6 N. R. 373; Seb. 248; Gage v. Canada Pub.

Trademarks upon the death of their owner pass with his other personalty to his personal representatives.[88] There should, of course, be a conveyance of the decedent's title by administration; and where, as in *Hovenden v. Lloyd*, there is no administration, and a relative simply continues business and uses the trademark, he probably acquires no title to the trademark thereby. At all events, in that case, where the deceased's son so used the trademark and subsequently sold his business with its goodwill to a third party, it was held that the son had acquired no title capable of being transferred to such third party.[89] The Supreme Court of Pennsylvania, however, has distinctly held that where a man's sons continued to use his trademark after his death (there having been no evidence of administration upon his estate) and subsequently separated, each continuing in business and using the trademark, they were entitled to an injunction against a stranger imitating that trademark, upon a bill in equity in which they joined as complainants. The subject is not as fully discussed by the court as it should have been. The language of Lord Cranworth in *Leather Cloth Co. v. American Leather Cloth Co.*[90] is quoted in the opinion, as follows: "Difficulties, however, may arise where the trademark consists merely of the name of the manufacturer. When he dies, those who succeed him (grandchildren or married daughters, for instance), though they may not bear the same name, yet ordinarily continue to use the original name as a trademark, and they would be protected against any infringement of the exclusive right to that name. They would be so protected, because according to the usage of trade they would be understood as meaning no more by the use of their grandfather's or father's name than that they were carrying on the manufacture formerly carried on by him." In the course of its opinion the Pennsylvania court observes: "It was urged, how-

Co., 11 Can. S. C. R. 306; 6 Ont. Rep. 68; 11 Ont. App. 402.

88—Croft v. Day, 7 Beav. 84; *Re* Farina, 44 L. T. N. S. 99; Giblett v. Read, 9 Mod. 459.

89—Hovenden v. Lloyd, 18 W. R. 1132; Seb. 337. There was substantially the same state of facts and the same holding in Singleton v. Bolton, 3 Doug. 293; Cox, 634; Seb. 4.

90—11 H. L. C. 523.

ever, that conceding this symbol to have been a valid trademark in the hands of Jesse Darlington (grandfather of complainants), or even of Jared (his son), that upon the death of the latter it ceased to be the property of any one, and that its use by several members of the family of the latter destroyed its distinctive features and left it open to the public to appropriate it. We can not assent to this proposition."[91] It might be suggested that in cases of this character (*i. e.*, where no administration is had upon the estate of a deceased owner of a trademark) its use by relatives in a similar business is practically an adoption *de novo* of the mark, left open to the world for appropriation by its owner's death.

Where the owner of a trademark takes partners into the business in which it is employed, the title to the trademark ordinarily is merged into the partnership assets.[92] The Supreme Court of the United States has apparently held to the contrary,[93] but the facts were that the owner of the mark owned the premises in which the business was conducted, and took two of his clerks into partnership. He did not convey the realty to the firm, and upon dissolution there was correspondence between him and the withdrawing partners which, in the language of Mr. Justice Field, "discloses beyond question their knowledge of the transfer and recognition of his power to make it;" referring to his subsequent sale of his business and his trademark to another. It would

91—Paxon, J., in Pratt's Appeal, 117 Pa. St. 401, 412. "The reason why a trademark may pass 'without administration,' as suggested by Paxon, J., in Pratt's Appeal, 117 Pa. St. 401, seems to be that a trademark can have no value except in connection with the business to which it attaches; and as creditors are not usually in condition to realize the value of the trademark, either by carrying on the business themselves or by selling to one who will, its chief element as an asset is wanting. But it seems, also, that cases may arise in which the trademark of a deceased testator or intestate is of value to creditors, or a subject of contention among heirs, when administration may become necessary." Woerner, Administration, 635, note 8.

92—Weston v. Ketcham (2), 51 How. Pr. 455; Filkins v. Blackman, 13 Blatchf. 440, 446; Fed. Case No. 4,786; Sohier v. Johnson, 111 Mass. 238, 242; Bury v. Bedford, 4 DeG. J. & S. 352-371; Condy v. Mitchell, 37 L. T. N. S. 268; Moore v. Rawson, 185 Mass. 264; 70 N. E. Rep. 64.

93—Kidd v. Johnson, 100 U. S. 617, 619; 25 L. Ed. 769

seem from this decision, then, that the partner who originally owns the mark may by agreement permit the use of the trademark by the firm during its existence, reserving the title to the trademark to himself in the event of dissolution.

In a recent case it has been held that "When a trademark or tradename is owned by one who enters into a partnership with another for the manufacture of the article designated, the title of the trademark does not pass to the partnership except by express agreement."[94] A like ruling has been made as to the trademark of one of the incorporators of a corporation.[95] In each case the title of the mark is a question of fact, and title to personalty usually follows possession. Use by a partnership is *prima facie* evidence of ownership by the partnership.

The federal supreme court has held that when a partner retires from a firm, assenting to or acquiescing in the retention by the other partners of the old place of business and the future conduct of the business by them under the old name, the goodwill (including the title to the firm's trademarks) remains with the latter as a matter of course.[96]

It is important to note, in considering the assignability of trademarks, the doctrine first announced by Judge Shipman, that "The right to use a trademark can not be so enjoyed by an assignee that he shall have the right to affix the mark to goods differing in character or species from the article to which it was originally attached."[97] And where the trademark involved the use of the assignor's name, it was said: "Where an individual parts with a right to the use of his own name in any given connection, the courts should not extend the contract by which he does so beyond its necessary scope. It certainly will not be held that a man has tied himself up so as to prevent the use of his own name any further than the clear terms of the agreement show his intention to do so."[98]

94—Kirkpatrick, J., in Greacen v. Bell, 115 Fed. Rep. 553, 554.

95—Cutter v. Gudebrod Bros. Co. (2), 61 N. Y. Supp. 225.

96—Menendez v. Holt, 128 U. S. 514, 522; 32 L. Ed. 526.

97—Filkins v. Blackman, 13 Blatchf. 440, 444; Fed. Case No. 4,786. This rule is again laid down in Chattanooga Medicine Co. v. Thedford (1), 49 Fed. Rep. 949, 952; Chattanooga Medicine Co. v. Thedford (2), 58 Fed. Rep. 347.

98—Newman, J., in Chattanooga Medicine Co. v. Thedford (2), 58 Fed. Rep. 347, 349; reversed upon

One who has assigned either his trademark[99] or tradename[1] will be enjoined from again using the mark or name himself; if he makes such an assignment to a corporation with a reversion to him if the corporation ceases to exist, he can not make a valid assignment of the mark to another during the life of the corporation.[2]

The assignee of a trademark does not, merely by virtue of the assignment, obtain a right to enjoin infringers of the mark. He must show that he has actually applied it, commercially, to goods of the class for which it is claimed as a trademark.[3]

While, as we have seen, a trademark is assignable only in connection with the goodwill of the business in which it is used, it does not follow that both must be conveyed by the same instrument or at the same time; and under the English Patents, Trademarks and Copyright Act of 1883 it has been held that the registration of an assignment of a trademark need not be contemporaneous with the assignment of the goodwill.[4] It is possible that the originator of a manufacturing business and the person who purchases that business may each thereafter have a right to the limited use of the tradename and trademark used in connection with that business.[5] Where such a state of facts arises, either the vendor or purchaser can assign his right to the use of the tradename and trademark, and either will be enjoined upon the application of the other from using the words "only genuine" in connection with the name or mark.[6]

the ground of unfair competition by defendants, in Chattanooga Medicine Co. v. Thedford, 14 C. C. A. 101; 66 Fed. Rep. 544.

99—Bury v. Bedford, 4 DeG. J & S. 352; Burkhardt v. Burkhardt Co., 4 Ohio N. P. 358.

1—Churton v. Douglas, Johnson (Eng.), 174.

2—Petrolia Mfg. Co. v. Bell & Bogart Soap Co., 97 Fed. Rep. 781, 784.

3—Walton v. Crowley, Fed. Case No. 17,133; 3 Blatchf. 440, 448; Filkins v. Blackman, 13 Blatchf. 440, 445; Fed. Case No. 4,786.

4—*In re* Wellcome, L. R. 32 Ch. D. 213; 3 R. P. C. 76; 55 L. J. Ch. 542; 54 L. T. 493; 34 W. R. 453; Cartmell, 342.

5—Fish Bros. Wagon Co. v. La Belle Wagon Works, 82 Wis. 546; Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co., 87 Fed. Rep. 201; affirmed, 95 Fed. Rep. 457; 37 C. C. A. 146.

6—Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co., 87 Fed. Rep. 203.

In a case where a trademark was used by a manufacturer in England and also by a firm in the United States in which he was a partner, the use of the trademark having begun in both places about the same time, and it having become a distinctive mark, identifying the article manufactured in the United States, the English manufacturer retired from the American house. Upon his subsequently attempting to use it in a separate business of the same kind in this country, it was held that his successors in the old firm had, upon his retirement, succeeded to the exclusive right to use the trademark, as part of the business, and he was enjoined from using the mark in his new establishment in the United States.[7] This case is but a practical application of the doctrines we have just considered, to an unusual state of facts.

Whenever the alien owner of a trademark has abandoned its use in the United States by neglecting to assert his rights as against infringers in this country, the public has a right to use that mark, of which it will not be divested by the operation of a law subsequently enacted by the country of which the former owner is a citizen.[8] A trademark applied to mineral paint produced from a deposit on a particular piece of land will pass to a purchaser of the land as an incident to the realty,[9] as will a trademark applied to the water of a particular spring[10] or the right to use words designating a particular building rather than the business conducted therein,[11] or the right to use a mark which has come to designate the product of a mill or factory rather than of the proprietor.[12]

In a case where the plaintiff had assigned the right to use his trademark to the defendant for a term of years, for a share of the profits of defendant's business, and during the term reengaged in the use of the mark, in an action by the plaintiff upon the contract it was held that the plaintiff could recover

7—Batchelor v. Thompson, 86 Fed. Rep. 630.

8—Saxlehner v. Eisner & Mendelson Co. (2), 91 Fed. Rep. 536; Saxlehner v. Eisner & Mendelson Co. (3), 179 U. S. 19, 36; 45 L. Ed. 60.

9—Prince Mfg. Co. v. Prince's Metallic Paint Co., 15 N. Y. Supp. 249; Cox, Manual, 721.

10—Hill v. Lockwood, 32 Fed. Rep. 389.

11—Armstrong v. Kleinhaus, 82 Ky. 303.

12—Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 217.

the profits due him under the contract, and the defendant was allowed damages for the breach of the contract. The validity of the assignment appears not to have been questioned.[13]

There is an exception to the general rule that a trademark can not be assigned save in connection with a business; where the mark is associated with the product of a secret process, the mark necessarily goes with an assignment of the process.[14] Thus the Court of Appeals of New York, speaking through O'Brien, J., has said, "There are doubtless some trademarks that consist of words that identify an article produced by some secret process and without the use of which the article could not be described. In other words the name used may be inherent in the article itself and is not used as in this case to distinguish one cigar from another. The celebrated cordial, which is in use the world over, known as 'Chartreuse' is a sample of a trademark, the bare assignment of which might confer upon the assignee the right to manufacture and sell that article."[15]

The doctrine of a later case is that where trademarked goods are made under a formula, and their manufacture abandoned, one who lawfully acquires knowledge of the formula may apply the trademark to its product, as against one who, in the interim, has applied the trademark to a spurious article not made by the formula.[16] The decision so holding was subsequently reversed upon the facts;[17] but the legal rule is believed to be sound.

§ 18. **Assignability of distillery brands and the like.**—Trademarks used at a particular producing establishment upon the articles produced at the establishment may be lawfully assigned and transferred with the establishment. Of such a mark it has been said that "its subsequent use by the person to whom the establishment is transferred is considered as only indicat-

13—Coe v. Bradley, 9 Off. Gaz. 541; Fed. Case No. 2,941.

14—Tuttle v. Blow, 176 Mo. 158, 173; Falk v. American West Indies Trading Co., 180 N. Y. 445; Baldwin v. Von Micheroux, 25 N. Y. Supp. 857, 859.

15—Falk v. American West Indies Trading Co., 180 N. Y. 445.

16—W. A. Gaines & Co. v. Kahn, 155 Fed. Rep. 639.

17—Kahn v. W. A. Gaines & Co., 161 Fed. Rep. 495; 88 C. C. A. 437; *cf.* W. A. Gaines & Co. v. Rock Spring Dist. Co., 141 C. C. A. 287; 226 Fed. Rep. 531.

ing that the goods to which it is affixed are manufactured at the same place and are of the same character as those to which the mark was attached by its original designer."[18] This rule has been applied to brands consisting in whole or in part of proper names. Thus, in the leading case, the brand was "S. N. Pike's Magnolia Whiskey,"[19] and in another case the brands were "J. G. Mattingly & Sons, Standard Bourbon" and "J. G. Mattingly & Sons, Pure Rye."[20]

§ 19. Unfair competition.—In 1877, the American writer, Mr. Charles E. Coddington, in his excellent digest of trade-mark cases, remarked that "The interference of courts of equity, instead of being founded upon the theory of protection to the owner of trademarks, is now supported mainly to prevent frauds upon the public.[21] If the use of any words, numerals or symbols is adopted for the purpose of defrauding the public, the courts will interfere to protect the public from such fraudulent intent, even though the person asking the intervention of the court may not have the exclusive right to the use of these words, numerals or symbols."[22] He added that this rule was fully supported by four cases, two English and two American, which he cited.[23] Since that time, the recognition of the doctrine so expressed has grown steadily and certainly, so that it now demands treatment as a specific branch

18—Mr. Justice Field in Kidd v. Johnson, 100 U. S. 617; 25 L. Ed. 769.

19—Kidd v. Johnson, 100 U. S. 617; 25 L. Ed. 769.

20—J. G. Mattingly Co. v. Mattingly, 17 Ky. L. Rep. 1; 27 S. W. Rep. 985; J. G. Mattingly Co. v. Mattingly, 96 Ky. 430; 31 S. W. Rep. 279.

21—The writer erred in ascribing this as the only reason. The prevention of fraud upon the person whose goods are pirated is equally important and cogent. Humphrey's Specific Med. Co. v. Wenz, 14 Fed. Rep. 250; Skinner v. Oakes, 10 Mo. App. 45.

22—Coddington, Digest, § 36.

23—1869. Lee v. Haley, 21 L. T. N. S. 546; 18 W. R. 181; L. R. 5 Ch. 155; 39 L. J. Ch. 284; 22 L. T. N. S. 251; 18 W. R. 242; Seb. 325.

1872. Wotherspoon v. Curie, 22 L. T. N. S. 260; 18 W. R. 562; 42 L. J. Ch. 130; 23 L. T. N. S. 443; 18 W. R. 942; L. R. 5 H. L. 508; 42 L. J. Ch. 130; 27 L. T. N. S. 393; Seb. 329.

1872. Newman v. Alvord, 49 Barb. 588; 35 How. Pr. 108; Cox, 404; 51 N. Y. 189; 10 Am. Rep. 588; Seb. 282.

1877. Kinney v. Basch, Seb. 542.

of the law, separate, apart from, but including the narrower and strictly technical law of trademarks.[24] "The tendency of the courts at the present time seems to be to restrict the scope of the law applicable to technical trademarks, and to extend its scope in cases of unfair competition."[25]

§ 20. **Historical.**—In 1742, in *Blanchard v. Hill*, a decision of no authority and of no particular use except to illustrate the slow growth of the law of trademarks, Lord Hardwicke observed, referring to *Southern v. How*,[26] "It was not the single act of making use of the mark that was sufficient to maintain the action, but doing it with a fraudulent design, to put off bad cloths by this means, or to draw away business from the other clothier."[27] The chancellor so crudely expressed (but disapprovingly) the first reported judicial reference to the law of unfair competition. In 1896, Lord Chancellor Halsbury, addressing the House of Lords, said "For myself, I believe the principle of the law may be very plainly stated, and that is, that nobody has any right to represent his goods as the goods of somebody else."[28] This sentence is a terse statement of the fundamental maxim of unfair competition. The English courts have long recognized the rule, and it may be found repeated in various phraseology by all the English courts within whose jurisdiction trademark and analogous cases have come.

It is more difficult to trace the growth of this doctrine in the American decisions. Chancellor Sandford in 1825, in an action concerning the right to the name of a periodical, observed, "The injury for which redress is given * * * results from the imposture practiced upon the customers of an existing establishment, or upon the public,"[29] so recognizing the rule which Mr. Coddington failed to recognize.

24—"The law of unfair competition is well settled. It is only the application of that law to individual cases which requires discussion." Lacombe, J., in Walter Baker & Co. v. Sanders, 80 Fed. Rep. 889, 891; 26 C. C. A. 220.

25—Baker, J., in Church & Dwight Co. v. Russ, 99 Fed. Rep. 276-278.

26—Southern v. How, Popham, 144; Cro. Jac. 471; 2 Rolle, 28; Sch. 1.

27—Blanchard v. Hill, 2 Atk. 484; Sch. 2.

28—Reddaway v. Banham, L. R. (1896) Appeal Cases, 199-204.

29—Snowden v. Noah, Hopkins' Ch. R. 347; Cox, 1; Sch. 41.

Twelve years later, in Massachusetts, it was said that "Imposition, falsehood and fraud, on the part of the defendant, in passing off his own medicines as those of the plaintiff, would be a ground of action." [30]

In 1840 Chancellor Walworth was presented with an application for an injunction to restrain the use of the words "New Era" as the name of a newspaper, the complainant being the proprietor of a rival periodical denominated "Democratic Republican New Era." He denied the application, and in the course of his opinion said: "The allegation in the complainant's bill of complaint is that the defendant has assumed the name of the complainant's newspaper for the fraudulent purpose of imposing upon the public, and supplanting him in the goodwill of his established paper, by simulating the name and dress thereof; with the intent to cause it to be understood, and believed by the community, that the defendant's newspaper was the same as the complainant's, and thereby to injure the circulation of the latter. If this were in fact so, I should have no difficulty in making this order absolute. For although the business of publishing newspapers ought, in a free country, to be always open to the most unlimited competition, fraud and deception certainly are not essential to the most perfect freedom of the press. * * * As the names of party newspapers, in these days, have no necessary connection with the principles which they advocate, and are manufactured as readily as the new names if not the new principles of political parties, there could be very little excuse for the editor of a newspaper who should adopt the precise name and dress of an old established paper, which would be likely to interfere with the goodwill of the latter by actually deceiving its patrons." [31]

Not until 1888 did the United States supreme court give distinct recognition to the law of unfair competition,[32] and

30—Thomson v. Winchester, 19 Pick. 214; Seb. 59.

31—Bell v. Locke, 8 Paige, 75; Cox, 11; Seb. 65.

32—Goodyear India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 128 U. S. 598; 32 L. Ed. 535; Cox, Manual, 705. In this case Mr. Justice Field said (128 U. S. at p. 604), "The case at bar can not be sustained as one to restrain unfair trade. Relief in such cases is granted only where the defendant,

three years later Mr. Chief Justice Fuller announced the doctrine clearly and unequivocally, in these terms: "The jurisdiction to restrain the use of a trademark rests upon the grounds of the plaintiff's property in it, and of the defendant's unlawful use thereof. If the absolute right belonged to plaintiff, then, if an infringement were clearly shown, the fraudulent intent would be inferred, and, if allowed to be rebutted in exemption of damages, the further violation of the right of property would nevertheless be restrained. It seems, however, to be contended that plaintiff was entitled at least to an injunction, upon the principles applicable to cases analogous to trademarks; that is to say, on the ground of fraud on the public and on the plaintiff, perpetrated by defendant by intentionally and fraudulently selling its goods as those of the plaintiff. Undoubtedly an unfair and fraudulent competition against the business of the plaintiff—conduct with the intent, on the part of the defendant, to avail itself of the reputation of the plaintiff to palm off its goods as plaintiff's—would, in a proper case, constitute ground for relief."[33]

With this decision the doctrine of unfair competition may be regarded as being finally established in the United States; and as based not only on fraud on the public, but on the plaintiff.[34]

by his mark, signs, labels, or in other ways, represents to the public that the goods sold by him are those manufactured or produced by the plaintiff, thus palming off his goods for those of a different manufacturer, to the injury of the plaintiff." Citing McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828; Sawyer v. Horn, 1 Fed. Rep. 24; 4 Hughes, 239; Perry v. Truefit, 6 Beavan,, 66; Croft v. Day, 7 Beavan, 84.

Indeed, McLean v. Fleming may be properly regarded as the first case in which the federal supreme court made any mention of the doctrine. This sentence occurs in the opinion: "Nor is it necessary, in order to give a right to an injunction, that a specific trademark should be infringed; but it is sufficient that there was an attempt on the part of the respondent to palm off his goods as the goods of the complainant." McLean v. Fleming, 96 U. S. 245; 24 L. ed. 828.

33—Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537; 34 L. Ed. 997; Cox, Manual, 720.

34—"The law relating to this subject is well understood. No man has a right to use names, symbols, signs or marks which are intended, or calculated, to represent that his business is that of another. No man should in this way be permitted to appropriate

the fruits of another's industry, or impose his goods upon the public by inducing it to believe that they are the goods of some one else. If A presents his goods in such a way that a customer who is acquainted with the goods of B and intends to purchase them is induced to take the goods of A instead, believing them to be the goods of B, A is guilty of a fraud which deceives the public and injures his competitor. Where the goods of a manufacturer have become popular not only because of their intrinsic worth, but also by reason of the ingenious, attractive and persistent manner in which they have been advertised, the goodwill thus created is entitled to protection. The money invested in advertising is as much a part of the business as if invested in buildings, or machinery, and a rival in business has no more right to use the one than the other—no more right to use the machinery by which the goods are placed on the market than the machinery which originally created them. No one should be permitted to step in at the eleventh hour and appropriate advantages resulting from years of toil on the part of another."

"The action is based upon deception, unfairness and fraud, and when these are established the court should not hesitate to act. Fraud should be clearly proved; it should not be inferred from remote and trivial similarities. Judicial paternalism should be avoided; there should be no officious meddling by the court with the petty details of trade; but, on the other hand, its process should be promptly used to prevent an honest business from being destroyed or invaded by dishonest means." Coxe, J., in Hilson Co. v. Foster, 80 Fed. Rep. 896-897.

"The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader; and he can not, therefore (in the language of Lord Langdale in the case of Perry v. Truefit, 6 Beavan, 66-73), 'be allowed to use names, marks, letters or other *indicia* by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.'" Lord Kingsdown in Leather Cloth Co. (Ltd.) v. American Leather Cloth Co. (Ltd.), 11 H. L. C. 358; followed in Johnston v. Orr-Ewing, 7 App. Cas. 219-229.

"The courts have evolved out of the technical law of trademarks a just doctrine, well founded, and known as the law of unfair trade, the underlying principle of which is not only sound and broad but eminently more concerned with the justice of the cause than was our ancient jurisprudence with reference to infringements of the trademark."

Nortoni, J., in Grocer's Journal v. Midland Pub. Co., 127 Mo. App. 366; 105 S. W. Rep. 312; quoted with approval, McGrew Coal Co. v. Menefee, 162 Mo. App. 209; 144 S. W. Rep. 869.

"The gradual but progressive judicial development of the doctrine of unfair competition in trade has shed lustre on that branch of our jurisprudence as an embodiment, to a marked degree, of the principles or high business morality, involving the nicest discrimination between those things which may,

It has been held in some cases that in cases of unfair competition the private right of action is not based upon fraud or imposition upon the public, but is maintained solely for the protection of the property rights of complainant.[35]

and those which may not, be done in the course of honorable rivalry in business. This doctrine rests on the broad proposition that equity will not permit any one to palm off his goods on the public as those of another. The law of trademarks is only one branch of the doctrine. But while the law of trademarks is but part of the law of unfair competition in trade, yet when the two are viewed in contradistinction to each other an essential difference is to be observed. The infringement of trademarks is the violation by one person of an exclusive right of another person to the use of a word, mark or symbol. Unfair competition in trade, as distinguished from infringement of trademarks, does not involve the violation of any exclusive right to the use of a word, mark or symbol. The word may be purely generic or descriptive, and the mark or symbol indicative only of style, size, shape or quality, and as such open to public use 'like the adjectives of the language,' yet there may be unfair competition in trade by an improper use of such word, mark or symbol. Two rivals in business competing with each other in the same line of goods may have an equal right to use the same words, marks or symbols on similar articles produced or sold by them respectively, yet if such words, marks or symbols were used by one of them before the other and by association have come to indicate to the public that the goods to which they are applied are of the production of the former, the latter will not be permitted, with intent to mislead the public, to use such words, marks or symbols in such a manner, by trade dress or otherwise, as to deceive or be capable of deceiving the public as to the origin, manufacture or ownership of the articles to which they are applied; and the latter may be required, when using such words, marks or symbols, to place on articles of his own production or the packages in which they are usually sold something clearly denoting the origin, manufacture or ownership of such articles, or negativing any idea that they were produced or sold by the former." Bradford, J., in Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651-659.

"The power of courts of equity to restrain unfair competition is a very beneficent one, and is founded upon a basis of sound business morality. * * * No arbitrary rules have ever been, nor ever can be, laid down by which courts of equity will furnish this protection. To establish such rules would, like definitions in the law, furnish the means by which fraud could successfully accomplish its ends." Gray, J., in Ludlow Valve Mfg. Co. v. Pittsburg Mfg. Co., 166 Fed. Rep. 26, 29; 92 C. C. A. 60.

35—American Washboard Co. v. Saginaw Mfg. Co., 103 Fed. Rep. 281; 43 C. C. A. 233; 50 L. R. A.

§ 21. Property right as the basis of the action for unfair competition.—In view of the nebulous condition of the American cases as to the nature of the right which is at the basis of the action for unfair competition in trade, it may be well to set out here the English doctrine. That doctrine has been rather slowly evolved, but it is now to be considered as established by the opinion from which the following is an extract:

"The proposition that no one has a right to represent his goods as the goods of somebody else must, I think, as has been assumed in this case, involve as a corollary the further proposition, that no one, who has in his hands the goods of another of a particular class or quality, has a right to represent these goods to be the goods of that other of a different quality or belonging to a different class. Possibly, therefore, the principle ought to be restated as follows:—A can not, without infringing the rights of B, represent goods which are not B's goods or B's goods of a particular class or quality to be B's goods or B's goods of that particular class or quality. The wrong for which relief is sought in a passing-off action consists in every case of a representation of this nature.

"The basis of a passing-off action being a false representation by the defendant, it must be proved in each case as a fact that the false representation was made. It may, of course, have been made in express words, but cases of express misrepresentation of this sort are rare. The more common case is, where the representation is implied in the use or imitation of a mark, tradename, or get-up with which the goods of another are associated in the minds of the public, or of a particular class of the public. In such cases the point to be decided is whether, having regard to all the circumstances of the case, the use by the defendant in connection with the goods of the mark, name, or get-up in question impliedly represents such goods to be the goods of the plaintiff, or the goods of the plaintiff of a particular class or quality, or, as it is sometimes put, whether the defendant's use of such mark,

609; Shelley v. Sperry, 121 Mo. App. 429; 99 S. W. Rep. 488; A. J. Reach Co. v. Simmons Hdw. Co., 155 Mo. App. 412; 135 S. W. Rep. 503.

name or get-up is calculated to deceive. It would, however, be impossible to enumerate or classify all the possible ways in which a man may make the false representation relied on.

"There appears to be considerable diversity of opinion as to the nature of the right, the invasion of which is the subject of what are known as passing-off actions. The more general opinion appears to be that the right is a right of property. This view naturally demands an answer to the question—property in what? Some authorities say property in the mark, name, or get-up improperly used by the defendant. Others say, property in the business or goodwill likely to be injured by the misrepresentation. Lord Herschell in *Reddaway v. Banham* (L. R. [1906] A. C. 139) expressly dissents from the former view; and if the right invaded is a right of property at all, there are, I think, strong reasons for preferring the latter view. In the first place, cases of misrepresentation by the use of a mark, name, or get-up do not exhaust all possible cases of misrepresentation. If A says falsely, 'These goods I am selling are B's goods,' there is no mark, name, or get-up infringed unless it be B's name, and if he falsely says, 'These are B's goods of a particular quality', where the goods are in fact B's goods, there is no name that is infringed at all. Further, it is extremely difficult to see how a man can be said to have property in descriptive words, such as 'Camel Hair' in the case of *Reddaway v. Banham* (L. R. [1906] A. C. 199) where every trader is entitled to use the words, provided only he uses them in such a way as not to be calculated to deceive. Even in the case of what are sometimes referred to as Common Law Trade Marks the property, if any, of the so-called owner is in its nature transitory, and only exists so long as the mark is distinctive of his goods in the eyes of the public or a class of the public. Indeed, the necessity of proving this distinctiveness in each case as a step in the proof of the false representation relied on was one of the evils sought to be remedied by the Trade Marks Act 1875, which conferred a real right of property on the owner of a registered mark. I had to consider the matter in the case of *Burberrys v. Cording* (26 R. P. C. 693) and I came to the same conclusion." [35a]

35a—Lord Parker, in Spalding & Bros. v. Gamage (Ltd.), 32 R. P. C. 284, House of Lords, 1915.

§ 22. Unfair competition distinguished from trademark infringement.—It can hardly be doubted that at its inception the doctrine of unfair competition was devised to protect the public, rather than to recognize any vested right in the complainant. He had adopted a geographical name, a generic term, or words otherwise *publici juris*, to designate his wares. Perhaps he had no device, symbol or mark whatsoever, but relied upon the shape, form or color of his packages. He had, at all events, none of those methods of distinguishing his goods from those of other merchants which the law recognizes as a right of property and denominates "trademark." Yet his goods had a fixed quality and were sought for by the public. When his competitor endeavored to palm off other goods as his upon the public, the chancellor would say as Lord Langdale said: "My decision does not depend on any peculiar or exclusive right the plaintiffs have to use the name of Day & Martin, but upon the fact of the defendant using those names in connection with certain circumstances, and in a manner calculated to mislead the public, and to enable the defendant to obtain, at the expense of Day's estate, a benefit for himself, to which he is not in fair and honest dealing entitled." [36]

The true theory of unfair competition has not always been as clearly stated by the courts as it should be. One line of decisions bases this doctrine and the right to injunctive relief upon the protection of the public from fraud. On the other hand, Judge Thayer has stated that relief is granted "To restrain the defendants from perpetrating a fraud which injures the complainant's business, and occasions him a pecuniary loss." [37]

It is very clear that equity intervenes in the protection from fraud of both the complainant whose business is or may be injured by the unfair and fraudulent competition, and the public who are the consumers of his merchandise.[38]

36—Croft v. Day, 7 Beav. 84; Seb. 76.

37—Carson v. Ury, 39 Fed. Rep. 777; Cox, Manual, 709; following Goodyear India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 128 U. S. 598; 32 L. Ed. 535; Cox, Manual, 705. And to the same effect see Pierce v. Guittard, 68 Cal. 68, 71.

38—Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537; 34 L. Ed. 997.

In a sense it is not exact to separate the doctrines of trademark infringement and unfair competition.[39] The underlying doctrine is the same—the control of fraud, great or petty, by the intervention of equity;[40] and yet, without a clear understanding of the doctrines of unfair competition, it is impossible to read intelligently the tradename cases which have so long been treated either as being "trademark" cases, or cases "analogous to" trademark cases. We have discussed elsewhere the use of proper names as trademarks, and from an examination of the cases the careful student will conclude that proper names are not trademarks, and that there should not be such a thing as a technical tradename. A name which is not a trademark is not entitled to protection as a trademark.[41] It is only entitled to protection when it is fraudulently used by another. Thus, in the case of "Dent, London,"[42] which we have before referred to, Dent is a proper name and London a geographical word. They are entitled to protection against fraudulent use, but only for the same reasons and in the same sense that the size, shape, color and design of labels or packages are entitled to protection against fraudulent use. This is true of many cases which have been decided by the courts as trademark cases.

39—See note to Scheuer v. Muller, 20 C. C. A. 161.

40—Unfair competition is essentially fraudulent and therefore peculiarly within the jurisdiction of equity. Morris v. Alstedter, 156 N. Y. S. 1103.

41—"After a careful consideration of the various cases bearing on the subject, the conclusion was reached in Draper v. Skerrett, 116 Fed. Rep. 206, that, to justify a court of equity in interfering in an alleged case of unfair competition, there must be something more than the mere duplication by the one party of the other's tradename, and that this was to be found in the deceptive use of imitative methods of display, or other device by which the public are led into buying the infringer's goods where they intended to buy those of the original producer; the fraud so perpetrated being a legitimate ground for equitable interference, and the practical basis of it. It is by this standard that the complainant's right to relief in the present instance must be judged. Stevens Linen Works v. Don & Co., 121 Fed. Rep. 171; Allen B. Wrisley Co. v. Iowa Soap Co., 122 Fed. Rep. 796, 59 C. C. A. 54." Archbald, J., in Heide v. Wallace & Co., 129 Fed. Rep. 649, 650: Affirmed 68 C. C. A. 16, 135 Fed. Rep. 346.

42—Dent v. Turpin, 30 L. J. Ch. 495; Seb. 196; *Ante*, p. 31.

It should be clearly understood, then, that the law of trademarks is merely a subdivision of the law of unfair competition; and that the broader and more comprehensive doctrines of the latter have been evolved to restrain fraudulent competition in all its guises of misrepresentation of identity. In the language of the Supreme Court of Wisconsin, "unfair competition in trade is not confined to the imitation of a trademark, but takes as many forms as the ingenuity of man can devise. It may consider the imitation of a sign, a tradename, a label, a wrapper, a package, or almost any other imitation by a business rival of some distinguishing earmark of an established business, which the court can see is calculated to mislead the public and lead purchasers into the belief that they are buying the goods of the first manufacturer."[43]

The fact is that there has always existed the willingness of equity to keep the zeal of competing traders within the bounds of fairness.[44] In the very early case of *Singleton v. Bolton*, where both parties made and sold a compound which they styled "Dr. Johnson's Yellow Ointment," Lord Mansfield said: "If the defendant had sold a medicine of his own under the plaintiff's name or mark, that would be a fraud for which an action would lie. But here both the plaintiff and defendant use the name of the original inventor, and no evidence was given of the defendant having sold it as if prepared by the plaintiff."[45] So that even at the early date of the rendition of that opinion (1783) the remedy for unfair competition would have been applied upon a proper state of facts; *i. e.*, if the defendant had sold his goods as the goods of the plaintiff.

In 1810 Lord Eldon said: "There can be no doubt that this court would interpose against that sort of fraud which has been attempted by setting up the same trade in the same

43—Winslow, J., in Manitowoc Malting Co. v. Milwaukee Malting Co., 119 Wis. 543, 97 N. W. Rep. 389.

44—This branch of the law is a most interesting illustration of the unlimited adaptability of equity to cope with fraud in every form. Judge Townsend has accurately observed that "A court of equity keeps pace with the rapid strides of the sharp competitors for the prize of public favor, and insists that it shall be won only by fair trade." R. Heinisch's Sons Co. v. Boker, 86 Fed. Rep. 765, 768.

45—Singleton v. Bolton, 3 Doug. 293; Cox, 624; Seb. 4.

place, under the same sign or name, the party giving himself out as the same person."[46] It was by analogous reasoning that the same learned judge, six years later, enjoined the piracy of Lord Byron's name, applied to poems not of his composition.[47]

In 1836 Lord Langdale enjoined a defendant from using omnibuses painted like the plaintiff's, and driven and managed by servants dressed in livery like that of the plaintiff's servants.[48]

So that the doctrine was old when Mr. Justice Clifford said from the bench of the federal supreme court, "Nor is it necessary, in order to give a right to an injunction, that a specific trademark should be infringed; but it is sufficient that the court is satisfied that there was an attempt on the part of the respondent to palm off his goods as the goods of the complainant."[49]

The whole question of fairness in trade is peculiarly within the province of equitable jurisdiction; trademark infringement is but one form of unfair competition. Unfair competition is the equivalent term for the "passing off" of the English[50] and the "*Concurrence deloyale*" of the French decisions.[51]

It must be borne in mind, however, that there is this practical distinction between the issues in cases of technical trademark infringement and cases of unfair competition where no technical trademark is involved; the court is to be guided to its conclusions not by reference to any arbitrary, fanciful and distinctive device to which the plaintiff has a property right. But it is for him to determine, in the light of all the facts, whether or not an unfair competition has been instituted by the respondent. Judge Kirkpatrick, in referring to this question, has said: "Recognizing the principle, I am of the opinion that the similarity (of the competing articles) which will warrant the inter-

46—Cruttwell v. Lye, 17 Ves. 335; 1 Rose, 123; Seb. 17.

47—Lord Byron v. Johnston, 2 Mer. 29; Seb. 23. There may be unlawful interference with a complainant's business by conspiracy to drive him from the field. Evenson v. Spalding, 150 Fed. 517, 82 C. C. A. 263

48—Knott v. Morgan, 2 Keen. 213; Seb. 57.

49—McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828.

50—Lever Bros. (Ltd.) v. Bedingfield, 80 L. T. 100.

51—Pouillet, Marques de Fabrique et de la Concurrence Deloyale (4th ed.), secs. 459 *et seq.*

ference of the court must be determined by the circumstances of each case."[52] While fraud is presumed from the wrongful use of a trademark it must be proven, directly or by inference, in all cases of unfair competition which do not involve a technical trademark.[53]

Whatever the rule may be as to the showing to be made by the successful complainant upon the accounting, it is well settled that "it is not necessary that the public should be actually deceived in order to afford a right of action. All that is required is that the infringement (to warrant injunctive relief) should have a tendency to deceive."[54]

But it is true of both classes of cases that where the defendant's conduct is calculated to mislead, "it is not essential that any particular person should have been actually misled,"[55] nor is it necessary to prove that the defendant's goods have actually been sold as the plaintiff's.[56]

As the Supreme Court of Wisconsin has said "In respect of imitation being established and such imitation being well calculated to deceive it is not necessary to show by specific proof that purchasers have been actually deceived. A court of equity will act before the injurious consequences of the unfair competition have made themselves manifest, if the imitation is established, and the consequent deception seems certain to result."[57]

52—Kroppf v. Furst, 94 Fed. Rep. 150.

53—Church & Dwight Co. v. Russ, 99 Fed. Rep. 276-279. "The deceitful representation or perfidious dealing must be made out or be clearly inferable from the circumstances." Mr. Chief Justice Fuller, in Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-551. To the same effect see Scriven v. North, 67 C. C. A. 348, 134 Fed. Rep. 366, affirming, with modification, Scriven v. North, 124 Fed. Rep. 894.

54—Dallas, J., in O'Connell v. National Water Co., 161 Fed. Rep. 545, 88 C. C. A. 487, affirming National Water Co. v. O'Connell, 159 Fed. Rep. 1001. Following Shaw v. Pilling, 175 Pa. 78, 87, 34 Atl. Rep. 446; Consolidated Ice Co. v. Hygeia Distilled Water Co., 151 Fed. Rep. 10, 12, 80 C. C. A. 506.

55—Dallas, J., in Bickmore Gall Cure Co. v. Karns, 134 Fed. Rep. 833, 835; 67 C. C. A. 439; and to the same effect see Scheuer v. Muller, 74 Fed. Rep. 225, 20 C. C. A. 161; Swift & Co. v. Brenner, 125 Fed. Rep. 826.

56—Devlin v. McLeod, 135 Fed. Rep. 164, 166.

57—Winslow, J., in Manitowoc Malting Co. v. Milwaukee Malting Co., 119 Wis. 543, 97 N. W. Rep. 389.

As we have noted, the policy of the law is to encourage legitimate competition. Thus it has been held that a manufacturer under a patent can not complain of the competition of a former employe who has patented an invention in the same art and is manufacturing under his patent.[58]

This rule that fraud must be proven in cases of unfair competition is exemplified by reference to the cases cited in the foot-note, where such comparisons have been made by the courts, resulting in a finding that the competition of the respondent was fair,[59] and others where the facts have led the court to the contrary conclusion.[60]

With the exception of this feature, the same general rules of law and procedure prevail in this class of cases as obtain in proceedings to restrain trademark infringement. Thus, an injunction to restrain an unfair competition has been expressly denied upon the ground that the complainant was guilty of laches and acquiescence.[61]

Federal jurisdiction in cases of unfair competition must of course be predicated upon the general rules fixing the jurisdiction of the federal courts, so that those courts can not entertain such an action arising between citizens of the same state.[62]

58—American Coat Pad Co. v. Phoenix Pad Co., 113 Fed. Rep. 629, 51 C. C. A. 339.

59—Kroppf v. Furst, 94 Fed. Rep. 150; Putnam Nail Co. v. Ausable Horsenail Co., 53 Fed. Rep. 390; Sterling Remedy Co. v. Eureka Mfg. Co., 70 Fed. Rep. 704; N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 88 Fed. Rep. 694; Klotz v. Hecht, 73 Fed. Rep. 822; Investor Pub. Co. v. Dobinson, 82 Fed. Rep. 56; C. F. Simmons Med. Co. v. Simmons, 81 Fed. Rep. 162; La Republique Francaise v. Schultz, 94 Fed. Rep. 500; Vitascope Co. v. United States Phonograph Co., 83 Fed. Rep. 30; Brown v. Doscher, 147 N. Y. 647; Mumm v. Kirk, 40 Fed. Rep. 589; Juros Hygienic Underwear Co. v. Simons, 49 Fed. Rep. 276; Pearlberg v. Rosenstone, 70 N. J. Eq. 638; 62 Atl. Rep. 446; Warren Bros. v. Barber Asphalt Paving Co., 145 Mich. 79, 108 N. W. Rep. 652; Banzhaf v. Chase, 150 Cal. 180, 88 Pac. Rep. 704; Perlberg v. Smith, 70 N. J. Eq. 638, 62 Atl. Rep. 442.

60—Draper v. Skerrett, 94 Fed. Rep. 912; Anheuser-Busch Brewing Ass'n v. Fred Miller Brewing Co., 87 Fed. Rep. 864; Block v. Standard Distilling Co., 95 Fed. Rep. 978; Allegretti Chocolate Cream Co. v. Keller, 85 Fed. Rep. 643; City of Carlsbad v. Tibbetts, 51 Fed. Rep. 852.

61—La Republique Francaise v. Schultz, 94 Fed. Rep. 500, 501.

62—Illinois Watch Case Co. v. Elgin Nat. Watch Co., 94 Fed. Rep. 667-672. And see Air-Brush Mfg. Co. v. Thayer, 84 Fed. Rep. 640.

Fraudulent intent is presumed where the defendant persists in using an imitative dress after he has been notified of its similarity, even if his first adoption and use of the dress was innocent.[63]

§ 23. Trade slander and libel.—The question whether equity will enjoin competing traders from publishing libelous or slanderous matter concerning their competitor's business has been frequently presented to the courts. In an early case Lord Eldon said: "The publication of a libel is a crime, and I have no jurisdiction to prevent the commission of crimes, except, of course, such cases as belong to the protection of infants, where a dealing with an infant may amount to a crime—an exception arising from that peculiar jurisdiction of this court."[64] How far this doctrine—which extended to all forms of libel—has been modified by the federal courts of the United States is an involved question, the discussion of which would not be relevant to this book.

But at an early date Lord Cottenham, in refusing to enjoin libelous statements uttered of the plaintiff's literary work, said that the proper remedy lay in an action at law.[65] And the English courts have subsequently held that where matter has been held libelous in an action at law, the repetition of the libel would be enjoined in equity.[66] In one case where the court refused to enjoin a defendant from circulating an adver-

63—Lamont, Corliss & Co. v. Hershey, 140 Fed. Rep. 763.

64—Gee v. Pritchard, 2 Swanst. 402. To the same effect see (refusing an injunction against the exhibition of a painting falsely purporting to be a copy of a picture by the plaintiff) Martin v. Wright, 6 Sim. 297; refusing to enjoin a publication by defendant of a statement disparaging the plaintiff's literary work, Seely v. Fisher, 11 Sim. 581; 10 L. J. Ch. N. S. 274. And see Clark v. Freeman, 11 Beavan, 112; Fleming v. Newton, L. R. 1 H. L. C. 363; Bullock v. Chapman, 2 DeG. & Sm. 211; Browne v. Freeman (2), Cox, Manual, 424; Prudential Assurance Co. v. Knott, L. R. 10 Ch. D. 142; Fisher & Co. v. The Apollinaris Co., L. R. 10 Ch. D. 297-299; Ward v. Drat, Cox, Manual, 607.

65—Seely v. Fisher, 11 Sim. 581; 10 L. J. Ch. N. S. 274.

66—Saxby v. Easterbrook, Cox, Manual, 606; Hinrichs v. Berndes, Cox, Manual, 594; Thorley's Cattle Food Co. v. Massam, L. R. 46 L. J. Ch. 713.

tisement among the plaintiff's customers which charged the plaintiff with infringing his trademarks, the court intimated that the injunction might have been granted if malice had been shown.[67] It may now be regarded, however, as the settled law of England that "the court will interfere by injunction where statements are made with reference to the infringement of a patent, or the invasion of a trademark and the like, if it is proved to the satisfaction of the court that these statements are untrue."[68]

The same doctrine would seem to obtain in this country. It is libelous to publish of a dealer in school books that he deals in "antiquated books" and books which are "disgraceful trash."[69] And it has been held libelous *per se* to publish of another dealer of the same name (Davey) "that an unscrupulous grocer of the same name, in the immediate vicinity, advertises 'Davey's teas and coffees,' with a view to deceive the public, and may sell an inferior article."[70] Judge Lacombe has laid down the broad proposition that "every legal occupation from which pecuniary benefit may be derived creates such special susceptibility to injury by language charging unfitness or improper conduct of such occupation that such language is actionable, without proof of special damage."[71] It is the necessary corollary of this rule that a disparaging statement concerning the goods sold by another, whether under a trademark or not, must be of a character to charge him with business incapacity or improper conduct of his business before it can come within the class of matter that is slanderous or libelous *per se*. For if the words used apply to the plaintiff's merchandise in such a manner as to constitute an imputation of his improper conduct in or want of capacity for his business, they will be libelous or slanderous *per se*.[72]

67—Colley v. Hart, 7 R. P. C. 101.

68—Chitty, J., in Anderson v. Liebig's Extract of Meat Co., 45 L. T. N. S. 757-758; and to the same effect, Halsey v. Brotherhood, 45 L. T. N. S. 640; Empire Typesetting Machine Co. v. Linotype Co., 79 L. T. N. S. 8.

69—American Book Co. v. Gates, 85 Fed. Rep. 729-734.

70—Davey v. Davey, 50 N. Y. Supp. 161.

71—Ohio & Miss. Ry. Co. v. Press Pub. Co., 48 Fed. Rep. 206.

72—So where in a criminal prosecution under the Oregon Code the words applied to the property of

The truth is always a defense in actions of this character. Thus where the plaintiff had bought the goods in question from the defendant and advertised them for sale, the publication of an advertisement by the defendant that read as follows: "An opinion of Shawknit hose should not be formed from the navy blue stockings advertised as first quality by (plaintiff), since we sold (plaintiff) some lots which were damaged in the dye-house," was held not libelous, in the absence of a showing of its untruth.[73] And a wide latitude is allowed in criticism of chattels where the facts are not mis-stated. So it is not libelous to attack the theories advanced in a book even with sarcasm and ridicule, if there is no misrepresentation of what is set forth in the book;[74] and a criticism of one of the pictures of an artist stating that it is not good of its kind is not libelous, where it does not attack him in his professional character generally.[75] So, it has been held in England that no action will lie against a defendant trader for stating falsely and maliciously that his goods are superior to those of the plaintiff, even though the plaintiff suffers special damage therefrom.[76] and no false statement directly disparaging the plaintiff's goods is actionable in the absence of proof of special damage.[77]

Where an alleged libel consisted of a charge that the plaintiff had no right to use a certain trademark, it was held to be a slander of title and not a libel upon the plaintiff; that the burden was upon the plaintiff to prove malice, falsity and special damage, and that the cause of action survived the plaintiff's death.[78]

The remedy for libel or slander affecting the title to a trademark depends upon whether there is a threatened continuance of the publication of the libelous or slanderous matter. "Courts of equity have no jurisdiction of libel or slander affecting title to property or property rights, or any other slander or libel,

the prosecuting witness in such a manner as to expose him to hatred, contempt or ridicule, they were held to be a libel upon him. State v. Mason, 38 Pac. Rep. 130; 26 Or. 273.

73—Boynton v. Shaw Stocking Co., 146 Mass. 219; 15 N. E. Rep. 507.

74—Dowling v. Livingstone, 108 Mich. 321; 66 N. W. Rep. 225.

75—Battersby v. Collier, 54 N. Y. Supp. 363.

76—Hubbuck v. Wilkinson (C. A.), L. R. (1898) 1 Q. B. 86.

77—Mellin v. White, L. R. (1895) A. C. 154.

78—Hatchard v. Mege, L. R. 18 Q. B. D. 771-775.

unless threatened or apprehended repetition makes preventive relief proper and necessary. The remedy for past injuries of that nature is understood to be wholly at law." [79]

§ 24. Are trademark rights monopolistic in character?—In some jurisdictions, there has been a tendency to regard trademark rights as offensive monopolies, and to that fact may be accredited the line of decisions which have construed technical trademark rights very narrowly.[80]

79—Wheeler, J., in Palmer v. Travers, 20 Fed. Rep. 501 To the same effect, see Francis v. Flinn, 118 U. S. 385; 30 L. Ed. 165; Montgomery Ward & Co. v. South Dakota etc. Ass'n., 150 Fed. Rep. 413; Everett Piano Co. v. Maus, 200 Fed. Rep. 718; 119 C. C. A. 162; Victor Safe & Lock Co. v. Deright, 77 C. C. A. 437; 147 Fed. Rep. 211; Marlin Fire Arms Co. v. Shields, 171 N. Y. 384; Baltimore Life Ins. Co. v. Gleisner, 202 Pa. 386; Whitehead v. Kiston, 119 Mass. 484.

80—"Monopolies of any sort have never been favorites with the law. They were held by the common law to be against public policy, because against common right. The grants, charters, letters patent or other form of device or assurance by the sovereign for their creation were declared by the act of Parliament of 21 Jac. I, c. 3, to be 'utterly void and of none effect, and in no wise to be put in use and operation.' Nothing short of the 'omnipotence of parliament' is able to exclude a subject from trade in England. 7 Bac. Abr. p. 23. Two exceptions to this general rule were given by the early text writers: First. 'It seemeth clear that the king may, for a reasonable time, make a good grant to any one of the sole use of any art invented or first brought into the realm by the grantee.' Second. The king may grant to particular persons the sole use of some particular employments, as 'of printing the Holy Scriptures and law books' etc. The somewhat curious reason given for the second exception is that an unrestrained liberty to print the books to which it relates might be 'of dangerous consequences to the public.' To these exceptions a third must now be added, viz. the right of a tradesman to the exclusive use of such signs, words or symbols as he may have adopted and used in his business to distinguish articles of his own production from all similar articles produced by other persons. These exceptions do not impair the force of the general rule, '*Exceptio probat regulam de rebus non exceptis.*' The rule is unrestricted liberty in the practice of all arts and trades, and in the use of the methods by which they are conducted. He who asserts the right to an exclusive privilege in any department of business must bring himself under the protection of some recognized exception to the rule. The plaintiffs in this case claim an exclusive privilege under the third exception, viz. the right to the sole use of a certain trademark adopted, used, and registered by them; and they allege that the defendants have adopted

This tendency is erroneous. When the Statute of Monopolies, 21 Jac. I, c. 3, was enacted, in 1623, trademarks had never been legally recognized.[81] The statute, therefore, could have no possible reference to trademark rights. The later decisions which refer to trademarks as being monopolistic in character have been based upon a misconception of what constitutes a trademark. Resulting as it does from the mere effort of the producer or handler of an article to identify his goods to the purchaser, it is merely a medium of authentication, and while the owner's title to it is necessarily exclusive, it is in no sense a monopoly. The effort of an infringer to invade that right is not a laudable attempt to break a monopoly, but an offense against society, and it has been likened by the courts to the criminal offenses of forgery and counterfeiting. Thus, Judge Rives said, "That any imitation of a trademark, calculated to deceive the unwary customer, differs from absolute forgery, not in the nature, but rather in the extent of the injury."[82]

The Supreme Court of Missouri has said that "If by fraudulent means, other parties are permitted to counterfeit and forge and simulate these trademarks * * * the community is imposed on and cheated."[83]

The distinction has been emphasized by a Scottish court in the following language:

"Monopoly is not the thing for which the one party struggles and which the other resists. On the contrary, fair trading is all for the protection of which the law is invoked; and the public, as well as the manufacturer or merchant, are concerned that infringement of trademarks and trade designations should be prevented. For there is a double wrong: the public are or may be deceived, and the trader whose trademark or trade designation is infringed is or may be injured."[84]

and are now using a trademark which is an imitation of, and an infringement upon, their own. It becomes important, therefore, to learn just what the plaintiffs' trademark is, and then to determine whether it has been improperly imitated by the defendants." Williams, J., in P. C. Weist Co. v. Weeks, 177 Pa. 412; 35 Atl. Rep. 693.

81—Except in Southern v. How, 2 Popham 144. See *ante*, § 5.

82—Blackwell v. Armistead, Fed. Case No. 1474, 3 Hughes, 163.

83—Wagner, J., in State v. Gibbs, 56 Mo. 133, 136.

84—Lord Craighill in Dunnachie v. Young & Sons, Ct. Sess. Cas. 4th Ser. X 874.

§ 25. Title.—The general rule has been stated by Mr. Justice Clifford to be that "trademarks are an entirety, and are incapable of exclusive use at different places by more than one independent proprietor."[85] But this rule is subject to exceptions; or, rather, the word "exclusive," as used by Mr. Justice Clifford, must not be construed to mean that there can not be joint and several ownership of a trademark. Mr. Justice Bradley has said at circuit that, "In holding that it is necessary to the validity of a trademark or tradename that the claimant must be entitled to an exclusive right to it, or property in it, we do not mean to say that it may not belong to more than one person, to be enjoyed jointly or severally. Co-partners, upon dissolution of a partnership, may stipulate that each of them may use the trademarks of the firm, and there may be many other cases of joint and several ownership; but such co-owners will together be entitled to the exclusive use of the trademark, and perhaps each of them will be entitled to such exclusive use as to all other persons except their associates in ownership."[86] Judge Swan has said that a trademark "may be the subject of ownership by two or more, without impairing the claim of its owners to redress for its unlawful use by others."[87]

As indicated in the last opinion, general and several ownership arises frequently upon the dissolution of partnership, where the assets are divided or the trademark is not sold with the other assets, even in the absence of a special agreement.[88]

Joint and several ownership may also be created by consent.[89] It may also be created by assignment.[90] And a contract for the purpose of establishing and defining the respective trademark rights of the parties to it, and providing for the addition of other matter to the trademark, in order to prevent confusion between the goods of the parties, has been sustained upon grounds of public policy.[91]

85—Manhattan Med. Co. v. Wood, Fed. Case 9026.

86—New York & R. Cement Co. v. Coplay Cement Co., 45 Fed. Rep. 212.

87—Cleveland Stone Co. v. Wallace, 52 Fed. Rep. 431-439.

88—Taylor v. Bothin, Fed. Case No. 13,780; Young v. Jones, Fed. Case No. 18159.

89—Emerson v. Badger, 101 Mass. 82; Pratt's App. 117 Pa. 401.

90—Fish Bros. Wagon Co. v. La-Belle Wagon Works, 82 Wis. 546.

91—Waukesha H. M. Springs Co. v. Hygeia S. D. Water Co., 11 C. C. A. 277, 63 Fed. Rep. 438.

§ 26. Licenses.—The extent to which licenses for the use of trademarks may be granted, has not yet been definitely settled, although the courts have repeatedly recognized their existence and enforced them. Thus, relief by injunction was granted by the United States Circuit Court in Texas, notwithstanding the defense that the complainant had granted a license to another to use the trademark within the state of Texas; Judge Sabin remarking, "The fee to the trademark still remains in the complainant, and any injury to it will justify injunction."[92] And in a more recent case, Judge Hazel construed a conveyance of "the absolute and exclusive use" of certain trademarks in and to certain states, reserving the right to the personal use of the mark by the person executing the conveyance, to be sufficient to entitle the grantee in the conveyance to maintain suit against an infringer.[93]

It is to be regretted, that in the case last referred to, the court did not go fully into the question whether exclusive contemporaneous rights to the same trademark may exist in different parts of the same country. The latter question is wholly undetermined, and is probably the most important question concerning the tenure of trademark rights, which has not yet been adjudicated. In a recent case, Judge Dallas has treated the question of licensing the use of a trademark exactly as if it were a license under a patent, wholly on the authority of the well established line of decisions in patent cases, that where there is an exclusive licensee of the right to use a trademark, he is a necessary party to a bill for its infringement. In this case, however, the mark was used upon a patented article during the life of the patent, and the license granted covered both the patent and the trademark rights.[94]

Where the defense is interposed to an action for infringement, that the defendant has had a license for its use, that defense is met by showing that the licensing agreement has been revoked, and defendant has been notified by the plaintiff that the license has been terminated.[95]

92—Moxie Nerve Food Co. v. Baumbach, 32 Fed. Rep. 205-210.

93—Griggs, Cooper & Co. v. Erie Preserving Co., 131 Fed. Rep. 359, 362.

94—Wallach v. Wigmore, 87 Fed. Rep. 469.

95—Martha Washington Creamery Buttered Flour Co. of the United States v. Martien, 44 Fed. Rep.

In an action for the recovery of license fees, the defendant is estopped to deny the validity of the mark.[96]

§ 27. Trademarks as subjects of taxation.—Goodwill being a proper subject of taxation,[97] and trademarks being incident to the goodwill of the business in which they are employed, the latter as well are subject to taxation.[98] In New York the action of the state comptroller in including the value of a trademark of a foreign corporation in estimating the value of its capital stock employed within the state of New York may be reviewed on *certiorari*.[99]

473; Nelson v. J. H. Winchell & Co., 203 Mass. 75, 89 N. E. Rep. 180, 186.

96—Hilsen v. Libbey, 44 N. Y. Supr. Ct. 12.

97—See § 102, and cases cited.

98—State *ex rel* Spencerian Pen Co. v. Kelsey, 105 App. Div. 132.

99—State *ex rel* Spencerian Pen Co. v. Kelsey, 105 App. Div. 132. In Kentucky trademarks are held not taxable, because goodwill "has never been considered property for the purposes of taxation." Barker, J., in Com. v. K. D. & W. Co., 116 S. W. Rep. 76.

CHAPTER II.

THE ACQUISITION OF A TRADEMARK.

§ 28. **Who may acquire.**—Generally speaking any person [1] capable of holding title to personal property may acquire the right to a trademark. In practice, by far the greater portion of all trademarks are held by manufacturers. There are, however, many persons, not manufacturers, who use trademarks as a means of identifying the subject-matter of their commerce. First among these, in their natural order, are those who apply geographical names as trademarks, to the natural products of the earth. This may be done, of course, only by the owner of its sole place of production,[2] as, if the product were accessible to others, there could be no exclusive right to the trademark, except to identify the person who handled the product on its way to the consumer.

This leads us to the second, and larger, class of those who can acquire trademark rights, though they are not manufacturers. Many mercantile houses who merely select merchandise, use trademarks upon the goods they so select,[3] and these are valid, because, in the language of Mr. Chief Justice Fuller, the marks so used are equivalent to a certificate that the goods so marked are the genuine article which has been

1—"A corporation is entitled to have its trademark as well as a private individual, and may sue for its infringement." Fenner, J., in Insurance Oil Tank Co. v. Scott, 33 La. Ann. 946.

2—Congress & Empire Spring Co. v. High Rock Congress Spring Co., 45 N. Y. 291-302; 10 Abb. Pr. N. S. 348; 6 Am. Rep. 82; 57 Barb. 526; Cox, 599; Dunbar v. Glenn, 42 Wis. 118; Seb. 529; Wheeler v. Johnston, 3 L. R. Ir. 284; Apollinaris Co. v. Norrish, 33 L. T. N. S. 242; Radde v. Norman, L. R. 14 Eq. 348; Braham v. Beachim, 7 Ch. D. 848; 47 L. J. Ch. 348; 38 L. T. N. S. 640; 26 W. R. 654; Seb. 589; Hill v. Lockwood, 32 Fed. Rep. 389; City of Carlsbad v. Schultz, 78 Fed. Rep. 469; City of Carlsbad v. Kutnow, 71 Fed. Rep. 167, 18 C. C. A. 24; affirming 68 Fed. Rep. 794; Northcutt v. Turney, 101 Ky. 314; 41 S. W. Rep. 21. To the same effect see Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 217.

3—Dewitt v. Mathey, 18 Ky. L. Rep. 257, 35 S. W. Rep. 1113.

determined by the selectors to possess a certain degree of excellence, evidencing that the skill, knowledge and judgment of the selectors have been exercised in ascertaining that the particular goods so marked are possessed of a merit rendered definite by their examination and of a uniformity rendered certain by their selection.[4] Slightly analogous to this class of cases are those where the members of a trades union adopt a label to be used by the workmen who compose the union, upon the goods manufactured by them. In a number of cases their right to the protection of this label, as a trademark, has been denied,[5] while in others the right is affirmed.[6]

4—Menendez v. Holt, 128 U. S. 514-520; 32 L. Ed. 526; Levy v. Waitt (1), 56 Fed. Rep. 1016; Levy v. Waitt (2), 61 Fed. Rep. 1008, 10 C. C. A. 227; Hirsch v. Jonas, L. R. 3 Ch. D. 584, 586; *In re* Australian Wine Importers (Ltd.), 41 Ch. D. 278-281; Thompson & Co. v. Robertson, Ct. Sess. Cas. (4th ser.) XV, 880; 25 Scot. L. Rep. 649; Yale Cigar Mfg. Co. v. Yale, 30 Off. Gaz. 1183; Wood v. Lambert, L. R. 32 Ch. D. 247.

5—*Ex parte* Cigar Makers' Ass'n, 16 Off. Gaz. 958; Schneider v. Williams, 44 N. J. Eq. 391; Cigar Makers' Union v. Conhaim, 40 Minn. 726 (the last case by a divided court, three denying the right of trademark and two affirming it); McVey v. Brendel, 144 Pa. St. 235; Cox, Manual, Case No. 730; Wecner v. Brayton, 152 Mass. 101, 25 N. E. Rep. 46, 8 L. R. A. 640; Cox, Manual, Case No. 712; State v. Berlinsheimer, 62 Mo. App. 165.

6—Allen v. McCarthy, 37 Minn. 349; affirming the decision of the lower court by an equally divided bench; Bloete v. Simon, 19 Abb. N. C. 88; People v. Fisher, 57 N. Y. Sup. Ct. 552; Cigar Makers' Protective Union v. Lindner, 3 Ohio St. Dec. 244; Strasser v. Moonelis, 108 N. Y. 611; Tracy v. Banker, 170 Mass. 266; Beebe v. Tolerton & Stetson Co., 117 Iowa 593, 91 N. W. Rep. 905; Bulena v. Newman, 31 N. Y. Supp. 449; Cigarmakers' International Union of America v. Goldberg, 57 Atl. Rep. 141; Cohn v. People, 149 Ill. 486; 37 N. E. Rep. 60; State v. Hagen, 6 Ind. App. 167, 33 N. E. Rep. 233; Hetterman v. Powers, 102 Ky. 133, 43 S. W. Rep. 180. In Carson v. Ury, Judge Thayer remarks: "It is no doubt true that the union label does not answer to the definition ordinarily given to a technical trademark, because it does not indicate with any degree of certainty by what particular person or firm the cigars to which it may be affixed were manufactured, or serve to distinguish the goods of one cigar manufacturer from the goods of another manufacturer, and because the complainant appears to have no vendible interest in the label, but merely a right to use it on cigars of his own make, so long and only so long as he remains a member of the union. In each of these respects the label lacks the charac-

The cases relating to the infringement of union labels must be read in the light of the rule that "neither at common law nor by the general principles of equity was a man entitled, at least in the absence of actual fraud, to protection in the exclusive use of a label for goods, unless it were one which he was using to distinguish some visible commodity owned or traded in by him. This was equally true of an association of men." * * * (The statutes for the protection of union labels are) "designed to create both a new right of action and a new cause of action." [7]

Importers [8] or exporters [9] may have trademarks to identify the goods passing through their hands, and it has been held that a bleacher who finishes goods manufactured by another has a right to a trademark applied to goods so treated by him.[10]

§ 29. User.—There can be no right in a trademark until it has been used. Under the English act [11] an application for

teristics of a valid trademark." In the case at bar, the complainant being a manufacturer of cigars, he was granted equitable relief on the ground of unfair competition. Carson v. Ury, 39 Fed. Rep. 777, 5 L. R. A. 614; Cox, Manual, Case No. 709. As to criminal prosecution for infringement of union label see State v. Bishop, 128 Mo. 373. As to the sufficiency of proof in such a prosecution under the Massachusetts statute of 1895 (C. 462, § 4), see Commonwealth v. Rozen, 176 Mass. 129; 57 N. E. Rep. 223. That the right to use a union label may be conferred by a union upon an affiliated trades council, and both properly joined as plaintiffs in an action to enjoin the unauthorized use of the label, see Lynch v. John Single Paper Co., 101 N. Y. Supp. 824.

7—Baldwin, J., in Lawlor v. Charles H. Merritt & Son, 78 Conn. 630, 63 Atl. Rep. 639. In the subsequent history of this case a judgment for the defendants was affirmed upon the ground that § 4907, Connecticut Gen. Stats. of 1902, had not been complied with in that the label did not announce that plaintiff's hats were made by members of the union, but rather that they were made or sold by the union itself. Lawlor v. Merritt, 79 Conn. 399, 65 Atl. Rep. 295.

8—Godillot v. Hazard, 44 N. Y. Super. Ct. 427.

9—Robinson v. Finlay, L. R. 9 Ch. D. 487.

10—*In re* Sykes, 43 L. T. N. S. 626.

11—Sec. 75, Patents, Designs and Trademark Act, 1883, amended 1888, 51 and 52 Vict., c. 50; *In re* Hudson's Trademark, 3 R. P. C. 155; 32 Ch. D. 311; 55 L. J. Ch. 531; 55 L. T. 228; 32 W. R. 616; Cartmell, 168; Edwards v. Dennis, 30 Ch. D. 454.

registration of a trademark is deemed to be equivalent to public use of the trademark. But even this is merely to supply a constructive instead of the actual user required at common law,[12] and the general rule is not affected by that statute.[13] The exclusive right to the use of a trademark is acquired only by priority of appropriation. The claimant of a trademark must have been the first to use or employ the same on like articles of production.[14] A single instance of user, with accompanying circumstances evidencing an intent to continue that use,[15] is sufficient to establish the right to a trademark; there is no requirement that the use shall continue for any prescribed or definite length of time.[16] It is immaterial that the first use of the mark was accidental, for a trademark, in the language of the United States Supreme Court, "is often the result of accident rather than design."[17]

On the other hand, the use of a mark may be "so transitory, spasmodic, and inconsiderable," as not to vest title in

12—Under the act of 1870 it was held that registration was equivalent to public use of a trademark. *In re* Dutcher Temple Co., Comr. Dec. 1871, p. 248. See sections 7 and 11 of the act of 1881; Wm. Rogers Mfg. Co. v. Rogers & S. Mfg. Co., 11 Fed. Rep. 495.

13—Singer Manufacturing Co. v. Wilson, 2 Ch. D. 434-440; Lowell Mfg. Co. v. Larned, Cox, Manual, No. 428.

14—J. R. Watkins Med. Co. v. Sands, 83 Minn. 326, 86 N. W. Rep. 340.

15—Columbia Mill Co. v. Alcorn, 150 U. S. 460; 37 L. Ed. 1144; Tetlow v. Tappan, 85 Fed. Rep. 774; Hyman v. Solis Cigar Co., 4 Colo. App. 475; American Washboard Co. v. Saginaw Mfg. Co., 43 C. C. A. 233, 103 Fed. Rep. 281; Welsbach Light Co. v. Adam, 107 Fed. Rep. 463.

16—Shaver v. Shaver, 54 Iowa, 208; 37 Am. Rep. 194; Hall v. Barrows, 32 L. J. Ch. 548; Seb. 215.

The length of time required to establish the right of trademark. —"The interference of a court of equity can not depend on the length of time the manufacturer has used the trademark." Romilly, M. R., in Hall v. Barrows, 32 L. J. Ch. 548.

The right exists "the moment the article goes into the market so stamped." Westbury, L. C., in McAndrew v. Bassett, 4 DeG. J. & S. 380-386.

The right dates from the time when the actual occupation of the market with goods bearing the mark began. Levy v. Waitt, 61 Fed. Rep. 1008-1011, 10 C. C. A. 227; compare W. A. Gaines & Co. v. Rock Spring Dist. Co., 226 Fed. Rep. 531, 538 (C. C. A. 6), and Hanover Star Mill Co. v. Metcalf, 240 U. S. 403, 60 L. Ed. —.

17—Mr. Justice Miller in Trademark Cases, 100 U. S. 82; 25 L. Ed. 550.

its user as against one whose use has been "long-continued, notorious, and universally recognized." [18]

§ 30. Affixing the mark.—As stated in our definition, the mark must be affixed to the subject it serves to identify. "It may be either affixed to, or impressed upon, the goods themselves by means of a stamp or an adhesive label, or it may be made to accompany the goods by being impressed or made to adhere to an envelope or case containing the goods." [19] It has been held in England that a trademark may be watermarked,[20] and a measuring stick with an octagonal head, used as a core for rolls of carpet, has been held to be of itself a valid trademark.[21] The question of the mode of affixing is purely practical, and one package, parcel or bottle of merchandise may bear a number of trademarks. A very large percentage of the liquors imported into the United States from Europe bear not only the trademark of the producer, but also that of the bottler; and in many cases another trademark, that of the capsule manufacturer, is to be found impressed in the metallic capsule. In like manner a complicated machine may bear many trademarks, indicating the manufacturers of the wheels, axles, oil-cups, bearings, etc., and the machine as a whole bear the comprehensive trademark of the maker who has selected these several parts and assembled them.

A trademark can not be acquired by merely using the mark in advertising.[22]

§ 31. Registration not a means of acquiring.—With the solitary exception of the California case of *Whittier v. Dietz*,[23] it has nowhere been held in the United States that the right

18—Heublein v. Adams, 125 Fed. Rep. 782, 785. And see *ante*, sec. 14.

19—Sir G. Jessel, M. R., in Singer Mfg. Co. v. Wilson, 2 Ch. D. 434.

20—Alexander Pirie & Sons v. Goodall, L. R. (1891) 1 Ch. D. 35-41; holding a watermark to be a "brand" within the meaning of sec. 64, subsec. 2 (c) of the Patents, Designs and Trademarks Act, 1883.

21—Lowell Mfg. Co. v. Larned, Cox, Manual, No. 428; Fed. Case No. 8570.

22—Hazelton Boiler Co. v. Hazelton Tripod Boiler Co., 142 Ill. 494, 30 N. E. Rep. 339. St. Louis Piano Mfg. Co. v. Merkel, 1 Mo. App. 305.

23—66 Cal. 78. This decision led to the enactment of the present section 3199 of the Political Code of California (March 12, 1885), providing that "An person

to a trademark is created by registration.[24] Section 1 of the act of 1905 provides that owners of trademarks used in commerce may obtain registration of such trademarks by complying with the requirements stipulated in the act. The applicant must show that he, and no one else, has a right to use the mark; that he is actually using it in commerce with foreign nations or among the several states, or with Indian tribes; and that it is not so similar to the registered or known mark of another as to be calculated to deceive.[25] So that registration under the act of congress is in no sense a means of acquiring the right to a trademark;[26] and indeed the actual

who has first adopted and used a trademark or name, whether within or beyond the limits of this state, is its original owner."

24—The recording of a name as a trademark can not give it the quality of a trademark, if it was not theretofore a valid trademark. Oakes v. St. Louis Candy Co., 146 Mo. 391; 48 S. W. Rep. 467.

"The general rule adopted by the courts on this subject is that state statutes providing for registration of trademarks are in affirmance of the common law; that the remedies given by such statutes are either declaratory or cumulative and additional to those recognized and applied by the common law." *Per curiam*, in Woodcock v. Guy, 33 Wash. 234, 74 Pac. Rep. 358. "As the name 'Remington' is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trademark, and its registration as such could not in itself give it validity." Mr. Chief Justice Fuller in Howe Scale Co. v. Wyckoff, Seamans & Benedict, 198 U. S. 118; 49 L. Ed. 972; reversing Wyckoff, Seamans & Benedict v. Howe Scale Co., 58 C. C. A. 510; 122 Fed. Rep. 348; and Wyckoff v. Howe Scale Co., 100 Fed. Rep. 520.

25—*Ex parte* Lyon, Dupuy & Co., 28 Off. Gaz. 191.

26—"Property in trademarks does not derive its existence from an act of congress." La Croix v. May, 15 Fed. Rep. 236.

"Registration under the act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trademark, or in cases where it is necessary to give jurisdiction to the United States courts." Hawley, J., in Hennessy v. Braunschweiger & Co., 89 Fed. Rep. 665-668; quoted and followed in Sleepy Eye Milling Co. v. C. F. Blanke Tea and Coffee Co., 85 Off. Gaz. 1905. It does not create a trademark. United States v. Braun, 39 Fed. Rep. 775; Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624-627, 35 C. C. A. 496; Brower v. Boulton, 53 Fed. Rep. 389, 390; Brower v. Boulton (2), 58 Fed. Rep. 888-890, 7 C. C. A. 567; Einstein v. Sawhill, 65 Off. Gaz. 1918; Sherwood v. Horton, Cato & Co., 84 Off. Gaz. 2018; La Croix v. May, 15 Fed. Rep. 236.

application of the trademark in commerce is so essential a prerequisite to registration under the act, that as between two applicants for registration of the same mark, one of whom had in fact used his mark in trade, while the other had the assignment of the mark, acquired by transfer from its inventor, but had never actually applied it, the commissioner of patents held that the actual prior use determined the right to the mark.[27] But registration under the laws of the United States and under the laws of several of the states, while creating no new rights, confers remedies and special protection to the owner of a trademark which we will examine in another chapter.

It follows from what has been said in this section that the fraudulent registration of a trademark by one not its true owner will avail him nothing. In dealing with such a case Judge Ray has said: "The acts of the Consolidated Hoof Pad Company are but the unlawful appropriation of the tradename of the Revere Rubber Company, and an attempt to obtain the apparent sanction of the general government to the unlawful appropriation by clandestinely procuring such tradename belonging to Revere Rubber Company to be registered as the trademark of Consolidated Hoof Pad Company. When one manufacturer or dealer has used certain letters as a tradename until his goods have come to be known and called for generally by that name, a competitor in the same business can not gain any right, superior or otherwise, by procuring such letters (or such name, if it be a name), to be registered under the trademark laws as his, or its, trademark. Such larceny as this is neither encouraged, sanctioned, nor legalized."[28]

§ 32. Acquisition by assignment.—The assignment of trademarks is a subject of some difficulty and is discussed elsewhere in this book. It is sufficient in this connection to say that trademark rights are generally assignable, that quality being indispensable to the striking characteristic of perpetual exist-

27—Schrauder v. Beresford & Co., Browne, Trademarks, 661.

28—Revere Rubber Co. v. Consolidated Hoof Pad Co., 139 Fed. Rep. 151, 154.

ence possessed by trademarks, and that a proper assignment conveys to the assignee all the property rights in and to the trademark possessed by his assignor.[29] The act of 1905, sec. 10 provides that a registered trademark and trademarks for the registration of which application has been made, shall be assignable in connection with the goodwill of the business in which it is employed; and any assignment of such mark shall be void as against a subsequent purchaser for value without notice unless recorded in the Patent Office within three months from its date. We need note at this time only the general restriction on the assignability of trademarks—that they can not be assigned save in connection with the goodwill of the business with which they are identified.[30]

It is true of trademarks as of other personal property that the great mark of ownership is possession, and contracts that the title to personalty shall be in one party and the possession in another can not be set up to the prejudice of a *bona fide* purchaser without notice. Accordingly, a contract that the right to use the mark shall revert to the assignor should the assignee sell his business, can not avail as against a *bona fide* purchaser from the assignee, buying without notice.[31]

§ 33. Acquisition by an alien.—In 1844 Chancellor Walworth announced that in the interposition of equity for the protection of trademark rights "there is no difference between citizens and aliens."[32] This is also the rule in England,[33]

29—Walton v. Crowley, 3 Blatch. 440; Cox, 166, Fed. Case No. 17,133.

30—Kidd v. Johnson, 100 U. S. 617 620; 25 L. Ed. 769; Grossman v. Griggs, 186 Mass. 275, 71 N. E. Rep. 560, 562; Spiegel v. Zuckerman, 175 Fed. Rep. 978; Independent Baking Powder Co. v. Boorman, 175 Fed. 448.

31—Oakes v. Tousmierre, 49 Fed. Rep. 447-452.

32—Taylor v. Carpenter (3), 11 Paige Ch., 292-296; 3 Story, 458; 2 Wood. & M. 1; Cox, 45. This is the general rule in the United States. La Croix v. May, 15 Fed. Rep. 236; Lemoine v. Canton, 2 E. D. Smith, 343; Cox, 142; Coats v. Holbrook, 2 Sandf. Ch. 586; Cox, 20; Coffeen v. Brunton, 4 McLean, 516; Cox, 82; and under a criminal act against counterfeiting trademarks, a conviction was sustained by the Missouri Supreme Court where the defendant counterfeited the mark of an English manufacturer. State v. Gibbs, 56 Mo. 133.

33—Collins v. Cowen, 3 K. & J. 428; Collins Co. v. Brown, 3 K. & J. 423; Collins Co. v. Walker, 7 W. R. 222; Collins Co. v. Reeves, 28 L. J. Ch. 56; Howe v. McKernan, 30 Beav. 547.

Scotland,[34] Canada,[35] and India.[36] But it has been held that a foreigner has no common-law right to a trademark in the United States as against a citizen who has adopted a similar mark, in good faith, before the alien has sold any goods in this country.[37]

Under our treaty relations with Germany, a German subject has been granted protection in the use of the word "Kaiser" as a trademark, although the term was open to common use in Germany and Austria.[38]

An alien religious order having established trademark rights in the United States is not deprived of those rights by the confiscation of its property abroad, when it removes to another foreign country and continues the manufacture of its trademarked product.[39]

§ 34. Priority of appropriation.—In order to acquire a trademark, its claimant must be its first appropriator, as we have seen; for, as said by Finletter, J., "in no other way can a mark or device indicate 'true origin or ownership.'"[40] Indeed, Bouvier has defined the right of trademark in these terms: "The right of trademark is said to be best termed an exclusive right arising from first use;"[41] and it has been said by the United States Supreme Court that "The exclusive right to the use of a mark or device claimed as a trademark is founded on priority of appropriation; that is to say, the claimant of a trademark must have been the first to use or employ the same on like articles of production."[42] There-

34—Singer Mfg. Co. v. Kimball & Morton, Ct. Sess. Cas. (3d ser). XI. 267.

35—Davis v. Kennedy, 13 Grant, Up. Can. Ch. 523. Pabst Brewing Co. v. Ekers, Rap. Jud. Que. 21 C. S. 545.

36—Orr-Ewing v. Chooneeloll Mullick, Cor. 150; Orr-Ewing v. Grant, Smith & Co., 2 Hyde, 185.

37—Richter v. Anchor Remedy Co., 52 Fed. Rep. 455; Richter v. Reynolds, 59 Fed. Rep. 577, 8 C. C. A. 220; Eiseman v. Schiffer, 157 Fed. Rep. 473, 475; Walter Baker & Co. v. Delapenha, 160 Fed. Rep. 746, 748 (in which the above text is quoted and approved).

38—J. & P. Baltz Brew. Co. v. Kaiserbrauerei, Beck & Co., 20 C. C. A. 402, 74 Fed. Rep. 222, 224.

39—Baglin v. Cusenier Co., 156 Fed. Rep. 1016; affirmed, 221 U. S. 580; 55 L. Ed. 863.

40—Sheppard v. Stuart, 13 Phil. 117; Price & Stewart, 193-200.

41—Bouvier, Dict., title "Trademarks."

42—Columbia Mill Co. v. Alcorn, 150 U. S. 460; 37 L. Ed. 1144. See also Manitowoc Mfg. Co. v. Dickerman, 57 Off. Gaz. 1721.

must necessarily be such a use as qualifies the mark as an indication of the origin and ownership of the goods to which it is applied. If the same mark had been in prior use by another at the same place or another locality near enough to start a similar right, the second user could have no trademark right to it.[43] "In order that the claimant of the trademark may primarily acquire the right of property in it, it must have been originally adopted and used by him—that is, the assumed name or designation must not be one that was then in actual use by others; and such adoption and use confer upon him the right of property in the trademark."[44] A trademark having no necessary relation to invention or discovery,[45] it is the party who first actually uses a mark, and not the one who first thought of it or designed it, that is entitled to protection in its use as a trademark.[46] A mere declaration of intention to use a certain mark in the future does not create a right to its use as a trademark, for such right can only originate with the actual use of the mark in commerce.[47] And it has been held in England, by Lord Justice Cairns, that there can be no right of trademark until the goods bearing the mark are actually upon the market, and that it can not be protected before that time, even though the goods to which it is to be applied are in the course of manufacture, and the claimants of the mark have made expenditures in advertising it.[48] The right to the mark must relate back to its first use.[49] A mark once abandoned is open to appropriation by another who adopts it subsequently in good faith.[50]

43—Tetlow v. Tappan, 85 Fed. Rep. 774; Hyman v. Solis Cigar Co., 4 Colo. App. 475.

44—Derringer v. Plate, 29 Cal. 292; Cox, 324.

45—Trademark Cases, 100 U. S. 82; 25 L. Ed. 550.

46—George v. Smith, 52 Fed. Rep. 830; Trisdorfer & Co. v. Estate of Bassett, 60 MSS. D. Sept. 1896.

"The right to a trademark does not depend upon originality, even as against the originator of the characteristic use." Holmes, C. J., in Burt v. Tucker, 178 Mass. 493; 59 N. E. Rep. 1111; citing Monson v. Bochm, L. R. 26 Ch. D. 398, 407, 408; Levy v. Waitt (2), 10 C. C. A. 227, 61 Fed. Rep. 1008, 25 L. R. A. 190; Julian v. Hoosier Drill Co., 78 Ind. 408, 412.

47—Schneider v. Williams, 44 N. J. Eq. 391; 14 Atl. Rep. 812; 44 Off. Gaz. 1400.

48—Maxwell v. Hogg, L. R. 2 Ch. 307; 36 L. J. Ch. 433; 16 L. T. N. S. 130; Seb. 264.

49—O'Rourke v. Central City Soap Co., 26 Fed. Rep. 576-578.

50—Brower v. Boulton, 53 Fed. Rep. 389.

It was held by the late Mr. Justice Brown when *nisi prius* judge that one who begins to use a mark while it is in use by another can not acquire title by a subsequent abandonment by the first user, the court observing "if it be once conceded that a person may acquire a good title to a trademark by appropriation, without the consent of the lawful owner, it would enable a manufacturer, by the use of large capital or superior energy, to drive competitors out of business by seizing their trademarks, and using them for that very purpose, provided the lawful owner is unable or unwilling to assert his rights by resort to the courts."[51] With this apparently sound doctrine the Court of Appeals, D. C., has differed, its reasoning being: "As long as the first appropriator is using the mark, the second acquires no property right therein. If his use interferes with that of the true proprietor, courts of equity afford the latter a swift and adequate remedy. We can not assume that one whose rights are invaded will not avail himself of such aid. If he is unwilling to do so, he must accept the consequences. When the owner abandons his mark, it becomes the subject of reappropriation and the property of the first taker. We fail to see why one already using the mark, where, as in this case, he has acted in good faith and without knowledge of its prior use, should not be as much entitled to appropriate it as one whose date of adoption is subsequent to the abandonment."[52]

As a matter of practice, inasmuch as the plaintiff must show title in order to make a case, evidence of the fact that he or his predecessor in title was the first to appropriate the mark to the class of goods for which he claims it as a trademark, is usually a part of the *prima facie* case. In a New York case, it was shown in defense that prior to the date when plaintiff first labeled cigars with the label in controversy, certain label manufacturers had sold the same label to other persons in the trade. Injunction was denied upon the ground that such evidence negatived plaintiff's claim of exclusive title.[53]

51—O'Rourke v. Central City Soap Co., 26 Fed. Rep. 576.

52—Mayer Fertilizer & Junk Co. v. Virginia-Carolina Chem. Co., 35 App. D. C. 425, 156 O. G. 539.

53—Wagner v. Daly, 97 Hun 477, 22 N. Y. Supp. 493.

A trademark right can not be negatived by any prior use for mere decorative purposes or on another class of goods.[54] And it has been held that the prior use as English silver hallmarks of the three component parts comprised in the complainant's mark did not deprive him of a trademark right therein.[55]

It is now well established that priority of adoption alone does not necessarily determine the ownership of the mark. The use of the mark by one claimant may be "so transitory, spasmodic, and inconsiderable," as not to vest title in the user as against one whose use has been "long continued, and universally recognized."[56] As Judge Elmer B. Adams has stated it, "The right to a trademark at common law, independent of the registration statute, is not created by invention or priority of adoption alone. A word, symbol, or device, to be a valid trademark constituting a right of property, must have been used by the owner in connection with the sale of his goods for such length of time, and under such circumstances, as indicates to the trade that the goods in connection with which it appears are his goods, as distinguished from those of other manufacturers or dealers. The mere adoption of such word, symbol, or device, unaccompanied by such a use, is not sufficient to create an exclusive right thereto."[57]

It is noteworthy in this connection that in a very recent decision of the Court of Session in Scotland, before the Lord President (Dunedin) and Lords McLaren, Kinnear and Pearson, the rule we are contending for has been explicitly announced. In the decision of that court as announced by the Lord President, it is said:

> "My Lords, I think it is very necessary to keep this firmly in view—that what we are doing in this case is

54—Johnson & Johnson v. Seabury & Johnson, 61 Atl. Rep. 5, 69 N. J. Eq. 696.

55—Gorham Mfg. Co. v. Weintraub, 176 Fed. Rep. 927.

56—Heublein v. Adams, 125 Fed. Rep. 782, 785.

57—Macmahan Pharmacal Co. v. Denver Chemical Mfg. Co. 113 Fed. Rep. 468-476; 51 C. C. A. 302. To the same effect see Tetlow v. Tappan, 85 Fed. Rep. 774, 775; Levy v. Waitt, 10 C. C. A. 227, 61 Fed. Rep. 1008, 25 L. R. A. 190; Cohen v. Nagle, 190 Mass. 4, 76 N. E. Rep. 276; Metcalf v. Hanover Star Mill. Co., 204 Fed. Rep. 211; 122 C. C. A. 483; affirmed, 240 U. S. 403; 60 L. Ed. —.

something very different from what one does in examining the evidence in a case say, as to anticipation of a patent. If the right to a trademark was constituted by the fact that it was, so to speak, an invention, then it is quite clear that as soon as it was proved that the trademark had been used by anybody, however little the use was, but still had been used at a period prior to that when it was first possible to register it, that would be sufficient to put out of the way the claim to exclusive right of a person who had got registered for it. * * * Now, property in a mark does not mean a few isolated sales under that mark, but it means, as I take it, that you had sold so much goods under it that the mark had come, in a certain market, to be associated with your goods." * * * "I will just say that, taking the matter as a jury would, it seems to me that none of these people have really proved anything more than a very spasmodic use of the labels with a cat and barrel on them, and that by none of them is there really any trade proved that would associate their goods with a cat and barrel." [58]

"Unless so well known and so thoroughly recognized by the public as to be a distinctive name for a sufficient length of time, such words could not be the subject of a valid trademark." [59]

§ 35. Acquisition of the right to use the name of another.—As the subject of the use of proper names in trade is fully discussed elsewhere in this book [60] we will in this section consider only the methods by which one trader may lawfully obtain the right to use the name of another person for trade purposes. The fundamental rule is, the right to use such a name must have been acquired in good faith and without any purpose to work a fraud on another; to merely "hire" such a right for the purpose of using it in competition with another having the same or a similar name, has been styled by Mr. Justice Bradley a "shallow pretext." [61] The same rule applies

58—Boord & Son v. Thom & Cameron, Ld., 24 R. P. C. 697, at pages 720, 721.

59—Chatfield, J., in Taylor Provision Co. v. Gobel, 180 Fed. Rep. 938; to same effect, Thomas G. Carroll & Son Co. v. McIlvaine & Baldwin, 171 Fed. Rep. 125, 129; Dietz v. Horton Mfg. Co., 170 Fed. Rep. 865, 869.

60—See §§ 72, 76, 77; Act 1905, § 5.

61—Sawyer v. Kellogg, 7 Fed. Rep. 720, 722.

to the adoption of a corporate name embodying a proper name,[62] and of course to partnership names.[63]

The conveyance of such a right must be clear and unequivocal; "the right of a man to use his own name in connection with his own business is so fundamental that an intention to entirely divest himself of such right and transfer it to another will not readily be presumed, but must be clearly shown. Where it is so shown, the transaction will be upheld, but it will not be sustained upon doubtful or uncertain proof."[64]

62—Garrett v. T. H. Garrett & Co., 24 C. C. A. 173, 78 Fed. Rep. 472, 475.

63—Gordon Hollow Blast Grate Co. v. Gordon, 142 Mich. 488, 105 N. W. Rep. 1118.

64—Harrison, J., in F. T. Blanchard Co. v. Simon, 51 S. E. Rep. 222, 104 Va. 209.

CHAPTER III.

WHAT CONSTITUTES A VALID TRADEMARK.

§ 36. The general rule.—Having seen in the preceding chapters something of the general requisites of a valid trademark, we now approach the subject of the more exact tests to be applied in determining its validity. It is the general rule that a mark must be truthful and unobjectionable on the ground of being a generic term.[1]

§ 37. It must be truthful.—This rule is apparently simple, yet it has given rise to much discussion and some apparent conflicts in the decisions. Honest competition is the requirement of the chancellor, and he is just as ready to dismiss the bill of a complainant whose trademark is calculated to deceive the public into a belief that his goods are something other than they actually are, as he is to enjoin the defendant where he has infringed an honest trademark. The modern law of unfair trade is a perfect superstructure of ethical principles, founded upon the basis of all ethics—honesty. In no class of cases is the rule that he who comes into a court of equity must do so with clean hands more rigidly applied.[2] It is not material whether the words or symbols used as trademark contain the deceptive or untruthful statement. Indeed the dishonest matter is usually foreign to the mark itself, and contained in other matter used in advertising or describing the goods sold under the mark.

In order to appreciate the trademark cases involving the question of untruthful representation, the reasoning of the courts in other avenues of jurisprudence, in which the consideration of the effect of such conduct is involved, is worthy of study. It is impossible to collate even the leading cases illuminative of this subject, within the limitations imposed upon

1—Prince Mfg. Co. v. Prince's Metallic Paint Co. (2), 135 N. Y. 24, 31 N. E. Rep. 990.

2—Dadirrian v. Yacubian, 98 Fed. Rep. 872-876.

a special treatise of this character; but we will refer to some of the most notable. In sustaining the Massachusetts Oleomargarine act, Mr. Justice Harlan found that "the real object of coloring oleomargarine so as to make it look like genuine butter is that it may appear to be what it is not, and thus induce unwary purchasers, who do not closely scrutinize the label upon the package in which it is contained, to buy it as and for butter produced from unadulterated milk or cream from such milk. * * * The constitution of the United States does not secure to any one the privilege of defrauding the public."[3]

In a suit for breach of contract, where the defense had offered proof tending to show that menhaden delivered under the contract by the plaintiff were packed by the plaintiff under the false brands "Alaska Mackeral," "Russia Mackeral," and "Family White Fish," the court said:

> "Humanity is entitled to know what it buys and consumes. Government is instituted and maintained, and law is administered, for the protection of the people; and justice influenced by enlightened public policy, and controlled by legal principles, requires that contracts shall not be upheld and enforced for the benefit of a wrong doer, where the subject-matter thereof is designed to be used in furtherance of a business enterprise which contemplates imposition upon the general public through false, misleading, and deceptive brands and labels, placed upon sealed packages of food products in a manner calculated to deceive, and forward the sale of such articles for what they are not."[4]

§ 38. **A dishonest label will invalidate.**—We find that where a distiller mixed nearly thirty-six per cent. of other whiskies with his own brand, and sold the blend under a label formerly used upon whisky of his own distillation, with cautions to avoid imitations and asserting that the mixture was "bottled at the distillery warehouse and is warranted perfectly pure and unadulterated," an injunction was refused because of this misrepresentation. This decision, whose tendency is more far-reaching than that of *Manhattan Medicine Co. v. Wood*,[5]

3—Plumley v. Massachusetts, 155 U. S. 461, 467, 479, 39 L. Ed. 223

4—Church v. Proctor, 66 Fed. Rep. 240-245; 13 C. C. A. 426.

5—108 U. S. 218; 27 L. Ed. 706.

seems on the reading of the facts to impose a hardship on the owners of the mark, Jas. E. Pepper & Co. The interest of the complainant was derived under a contract with that firm giving him the entire control of their trade in bottled whisky. The proof showed that up to and including the year 1891 the Pepper Company bottled nothing under the gold trade label partially described above used by them but "Old Pepper" whisky distilled by them, but that after November, 1891, the demand for the distillery bottling became so great that they could not supply it with the output of their own distillery and therefore bought other whiskies shown to be more expensive, older and made by the same formula as their own, and blended these whiskies with their own, and bottled the resulting blend under the same label and trademark. Here, if ever, one would think equity would relax its rule, and, as the public had not suffered by the complainant's acts, would continue to protect the trademark. But the learned court thus tersely applies the principles: "Pepper offers as an excuse for bottling a mixture that the demand for his goods had so increased that he could not supply it with Pepper whisky. What was this demand for? Plainly for pure and unadulterated Pepper whisky, bottled at the distillery. If this could not be honestly supplied, then it could not be supplied at all in such a way as to keep the business within the protection of a court of equity. Relief is refused to Pepper and his privies because of his misrepresentations to the public."[6] Thus is emphasized the statement of Mr. Justice Field that the protection of equity is extended to the owner of a trademark "not only as a matter of justice to him, but to prevent imposition upon the public."[7] There are a number of cases in which the misrepresentation has been held to be so slight and immaterial as not to disentitle the complainant

6—Krauss v. Jos. R. Peebles' Sons Co., 58 Fed. Rep. 584-596. An English case resembling this as to the facts is Starey v. Chilworth Gunpowder Co., L. R. 24 Q. B. D. 90.

Relief will be denied in such cases although the article is actually as good as it is represented to be. Prince Mfg. Co. v. Prince's Metallic Paint Co. (2), 135 N. Y. 24, 31 N. E. Rep. 990.

7—Manhattan Medicine Co. v. Wood, 108 U. S. 218-223; 27 L. Ed. 706; citing Amoskeag Manufacturing Co. v. Trainor, 101 U. S. 51; 25 L. Ed. 993.

to relief.[8] Thus, a claim by the manufacturer of a patent medicine that it permanently overcomes habitual constipation, will not, even if untrue, disentitle the plaintiff from relief in equity, the court taking judicial notice of the fact that the effect of any medicine for constipation is largely dependent upon the constitution and habits of the person treated.[9]

The use of the words "Sole Manufacturer" by a dealer who does not manufacture, but has the article produced for him by another, has been held not to debar the user of the trademark from equitable relief,[10] as has the addition of the word "distillers" to the firm name of former proprietors of a distillery owned by a complainant.[11]

§ 39. The cases of false representation in connection with trademarks.—In 1837 the English High Court of Chancery in *Pidding v. How*, announced that it could not interfere in behalf of a plaintiff who had "thought fit to mix up that which may be true with that which is false" in his labels and advertisements.[12] The Court of Appeals of New York in a similar case in 1848, by Gardiner, J., observed laconically, "The privilege of deceiving the public, even for their own benefit, is not a legitimate subject of commerce; and at all events, if the maxim that he who asks equity must come with pure hands is not altogether obsolete, the complainant has no right to invoke the extraordinary jurisdiction of a court of chancery in favor of such a monopoly."[13] Prior to this, an injunction was refused where the mark in question was applied by the complainant to a "quack" medicine.[14] "Balm of Thousand Flowers" the name of a cosmetic, being deceptive, its infringement by a defendant assuming the name "Balm of Ten Thousand

8—Tarrant & Co. v. Hoff, 71 Fed. Rep. 163; affirmed, 76 Fed. Rep. 959, 22 C. C. A. 644; Centaur Co. v. Robinson, 91 Fed. Rep. 889; Ransom v. Ball, 7 N. Y. Supp. 238.

9—California Fig Syrup Co. v. Worden, 95 Fed. Rep. 132-134.

10—Gluckman v. Strauch, 91 N. Y. Supp. 223, affirmed, 186 N. Y. 560, 79 N. E. Rep. 1106.

11—Frazier v. Dowling, 18 Ky. L. Rep. 1109, 39 S. W. Rep. 45.

12—Pidding v. How, 8 Sim. 477; Cox, 640; followed in Perry v. Truefit, 6 Beav. 66; Cox, 644.

13—Partridge v. Menck, 2 Sandf. Ch. R. 622; 2 Barb. Ch. R. 101; 1 How. App. Cas. 558; Cox, 72.

14—Fowle v. Spear, 7 Penn. L. J. 176; Cox, 67; followed in Heath v. Wright, 3 Wall. Jr., 1; Cox, 154.

Flowers" was not enjoined,[15] although the same mark was held valid and the rule announced that "the public should be left to its own guardianship" in *Fetridge v. Merchant*.[16] But the doctrine generally is that of *Pidding v. How*.[17]

The general rule concerning the effect of false representations by the plaintiff in the use of the mark upon his right to relief in equity, has been comprehensively stated by Mr. Justice Shiras, as follows: "When the owner of a trademark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not in his trademark, or in his advertisements and business, be himself guilty

15—Fetridge v. Wells, 4 Abb. Pr. 144; 13 How. Pr. 385; Cox, 180.

16—4 Abb. Pr. 156; Cox, 194.

17—*Supra*, 8 Sim. 477; Cox, 640. The rule is conceded, announced or followed in Hobbs v. Francais, 19 How. Pr. 567; Cox, 287; Phalon v. Wright, 5 Phila. 464; Cox, 307; Smith v. Woodruff, 48 Barb. 438; Cox, 373; Curtis v. Bryan, 2 Daly, 212; 36 How. Pr. 33; Cox, 434; Palmer v. Harris, 60 Pa. St. 156; 8 Am. L. Reg. N. S. 137; Cox, 523; Dixon Crucible Co. v. Guggenheim, 3 Am. Law T. 228; 2 Brewster, 321; Cox, 559; Leather Cloth Co. v. American Leather Cloth Co, 11 Jur. N. S. 513; Cox, 688; 11 H. L. C. 543; Flavel v. Harrison, 10 Hare, 467; Morgan v. McAdam, 36 L. J. Ch. 228; Ford v. Foster, L. R. 7 Ch. D. 611; 41 L. J. Ch. 682; *In re* Saunion & Co., Cox, Manual, No. 625; Estcourt v. The Estcourt Hop Essence Co., 31 L. T. N. S. 567; L. R. 10 Ch. D. 276; 44 L. J. Ch. 223; 32 L. T. N. S. 80; 23 W. R. 213; Joseph v. Macowsky, 96 Cal. 518; Meriden Britannia Co. v. Parker, 39 Conn. 454-460; Laird v. Wilder, 2 Bush (Ky.), 131; 15 Am. Rep. 707; Connell v. Reed, 128 Mass. 477; 35 Am. Rep. 299; Wolfe v. Burke, 7 N. Y. Sup. Ct. 151; 56 N. Y. 115; 2 Off. Gaz. 441; Seabury v. Grosvenor, Fed. Case No. 12576; 14 Off. Gaz. 679; Hennessy v. Wheeler, 69 N. Y. 271; Piso Co. v. Voight, 4 Ohio N. P. 347; California Syrup of Figs Co. v. Stearns (1), 67 Fed. Rep. 1008; Wood v. Butler, 3 R. P. C. 81; L. R. 32 Ch. D. 247; 55 L. J. Ch. 377; 54 L. T. 314, Cartmell, 349; *In re* Heaton's Trademark, L. R. 27 Ch. D. 570; 53 L. J. Ch. 959; 51 L. T. 220; 32 W. R. 951; Cartmell, 160; Newman v. Pinto, 4 R. P. C. 508; 57 L. T. 31; Cartmell, 242; Kenny v. Gillet, 70 Md. 574; Siegert v. Abbott (1), 61 Md. 276; Parlett v. Guggenheimer, 67 Md. 542; Palmer v. Harris, 60 Pa. St. 156; Hoxie v. Cheney, 143 Mass. 592; 10 N. E. Rep. 713; Clotworthy v. Schepp, 42 Fed. Rep. 62; California Syrup of Figs Co. v. Stearns (2), 73 Fed. Rep. 812, 20 C. C. A. 22; Buckland v. Rice, 40 Ohio St. 526; Burton v. Stratton, 12 Fed. Rep. 696-699; Ginter v. Kinney Tobacco Co., 12 Fed. Rep. 782; Koehler v. Sanders, 122 N. Y. 65, 25 N. E. Rep. 235, 9 L. R. A. 576; Perlberg v. Smith, 70 N. J. Eq. 638, 62 Atl. Rep. 442.

of any false or misleading representation; that if the plaintiff makes any material false statement in connection with the property which he seeks to protect, he loses his right to claim the assistance of a court of equity; that where any symbol or label claimed as a trademark is so constructed or worded as to make or contain a distinct assertion which is false, no property can be claimed in it, or, in other words, the right to the exclusive use of it can not be maintained." [18]

For the reasons we have been considering in this chapter, the Patent Office has refused to admit to registration as a trademark for powdered soap "the picture of a bag having the open end thereof closed by a tie," the commissioner holding that such a mark was necessarily deceptive or descriptive, and in either event was not a valid trademark.[19]

Conversely, it is manifest that it is no defense to a violation of a pure food law that the defendant sold an inferior milk product under the tradename "Evaporated Cream." [20]

It is no answer to plaintiff's misrepresentation that defendant's conduct is without justification.[21]

§ 40. **Manhattan Medicine Co. v. Wood.**—This decision, the language of whose opinion has been more often cited in support of the proposition under consideration than any other, was based on this statement of facts: The complainant derived all its trade rights in and to a proprietary medicine styled "Atwood's Genuine Physical Jaundice Bitters" from its original manufacturer, Moses Atwood, who lived at Georgetown, Massachusetts, and manufactured it there. The court says: "It is not honest to state that a medicine is manufactured by Moses Atwood, of Georgetown, Massachusetts, when it is manufactured by the Manhattan Medicine Company, in the city of

18—Clinton E. Worden & Co. v. California Fig Syrup Co., 187 U. S. 516, 528; 47 L. Ed. 282 288. To the same effect see Uri v. Hirsch, 123 Fed. Rep. 568; Millbrae Co. v. Taylor (Cal.), 37 Pac. Rep. 235; 25 L. R. A. 193.

19—*Ex parte* Martin, 89 Off. Gaz. 2259. "A word to be used as a trademark must obviously be meaningless as applied to the goods, so as to be neither descriptive nor deceptive." Duell, Commissioner, in *Ex parte* Pearson Tobacco Co., 85 Off. Gaz. 287.

20—State v. Tetu, 98 Minn. 351, 107 N. W. Rep. 953.

21—Epperson & Co. v. Bluthenthal, 149 Ala. 125, 42 So. Rep. 863.

New York."[22] On these facts the protection of their mark was refused complainants.

§ 41. The similar cases—Assignment must be made public in conjunction with the trademark, when.—Following *Manhattan Medicine Co. v. Wood*, the Court of Appeals of Maryland held[23] where the label used by the manufacturers of Angostura Bitters did not disclose the death of Dr. J. G. B. Siegert, their originator, that the label was not truthful and its infringement would not be enjoined. And the same rule has been applied as against one continuing to use the name of a predecessor in business, whose label does not announce the change.[24] The rule in this regard is held by McKenna, J., to be that where a trademark is a mark of special qualities, due to superior material, processes, skill and care exercised by the originator thereof, an assignee of the business who continues to use labels which contain the false statement that the goods are being prepared by the originator is not entitled to equitable relief against an infringer.[25]

§ 42. Unauthorized use of words "patent" or "patented."—The use of the words "patent" or "patented," in connection with or as part of a trademark, where the article identified by the mark is in fact not covered by letters patent, has given rise to many interesting decisions. All of these matters of untruthful representation are to be tested by the question of whether or not they are direct, or "purely collateral" misrep-

22—Manhattan Medicine Co. v. Wood, 108 U. S. 218; 27 L. Ed. 706.

23—Seigert v. Abbott (1), 61 Md. 276. The same doctrine is followed in Sherwood v. Andrews, 5 Am. L. Reg. N. S. 588; Seb. 263; Stachelberg v. Ponce, 23 Fed. Rep. 430; Price & Steuart, 967.

24—Helmbold v. H. T. Helmbold Mfg. Co., 53 How. Pr. 453.

25—Alaska Packers' Association v. Alaska Imp. Co., 60 Fed. Rep. 103. The Supreme Court of Pennsylvania has held the contrary, saying that an assignee is entitled to relief, even though he has not designated himself as assignee in making use of the mark. Fulton v. Sellers, 4 Brewst. 42. The tendency of the later rulings is to uphold the use of the mark by the assignee, except where his failure to disclose the fact of the assignment is equivalent to misrepresentation and falsehood. See Pillsbury v. Flour-mills Co., 64 Fed. Rep. 841-850, 12 C. C. A. 432.

resentations.[26] Where the letters patent of the United States covering an alleged improvement in jars had been declared invalid by judicial decision, but the manufacturer continued to designate the jars "Mason's Patent" jars, it was held that the fact deprived the manufacturer of equitable relief against an infringement.[27] In England a plaintiff used on his label the words "Royal letters patent," and supported the use of the words by showing that for many years he had paid the stamp duty on "patent medicines," and was only using the labels remaining on hand at the time he discovered his medicines did not belong to that class. He was denied an injunction against an infringer of his label.[28]

The reason for the particular disfavor with which equity regards this class of cases is that, by using words indicating that an article is patented where it is not, the owner of the mark is seeking to obtain the benefits of a monopoly, where he has none. As stated by Vice-Chancellor Wood, in *Morgan v. McAdam:*[29] "All those who are induced to buy these crucibles thus described as 'Patent Plumbago Crucibles' are to a certain extent deceived, because they are led to believe that the article is protected by a patent, and thus may be induced to purchase it from the plaintiff under the belief that there is a patent, and that the plaintiffs, or at least some limited number of persons, are the only persons authorized to sell it; and

26—Ford v. Foster, L. R. 7 Ch. D. 611; 27 L. T. N. S. 220; 20 W. R. 311; Cox, Manual, 384. In this case the false use of the word "patentee," used by the complainant in advertisements, was held to be a collateral misrepresentation which did not disentitle him to a remedy in equity against an infringer.

27—Consolidated Fruit Jar Co. v. Dorflinger, Fed. Case No. 3129; 6 Fed. Cas. 339; 2 Am. Law. T. Rep. N. S. 511; Cox, Manual, 444. The same rule is announced in England in Leather Cloth Co. v. Lorsont, L. R. 9 Eq. 345; 39 L. J. Ch. 86; 21 L. T. N. S. 661; 18 W. R. 572; Cox, Manual, Case No. 324; Nixey v. Roffey, W. N. 1870, p. 227; Cox, Manual, Case No. 343; Oliphant v. Salem Flouring Mills, 5 Sawyer 128, Fed. Case 10,486; Beecham v. Jacobs, 159 Fed. Rep. 129; 86 C. C. A. 623; affirmed, Jacobs v. Beecham, 221 U. S. 263, 55 L. Ed. 729.

28—Lamplough v. Balmer, W. N. 1867, p. 293.

29—36 L. J. Ch. 228; Cox, Manual, Case No. 267. Other arguments are used by the same judge in Flavel v. Harrison, 10 Hare, 467; 22 L. J. Ch. 866; 17 Jur. 368; 1 W. R. 213; Cox, Manual, Case No. 116.

further, they are led to believe that if they should be minded to set up any manufactory of the same kind for themselves, they would be unable to do so in consequence of the plaintiffs being the possessors, either by way of license or ownership, of a patent preventing the world at large from imitating the article which is sold by them under this particular designation."

And although in another English case[30] a plaintiff was held entitled to recover in an action at law in a case of this kind, where his father had held a patent held to be invalid (as in *Consolidated Fruit Jar Co. v. Dorflinger, supra,* where the contrary rule is announced), the rule is generally that, where no valid patent has ever existed, the use of the words indicating the contrary will debar the plaintiff from relief in equity.[31]

Mr. Justice Fuller has accurately defined the rule under consideration in the following language: "No right to a trademark which includes the word 'patent,' and which describes the article as 'patented,' can arise when there is and has been no patent; nor is the claim a valid one for the other words used, when it is based upon their use in connection with that word." [32]

But where there has been a valid patent upon the subject-matter of the trademark, different issues arise.

In England it has been held that the fact that a plaintiff put a mark upon his goods with the addition of the words "trademark," when his mark was not registered, did not amount to such a misrepresentation as to deprive him of the right to an injunction, because the use of the words "trademark" did not necessarily carry with it the implication that the mark had been registered.[33]

30—Sykes v. Sykes, 3 B. & Cr. 541.

31—Leather Cloth Co. v. American Leather Cloth Co., 11 Jur. N. S. 513; Cox, 688; 11 H. L. C. 543; Cox, Manual, Case No. 223. See, *per contra*, Stewart v. Smithson, 1 Hilt. 119; Cox, 175. This case can not be regarded as of authority.

32—Holzapfel's Composition Co. v. Rahtjen's American Composition Co., 183 U. S. 1, 8; 46 L. Ed. 49; reversing Rahtjen's Composition Co. v. Holzapfel's Composition Co., 41 C. C. A. 329, 101 Fed. Rep. 257, the latter reversing Rahtjen's Composition Co. v. Holzappel's Composition Co., 97 Fed. Rep. 949.

33—Sen Sen Co. v. Britten, L. R. (1899) 1 Ch. D. 692.

§ 43. Use of such word as a trademark where there has been a patent.—The last clause of sec. 4901, Revised Statutes of the United States, declares that "every person who in any manner marks upon or affixes to any unpatented article the word 'patent,' or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable for every such offence to a penalty of not less than $100, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed." It is not an offense under this law to affix to an article the word "patented" and the date of an expired patent, for the reason that the offense is not complete, unless the mark affixed indicates that there is a present subsisting patent upon the article.[34]

In *Chevrin v. Walker*,[35] Jessel, M. R., observes with regard to the effect of the use of the word "patent" by the plaintiff: "The question was fully discussed in the case in the House of Lords, *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. C. 543,[36] and I have nothing to add to what was there said. No doubt a man may use the word 'patent' so as to deceive no one. It may be used so as to mean that which was a patent, but is not so now. In other words, you may state in so many words, or by implication, that the article is manufactured in accordance with a patent which has expired. But if you suggest that it is protected by an existing patent, you can not obtain the protection of that representation as a trademark. Protection only extends to the time allowed by the statute for the patent, and if the court were afterwards to protect the use of the word as a trademark, it would be in fact extending the time for protection given by the statute. It is therefore impossible to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trademark."

34—Wilson v. Singer Mfg. Co., 12 Fed. Rep. 57.

35—L. R. 5 Ch. D. 850; 46 L. J. Ch. 686; 36 L. T. 938; Cartmell, 92; Seb. 528. See also Nixey v. Roffey, W. N. 1870, p. 227; Seb. 343.

36—*Ante*, § 42.

"But, further, no man can claim a trademark in a falsehood. It is a falsehood to represent that the patent is still subsisting."

And Kekewich, J., said *In re Adams' Trademarks:*[37] "The word 'patent' means not necessarily that there is now current a patent of protection, but that the article in question is one of those articles which had the merits of utility and novelty, and therefore received the protection of the crown by letters patent."

There are other decisions, however, not so clear as to facts, and apparently not in harmony with *Cheavin v. Walker, supra.* Five years after that case, Bacon, V. C., in a case where the plaintiffs had stamped the word "patent" on plowshares manufactured by them after their patent had expired, said: "(they) make their shares according to the invention in the expired patent, as everybody else may; but to suggest that they have in any manner claimed anything under or in respect to that patent, and that they have done this fraudulently and to deceive the public, is merely desperate, and opposed to the truth of the case."[38] Yet it does not appear in the report wherein this differed from the use of the word "patent" as criticized in *Cheavin v. Walker.* In another case[39] Vice-Chancellor Wood said: "It does not follow because upon the expiration of the patent the article and its known description become known to all, that therefore all would become entitled to use the label by which the patentees had been accustomed to distinguish their goods." This he held in regard to a label used on packages of pins marked "Taylor & Co.'s Patent Solid-headed Pins;" the manufacturer continuing to use the label after the expiration of his patent. The conclusion of the learned Vice-Chancellor was that: "The public may have ac-

37—9 R. P. C. 174; 66 L. T. 610; Cartmell, 43.

38—Ransome v. Graham, 51 L. J. Ch. 897; 47 L. T. 218; Cartmell, 279. Same rule in Stewart v. Smithson, 1 Hilt. 119; Cox, 175; Leather Cloth Co. v. Hirschfeld, 1 N. R. 551; Cox, Manual, Case No. 214. And even where no letters patent have ever issued, but the exclusive right of manufacture of baskets has been secured by registration of their design. Cave v. Myers, Seton (5th ed.), 539; Cox, Manual, Case No. 304.

39—Edelsten v. Vick, 11 Hare, 78; 1 Eq. Rep. 413; 18 Jur. 7; Cox, Manual, Case No. 119.

quired confidence in that particular label, and the confidence may have given a value to it which the patentees may be entitled to have after the expiration of their patent."

In another case it was held that where plaintiffs labeled their thread "Patent Thread," they would not be denied relief against an infringer, because the word "patent" by long usage had come to denote the character of the thread, and did not imply the existence of any patent.[40]

Of course the holder of letters patent may describe himself as "patentee" and his goods as "patented" even where he doubts the validity of the patent, and its validity has been questioned by others.[41] And it has been held in New York that one who applies for letters patent is not disentitled from relief against an infringer by reason of his describing the goods as "patented" after his application had been filed, but before the issuance of letters patent.[42] Where the plaintiffs used their label bearing the words "specially registered trademark" after application, but before registration, the English Court of Appeals granted an interlocutory injunction against an infringer, but expressly said in their opinion that they refrained from finally deciding the question whether that misrepresentation *prima facie* destroyed plaintiff's right to protection.[43]

It will be seen, therefore, that the cases discussed in this and the next preceding section are for the greater part English, and their reasoning is rather confused. The surest conclusion to be reached by an examination of the cases in this section is that of Lord Kingsdown, in *Morgan v. McAdam:*[44] "Of course it would be better, and those who are inclined to act with scrupulous honesty would take care, to put the date of their patent, which would obviate all difficulty, upon the articles which they designate as patented." Judge Kohlsaat, in denying a motion for preliminary injunction, based his decision upon the fact that the complainant, though not mark-

40—Marshall v. Ross, L. R. 8 Eq. 651; 39 L. J. Ch. 225; 21 L. T. N. S. 260; 17 W. R. 1086; Cox, Manual, Case No. 316.

41—Blakey v. Latham, 85 L. T. (Journal), 47.

42—Lauferty v. Wheeler, 16 How. Pr. 488; 11 Daly, 194.

43—Read v. Richardson, 45 L. T. 54; Cartmell, 281.

44—36 L. J. Ch. 228; Cox, Manual, No. 267.

ing the article itself "patented," had issued circulars stating that it was patented, after the patent had expired.[45]

One who issues circulars or uses markings on merchandise falsely indicating the goods dealt in by him to have been made under a particular patent will be enjoined at the instance of the owner of the patent.[46] Where there has been a patent, he who has manufactured a trademarked article under the patent during its lifetime, although he has lost the exclusive right to the use of the trademark upon the expiration of the patent, may yet enjoin one from using the mark upon an article not made according to the expired patent.[47] Where the complainant had falsely advertised that the method of applying its name to silk dealt in by it was patented, a preliminary injunction against an infringer was refused because of the misrepresentation.[48]

§ 44. The effect of expiration of the patent upon the collocation of color used in the patented article.—As we have elsewhere demonstrated[49] color alone can not be appropriated as a trademark. It would seem clear, therefore, that the same principle which renders the trademark by which the patented article is known, public property upon the expiration of the patent, would also give to the public at the same time the right to reproduce the patented article with the same coloring which it had during the life of the patent. The trend of the decisions is in that direction.

"The right to an exclusive trademark can only be acquired by its adoption for the very purpose of pointing to the origin or ownership of the article to which it is attached, and must be designed to indicate the manufacturers or sellers, and to distinguish the article from like things made or sold by others. This elastic seam, having the natural color of the cotton yarn from which the fabric was made, was inserted in men's drawers made by the Scriven Company, because such an inserted piece

45—Preservaline Mfg. Co. v. Heller Chemical Co., 118 Fed. Rep. 103.

46—Washburn & Moen Mfg. Co. v. Haish, Fed. Case No. 17217.

47—Singer Mfg. Co. v. Hipple, 109 Fed. Rep. 152.

48—Stirling Silk Mfg. Co. v. Sterling Silk Co., 46 Atl. Rep. 199, 59 N. J. Eq. 394.

49—See § 114, *post*.

constituted a structural difference constituting the invention covered by the monopoly of the patent. As assignees of the patent, no one else could insert such an elastic seam without infringement. But when the patent expired the public was free to use it. To give that inserted strip, with or without its inartificial color, the effect of a trademark thereafter would be, in effect, to extend the monopoly of the patent. That others may make and sell drawers constructed according to the design of the patent is not denied; the contention being that the elastic seam shall not be of the color used by Scriven. But, as that color is not an artificial color, Scriven has no monopoly. The color of the strip in the drawers sold by the defendants has not been artificially produced, but is shown to be the natural color of undyed and unbleached cotton yarn from which the strip is made. We may therefore dismiss the claim that the Scriven Company has established a trademark in the color of the inserted piece."[50]

§ 45. **Names of patented articles.**—The general rule as to the name applied to a patented article during the life of the patent, is that upon the expiration of the patent, the public acquires the right to make, use, and sell the patented article, and to distinguish it by the name which it bore during the life of the patent.[51]

50—Newcomer & Lewis v. Scriven Co., 168 Fed. Rep. 621, 624, 94 C. C. A. 77.

51—Fairbanks v. Jacobus, Fed. Case No. 4608, 14 Blatchf. 337; Singer Mfg. Co. v. Stanage, 6 Fed. Rep. 279; Adee v. Peck Bros. & Co., 39 Fed. Rep. 209; Singer Mfg. Co. v. June, 163 U. S. 169; 41 L. Ed. 118; (reversing Singer Mfg. Co. v. June, 41 Fed. Rep. 208); Wilcox & Gibbs S. M. Co. v. The Gibbens Frame, 17 Fed. Rep. 623; Singer Mfg. Co. v. Bent, 163 U. S. 205; 41 L. Ed. 131; (reversing Singer Mfg. Co. v. Bent, 41 Fed. Rep. 214); Centaur Co. v. Killenberger, 87 Fed. Rep. 725; Singer Mfg. Co. v. Larsen, 8 Biss. 151, Fed. Case No. 12902; Burton v. Stratton, 12 Fed. Rep. 696-700; Goodyear Rubber Co. v. Day, 22 Fed. Rep. 44; Singer Mfg. Co. v. Riley, 11 Fed. Rep. 706; Wheeler & Wilson Mfg. Co. v. Shakespear, 39 L. J. Ch. 36; Tucker Mfg. Co. v. Boyington, Fed. Cas. No. 14229; 9 Off. Gaz. 455; Filley v. Child, 16 Blatchf. 376; Fed. Case No. 4787; Ralph v. Taylor, L. R. 25 Ch. D. 194; Linoleum Mfg. Co. v. Nairn, 7 Ch. D. 834; Young v. Macrae, 9 Jur. N. S. 322; *In re* Palmer's Trademark, 24 Ch. D. 504; *In re* Leonard & Ellis' Trademark, 26 Ch. D. 288; Singer Mfg. Co. v. June, 41 Fed. Rep. 208; Brill v. Singer Mfg. Co., 41 Ohio St. 127; 52 Am. Rep. 74; Hiram Holt Co. v. Wadsworth, 41

Of course the name of a patented article during the life of the patent must be good as a trademark, to be protected as such. A patentee can not "give to his machine a word that is descriptive only, and thereby acquire a monopoly in the use of that word."[52]

In the leading case upon this subject, Mr. Justice White, speaking for the United States Supreme Court, explained the reason of the rule as follows: "It is self-evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows, as a matter of course, that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent. We may therefore dismiss without further comment the complaint, as to the form in which the defendant made his machines. It equally follows from the cessation of the monopoly and the falling of the patented device into the domain of things public, that along with the public ownership of the device there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly, in consequence of the designation having been acquiesced in by the owner, either tacitly, by accepting the benefits of the monopoly, or expressly, by his having so connected the name with the machine as to lend

Fed. Rep. 34; Coats v. Merrick Thread Co., 36 Fed. Rep. 324; Centaur Co. v. Heinsfurter, 84 Fed. Rep. 955; 28 C. C. A. 581; Lorillard v. Pride, 28 Fed. Rep. 434; Gally v. Colt's Patent Fire Arms Mfg. Co., 30 Fed. Rep. 118; Dover Stamping Co. v. Fellows, 163 Mass. 191; 47 Am. St. Rep. 448; Centaur Co. v. Robinson, 91 Fed. Rep. 889; Centaur Co. v. Neathery, 91 Fed. Rep. 891; 34 C. C. A. 118, followed in Centaur Co. v. Reinecke, 34 C. C. A. 684, 91 Fed. Rep. 1001; Centaur Co. v. Hughes Bros. Mfg. Co., 91 Fed. Rep. 901; 34 C. C. A. 127; Centaur Co. v. Marshall, 97 Fed. Rep. 785; 38 C. C. A. 413, affirming, Centaur Co. v. Marshall, 92 Fed. Rep. 605; Warren Featherbone Co. v. American Featherbone Co., 72 C. C. A. 571; 141 Fed. Rep. 513; B. B. Hill Co. v. Sawyer-Boss Mfg. Co., 112 Fed. Rep. 144; Whann v. Whann, 116 La. 690, 41 So. Rep. 38; Rice-Stix Dry Goods Co. v. Scriven Co., 165 Fed. Rep. 639, 91 C. C. A. 475; Hughes v. Alfred H. Smith Co., 205 Fed. Rep. 311.

52—Willard, J., in Seeger Refrigerator Co. v. White Enamel Refrigerator Co., 178 Fed. Rep. 567.

countenance to the resulting dedication. To say otherwise would be to hold that, although the public had acquired the device held by the patent, yet the owner of the patent or the manufacturer of the patented thing had retained the designated name which was essentially necessary to vest the public with the full enjoyment of that which has become theirs by the disappearance of the monopoly. In other words, that the patentee or manufacturer could take the benefit and advantage of the patent upon the condition that at its termination the monopoly should cease, and yet when the end was reached disregard the public dedication and practically perpetuate indefinitely an exclusive right.

"The public having the right on the expiration of the patent to make the patented article and to use its generic name, to restrict this use, either by preventing its being placed upon the articles when manufactured, or by using it in advertisements or circulars, would be to admit the right and at the same time destroy it. It follows, then, that the right to use the name in every form passes to the public with the dedication resulting from the expiration of the patent.

"Nor is this right governed by different principles where the name, which has become generic, instead of being an arbitrary one, is the surname of the patentee or original manufacturer." [53]

There appears to be an exception to this general rule where the use of the name antedates the existence of the patent,[54] particularly where it further appears that the name and not the patent gave its value to the article.[55]

In accordance with the general rule, the Patent Office has declined to register a trademark which is the name of a patented article,[56] even in association with an arbitrary symbol; [57]

53—Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 185; 41 L. Ed. 118, 124.

54—Avenarius v. Kornely, 139 Wis. 247, 121 N. W. Rep. 336.

55—Batcheller v. Thomson, 35 C. C. A. 532, 93 Fed. Rep. 660, 665. Thus the rule does not apply to "the pre-existing tradename of one unpatented element." Buffalo Specialty Co. v. Van Cleef, 227 Fed. Rep. 391 (C. C. A. 7), 142 C. C. A. 87.

56—*Ex parte* Velvril Co., Ltd., 84 Off. Gaz. 807.

57—*Ex parte* Holophane Glass Co. 100 Off. Gaz. 450; *Ex parte* Farnum & Co., 18 Off. Gaz. 412.

a registration as a trademark of the name under which a copyrighted publication was known and sold, after the expiration of the copyright, is void.[58]

It is by no means clear what trademarks applied to patented articles, other than mere names or words descriptive of the thing patented, will become *publici juris* upon the expiration of the patent. Thus the Supreme Court of Massachusetts has held that where a special word, device or symbol is added to the general descriptive name of the article of the patent, it is possible that the trademark right may exist in the combination of the word and the device or symbol, notwithstanding the expiration of the patent.[59]

In this connection, Lindley, L. J., says: "I do not mean to say that a manufacturer of a patented article can not have a trademark not descriptive of the patented article, so as to be entitled to the exclusive use of that mark after the patent has expired, for instance, if he impressed upon the patented articles a griffin or some other device; but, if his only trademark is a word or set of words descriptive of the patented article of which he is the only maker, it appears to me to be impossible for him ever to make out, as a matter of fact, that this mark denotes him as the maker, as distinguished from other makers."[60]

In every case of the kind under consideration, however, others will be enjoined from using the mark in such a way as to deceive the public into the false belief that they are getting the goods of the original owner of the mark.[61]

Thus in the leading case, the court found that the Singer Sewing Machine sold by the defendant after the expiration of the Singer patent, embodied features not a part of the patented article, and which had been used by the complainant to indicate itself as the manufacturer of the machine; and Mr. Justice White in reversing and remanding the case directed a decree of injunction in favor of the complainant, "perpet-

58—Merriam Co. v. Syndicate Pub. Co., 237 U. S. 618, 622; 59 L. Ed. 1148.

59—Dover Stamping Co. v. Fellows, 163 Mass. 191, 47 Am. St. Rep. 448.

60—*In re* Palmer's Trademark, L. R. 24 Ch. D. 504-521.

61—Singer Mfg. Co. v. Charlebois, 16 Rap. Jud. Q. C. S. 167; Centaur Co. v. Link, 62 N. J. Eq. 147, 49 Atl. Rep. 828.

ually enjoining the defendant, its agents, servants, and representatives, first, from using the word 'Singer' or any equivalent thereto, in advertisements in relation to sewing machines, without clearly and unmistakably stating in all said advertisements that the machines are made by the defendant, as distinguished from the sewing machines made by the Singer Manufacturing Company, second, also perpetually enjoining the defendant from marking upon sewing machines or upon any plate or device connected therewith or attached thereto the word 'Singer,' or words or letters equivalent thereto, without clearly and unmistakably specifying in connection therewith that such machines are the product of the defendant or other manufacturer, and therefore not the product of the Singer Manufacturing Company."[62]

It is manifest, however, that to create this right in the public, two conditions of facts are prerequisite; first, there must have been a patent, second, the patent must have expired.

Where the owner of the trademark had made an unsuccessful application for a patent upon the article to which the trademark was applied, Bradley, J., held that he had a valid subsisting right to the trademark upon the rejection of his application, and said: "His failure to establish his patent (which would have covered all his rights) ought not to preclude him from falling back on his right to the trademark."[63]

In a case where the patent had not expired, Judge Vann, speaking for the Court of Appeals of New York, said: "Assuming that upon the expiration of the patent any one may use the name, until that time arrives, why should the inventor be deprived of a right which, without question, would be his if he had not taken out a patent for his invention."[64]

Where a name indicating a patented article exists, an exclusive licensee for the sale of the patented articles under a license to which the defendant is not a party can not enjoin him from conducting an unfair competition by means of the name; the licensor not being a party to the action, and no

62—Singer Mfg. Co. v. Bent, 163 U. S. 169, 204, 41 L. Ed. 118, 131.

63—Sawyer v. Kellogg, 7 Fed. Rep. 720, 723.

64—Waterman v. Shipman, 130 N. Y. 301, reversing s. c. 8 N. Y. Supp. 814. To the same effect see George Frost Co. v. E. B. Estes & Sons, 156 Fed. Rep. 677.

infringement of the patent being charged, and the defendant having the right to deal in the articles known by the name.[65] If the patent is reissued the trademark will be valid during the life of the reissued patent.[66]

Names of copyrighted books.—The protection of such names, before or after the expiration of the copyright, is purely a matter of the application of the rules of unfair competition.[67] The right to the use of the name passes to the public upon the expiration of the copyright, but injunctive relief will be granted against the passing off of a reprint as and for the production of the original publishers under the copyright.[68]

§ 46. Generic term, defined.—By "generic term" (Latin, *genus, gener;* French, *genre*) is meant a term which may not be appropriated as a trademark because it is too general and comprehensive in its meaning to become the monopoly of an individual in application to merchandise. The word in its proper signification includes the use of geographical names, proper names, and descriptive words, used in commerce. It is a matter of regret that the courts have not defined these several phrases in their relations to each other, but such is the fact. The correctness of the author's definition is clearly established by analysis of the three classes of words and the reasons why they are not sustained as trademarks. We will examine them in their order.

(*a*) *Geographical names.*—Mr. Justice Strong has said: "It must be considered as a sound doctrine that no one can apply the name of a district or country to a well-known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or deal-

65—Johnson v. Seaman, 108 Fed. Rep. 951, 48 C. C. A. 158; reversing Seaman v. Johnson, 106 Fed. Rep. 915.

66—Hiram Holt Co. v. Wadsworth, 41 Fed. Rep. 34.

67—See *post*, § 85.

68—Ogilvie v. G. & C. Merriam Co., 149 Fed. Rep. 858; modified in G. & C. Merriam Co. v. Ogilvie, 159 Fed. Rep. 638; 95 C. C. A. 423; 16 L. R. A. (N.S.) 549; E. B. Estes & Sons v. George Frost Co., 176 Fed. Rep. 338; 100 C. C. A. 258; G. & C. Merriam Co. v. Ogilvie, 170 Fed. Rep. 167; 95 C. C. A. 423; G. & C. Merriam Co. v. Saalfield, 190 Fed. Rep. 927; 117 C. C. A. 245; same v. Syndicate Pub. Co., 207 Fed. Rep. 515; 125 C. C. A. 177; 237 U. S. 618; 59 L. Ed. 1148.

ing in similar articles coming from the district, from truthfully using the same designation."[69] In our further examination of the use of geographical names in trade, we will find that they are never properly sustained as technical trademarks except where they are used by one who is the sole owner of the entire locality to which the name is applied. In such a case the geographical name has ceased to be generic, because one person has the sole and exclusive right of trade or manufacture in the locality. Thus the author reasons that geographical names are ordinarily generic, and whenever they are held not to be valid trademarks it is because they are generic.

Of course the general rule does not apply to words which in their primary and ordinary significance are not geographical. So it has been held that the word "Keystone" is a valid technical trademark although used as an appellation for the state of Pennsylvania.[70]

(*b*) *Proper names.*—The eminent English barrister, Mr. Sebastian, has said in his work on trademarks that "a name is in its very nature generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousands, to all of whom it is equally appropriate."[71]

(*c*) *Descriptive words* have always been understood to come within the category of generic terms; indeed, Mr. Browne in his treatise upon the subject has defined "generic names" to be "names merely descriptive of an article of trade, of its qualities, ingredients or characteristics."[72] The United States Supreme Court has held that there can be no technical trademark right in words used to denote class, grade, style, quality, ingredients or characteristics.[73]

It is apparent, therefore, that the definition of generic terms which we have adopted is scientifically exact, including noth-

69—Delaware & Hudson Canal Co. v. Clark, 13 Wall. (80 U. S.) 311-327; 20 L. Ed. 581. Followed in Genessee Salt Co. v. Burnap, 67 Fed. Rep. 534; affirmed in Genessee Salt Co. v. Burnap, 20 C. C. A. 27; 73 Fed. Rep. 818.

70—Buzby v. Davis, 80 C. C. A. 163; 150 Fed. Rep. 275, 277.

71—Sebastian on Trademarks (4th ed.), p. 23.

72—Browne on Trademarks (2d ed.), § 134.

73—Canal Co. v. Clark, 13 Wall. 311-322; 20 L. Ed. 581; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-548; 34 L. Ed. 997.

ing more nor less than the words which are not subject to exclusive appropriation as trademark, because they can not be so appropriated "to the advancement of the business interests of any particular individual, firm or company. The inability to make such appropriation of them arises out of the circumstance that, on account of their general or popular use, every individual in the community has an equal right to use them, and that right is in all cases paramount to the rights and interests of any person."[74]

A generic or descriptive word can not be made a valid trademark by misspelling it (as, for example, "Kid Nee Kure," applied to a medicine),[75] or by printing it in letters from the alphabet of a foreign language.[76]

Thus the word "Roachsault," applied to a preparation for destroying roaches, has been held invalid as a trademark.[77]

It must not be inferred, however, that words in common use can not be appropriated as trademarks. They certainly can be so appropriated if used in a new and distinctive sense. If any other rule obtained, no words could be used as trademarks unless the person adopting them was their original and first inventor. There is no such legal requirement either as to words or devices.[78] "Words in common use may be adopted, if at the time of adoption they were not used to designate the same or similar articles of production."[79]

(*d*) *Suggestive words.*—It is obvious that the article to which the mark is applied must be considered in this connection. As Judge Wallace has put it, "whether a word claimed as a trademark is available because it is a fanciful or arbitrary name, or whether it is obnoxious to the objection of being descriptive, must depend upon the circumstances of each case. The word which would be fanciful or arbitrary when applied to one ar-

74—Daniels, J., in Newman v. Alvord, 49 Barb. 588; Cox, 404.

75—*Ex parte* Henderson, 85 Off. Gaz. 453.

76—*Ex parte* Stuhmer, 86 Off. Gaz. 181.

77—Barrett Chemical Co. v. Stern, 176 N. Y. 27; 68 N. E. Rep. 65; reversing 76 N. Y. Supp. 1009. Similarly "Dridip," a misspelling of "Dry dip," is not a valid trademark for lice and vermin destroyer. Ungles-Hoggette Mfg. Co. v. Farmers' Hog & Cattle Powder Co., 232 Fed. Rep. 116 (C. C. A. 8).

78—Osgood v. Allen, 1 Holmes, 185; Fed. Case No. 10603.

79—Osgood v. Allen, *supra*.

ticle may be descriptive when applied to another. If it is so apt and legitimately significant of some quality of the article to which it is sought to be applied that its exclusive concession to one person would tend to restrict others from properly describing their own similar articles, it can not be the subject of a monopoly. On the other hand, if it is merely suggestive, or figurative only, it may be a good trademark, notwithstanding it is also indirectly or remotely descriptive."[80]

Thus the word "Teller" is a valid trademark for safes, though "of a suggestive character,"[81] and so of "Roof Leak," for liquid roofing paint or coating.[82] "One may make a trademark out of a name or phrase which has some element of suggestion about it."[83]

While the following is an extract from a judicial argument delivered by a court in a futile attempt to justify its decree sustaining as a trademark a geographical word to which the plaintiff had no color of exclusive right, it is still a lucid exposition of the principle under consideration: "Words and names having a known or established signification can not within the limits of such specification be exclusively appropriated to the advancement of the business purposes of any particular individual, firm or company. The inability to make such appropriation of them arises out of the circumstance that on account of their general or popular use every individual in the community has an equal right to use them, and that right is in all cases paramount to the rights and interests of any one person, firm or company. What alike may be claimed and used by all can not be exclusively appropriated to advance the interests of any person. Numerous cases have been before the courts in which this limitation upon the use of words and names as trademarks has been maintained and established, and no good reason can be given for questioning or impeaching their conclusions. But while this limitation is entirely reasonable, there can be no propriety in extending it beyond the circumstance upon which it is founded; and accordingly any member

80—Bennett v. McKinley, 65 Fed. Rep. 505; 13 C. C. A. 25.

81—Automatic Recording Safe Co. v. Bankers' Reg. Safe Co., 224 Fed. Rep. 506, 511.

82—Elliott Varnish Co. v. Sears, Roebuck & Co., 221 Fed. Rep. 797.

83—Rose, J., in Chapin Sacks Mfg. Co. v. Hendler Creamery Co., 231 Fed. Rep. 550, 551.

of the community whose interests and business may be promoted by doing so, should be at liberty to apply even names and words in common use to the products of his industry, in such a manner as to indicate their origin or particular manufacture, where such application will not intrench upon and be in no way included in their use by the public. By doing so, the rights of no member of the community can be in any manner infringed, and no public inconvenience whatever can be occasioned by it. The public will still be left at full liberty to use such words or terms as they were used before; while for a special purpose a new office or purpose may be imposed upon them.

"In cases of that description no greater inconvenience or embarrassment can be found in protecting parties in the enjoyment of the new use or purpose engrafted upon a popular term than has been found in extending that protection to the case of a word created for the occasion." [84]

(*e*) *Laudatory adjectives.*—The rule as to adjectives claimed as trademarks has thus been stated in a recent English case:

"As pointed out by Lord Justice Moulton in the Perfection Case (26 R. P. C. 858), the quality of distinctiveness may be inherent in the word itself, but in cases where this is not the case the quality may be acquired by the mode in which it has been used and applied in the market. The question in reality is, what amount of credence is to be given to evidence tending to prove that a particular word *prima facie* descriptive only has acquired the quality of distinctiveness in reference to the particular goods? It is impossible to believe that ordinary laudatory epithets can by any amount of user acquire the quality of distinctiveness. On the other hand, there may be descriptive words so indeterminate in meaning, or so rare and unusual as applied to the particular goods, that the Tribunal may without difficulty accept the statement that they have been so used as to denote the goods of a particular trader." [85] While this decision was rendered under the English Trademark Act, it embodies the rule under which adjectives have been con-

84—Newman v. Alvord, 49 Barb. 588.

85—W. N. Sharpe, Ltd. v. Solomon Bros., 31 R. P. C. 441, 450.

demned as trademarks in the illustrative American cases in the next section.

§ 47. Illustrations of generic terms.—In the following instances the words and marks mentioned have been held to be invalid as trademarks because generic; being geographical or descriptive. The examples are arranged in alphabetical order for convenient reference.

Claimed as Trademark.	*Class of Goods.*
"A. C. A.,"	cloth.[86]
"Acid Phosphate,"	medicinal preparation.[87]
"Allcock's Porous Plasters,"	medicated plasters.[88]
"Aluminum,"	washboards.[89]
"Always Closed,"	revolving doors.[90]
"American,"	sardines.[91]
"American,"	wine.[92]
"America Strength,"	coffee and spices.[93]
"Ammoniated Bone Superphosphate of Lime,"	fertilizer.[94]
"Anglo-Portugo,"	oysters.[95]
"Angostura,"	bitters.[96]
"Antiquarian,"	book-store.[97]
"Apple and Honey,"	medicine.[98]

86—Amoskeag Mfg. Co. v. Trainer, 101 U. S. 51; 25 L. Ed. 993.

87—Rumford Chem. Works v. Muth, 35 Fed. Rep. 524.

88—*In re* Brandreth, L. R. 9 Ch. D. 618.

89—American Washboard Co. v. Saginaw Mfg. Co., 103 Fed. Rep. 281; 43 C. C. A. 233.

90—Van Kannel Revolving Door Co. v. American Revolving Door Co., 135 C. C. A. 439; 215 Fed. Rep. 582 (C. C. A. 7).

91—*In re* American Sardine Co., 3 Off. Gaz. 495.

92—American Wine Co. v. Kohlman, 158 Fed. Rep. 830; but compare Hamilton Brown Shoe Co. v. Wolf Bros. & Co., 240 U. S. 251; 60 L. Ed. —.

93—*In re* Meyer Bros. Coffee & Spice Co., 32 App. D. C. 277.

94—Allegheny Fertilizer Co. v. Woodside, 1 Hughes, 115; Fed. Case No. 206.

95—*In re* Saunion & Co., Seb. 625; Cox, Manual, 625.

96—Siegert v. Findlater, L. R. 7; Ch. D. 801; Cox, Manual, 591; Siegert v. Gandolfi, 149 Fed. Rep. 100; 79 C. C. A. 142; reversing s. c. 139 Fed. Rep. 917.

97—Choynski v. Cohen, 39 Cal. 501.

98—*Ex parte* G. F. Heublein & Bro., 87 Off. Gaz. 179.

Claimed as Trademark.	*Class of Goods.*
"A Red or Other Distinctively Colored Streak Applied To or Woven In a Wire Rope,"	wire rope.[99]
"Asbestos,"	shoes.[1]
"Asbestos,"	wall plaster.[2]
"Astral,"	oil.[3]
"Balm of Thousand Flowers,"	cosmetic.[4]
"Barber's Model,"	razors.[5]
"Bazaar,"	patterns for clothing.[6]
"Better Than Mother's,"	mince meat.[7]
"Birdsboro Trap Rock,"	stone.[8]
"Black Caps,"	medicine.[9]
"Black Capsules,"	transparent capsules containing dark medicine.[10]
"Black Package,"	tea.[11]
"Bohemian,"	beer.[12]
"Book,"	the device of a book, used by a publisher.[13]
"Borax,"	soap.[14]
"Braided Fixed Stars,"	cigar lights.[15]

99—A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 134 Fed. Rep. 571; 67 C. C. A. 418.

1—Johnson v. Brandau, 32 App. D. C. 348.

2—Asbestos & Asbetic Co. v. Wm. Selater Co., 18 Rap. Jud. Que. C. S. 360.

3—Pratt's Mfg. Co. v. Astral Refining Co., 27 Fed. Rep. 492-494.

4—Fetridge v. Wells, Cox, Am. Tr. Cas. 180.

5—*Ex parte* Krusius Bros., 82 Off. Gaz. 1687.

6—McCall v. Theal, 28 Grant (Up. Can.) Ch. 48.

7—*Ex parte* Ervin A. Rice Co., 83 Off. Gaz. 1207.

8—John T. Dyer Co. v. Schuylkill Stone Co., 185 Fed. Rep. 557.

9—*In re* Safety Remedy Co., 35 App. D. C. 353.

,10—Planten v. Canton Pharmacy Co., 33 App. D. C. 268.

11—Fischer v. Blank, 138 N. Y. 244.

12—American Brewing Co. v. Bienville Brewery, 153 Fed. Rep. 615.

13—Merriam v. Famous Shoe & Clothing Co., 47 Fed. Rep. 411.

14—Dreydoppel v. Young, 14 Phila. 226; Am. Tr. Case No. 70. Prive & Steuart, p. 423.

15—*In re* Palmer, L. R. 24; Ch. D. 504.

Claimed as Trademark.	*Class of Goods.*
"Brassiere,"	combined corset cover and bust supporter.[16]
"Brilliant,"	flour.[17]
"Cachemire Milano,"	fabric.[18]
"California Syrup of Figs,"	laxative medicine.[19]
"C. A. P.,"	cream acid phosphate.[20]
"Car Advertising Co.,"	corporate name.[21]
"Castoria,"	medicine.[22]
"Celebrated Stomach Bitters,"	bitters.[23]
"Cellular,"	cloth of cellular construction.[24]
"Centennial,"	medals.[25]
"Cherry Pectoral,"	medicine.[26]
"Chill Stop,"	medicine.[27]
"Chlorodyne,"	medicinal compound.[28]

16—Chas. R. DeBevoise Co. v. H. & W. Co., 60 Atl. Rep. 407.

17—Sauers Milling Co. v. Kehlor Flour Mills Co., 39 App. D. C. 535.

18—*In re* Warburg, 13 Off. Gaz. 44.

19—Worden & Co. v. California Fig Syrup Co., 187 U. S. 515; 47 L. Ed. 282; reversing Worden v. California Fig Syrup Co., 102 Fed. Rep. 334; 42 C. C. A. 383; California Fig Syrup Co. v. Putnam, 66 Fed. Rep. 750; affirmed, California Fig Syrup Co. v. Putnam, 16 C. C. A. 376; 69 Fed. Rep. 740; California Fig Syrup Co. v. Stearns, 67 Fed. Rep. 1008; s. c. on appeal, 73 Fed. Rep. 812; *In re* California Fig Syrup Co., L. R. 40 Ch. D. 620. *Contra*, see California Fig Syrup Co. v. Improved Fig Syrup Co., 51 Fed. Rep. 296; Improved Fig Syrup Co. v. California Fig Syrup Co., 4 C. C. A. 264; 54 Fed. Rep. 175; California Fig Syrup Co. v. Worden, 86 Fed. Rep. 212; s. c. 95 Fed. Rep. 132.

20—Provident Chemical Works v. Canada Chemical Mfg. Co., 2 Ont. Law. Rep. 182.

21—Car Advertising Co. v. New York City Car Advertising Co., 107 N. Y. S. 547; 57 Misc. Rep. 105.

22—Centaur Co. v. Robinson, 91 Fed. Rep. 889; Centaur Co. v. Neathery, 34 C. C. A. 118; 91 Fed. Rep. 891; Centaur Co. v. Hughes Bros. Mfg. Co., 34 C. C. A. 127; 91 Fed. Rep. 901; Centaur Co. v. Link, 62 N. J. Eq. 147; 49 Atl. Rep. 828.

23—Hostetter v. Adams, 20 Blatchf. 326; 10 Fed. Rep. 838.

24—Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326.

25—Hartell v. Viney, Fed. Case No. 6158.

26—Ayer v. Rushton, 7 Daly, 9.

27—*Ex parte* Hance Bros. & White, 87 Off. Gaz. 698.

28—Browne v. Freeman (1), 12 W. R. 305; Seb. 230; Cox, Manual, 230; Browne v. Freeman (2), Seb. 424; Cox, Manual, 424.

Claimed as Trademark.	*Class of Goods.*
"Circular Loom,"	coverings for electrical conductors.[29]
"Club House,"	gin.[30]
"Computing,"	scales.[31]
"Continental,"	sought to be protected from infringement as the name of a fire insurance corporation.[32]
"Copenhagen,"	snuff.[33]
"Cough Remedy,"	cough medicine.[34]
"Crack Proof,"	rubber.[35]
"Cramp Cure,"	medicine.[36]
"Cream,"	rolled oats.[37]
"Cream,"	yeast.[38]
"Cresylic,"	ointment.[39]
"Croup Tincture,"	medicine.[40]
"Crystal,"	beer.[41]
"Crystallized Egg,"	for a preparation of egg-meat.[42]
"Cylinder,"	glass products.[43]
"Desiccated,"	codfish.[44]
"Druggists' Sundries,"	cigars.[45]

29—*In re* American Circular Loom Co., 28 App. D. C. 450.

30—Corwin v. Daly, 7 Bos. 222.

31—Computing Scale Co. v. Standard Computing Scale Co., 55 C. C. A. 459, 118 Fed. Rep. 965.

32—Continental Ins. Co. v. Continental Fire Ass'n, 96 Fed. Rep. 846; affirmed, 41 C. C. A. 326; 101 Fed. Rep. 255.

33—Weyman v. Soderberg, 108 Fed. Rep. 63.

34—Gilman v. Hunnewell, 122 Mass. 139; Cox, Manual, 540.

35—*In re* Goodyear Rubber Co., 11 Off. Gaz. 1062.

36—L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624.

37—Albers Bros. Milling Co. v. Acme Mills Co., 170 Fed. Rep. 989.

38—Gillett v. Lumsden, 4 Ont. Law Rep. 300.

39—Carbolic Soap Co. v. Thompson, 25 Fed. Rep. 625.

40—*In re* Roach, 10 Off. Gaz. 333.

41—*In re* New South Brewery & Ice Co., 32 App. D. C. 591.

42—Lamont v. Leedy, 88 Fed. Rep. 72.

43—Stokes v. Landgraff, 17 Barb. 608; Cox, Am. Tr. Cas. 137.

44—Town v. Stetson, 3 Daly, 53; Cox, Am. Tr. Cas. 514.

45—*Ex parte* Cohn (2), 16 Off. Gaz. 680.

Claimed as Trademark.	*Class of Goods.*
"Dry Monopole,"	champagne.[46]
"Durham,"	tobacco.[47]
"Edelweiss-Maltine,"	beer.[48]
"Egg,"	macaroni.[49]
"Elastic Seam,"	drawers.[50]
"Electric Lump,"	coal.[51]
"Electro,"	steel.[52]
"Elgin,"	watches.[53]
"Emolliorum,"	waterproof dressing for leather.[54]
"Encyclopedia Brittannica,"	title of an encyclopedia.[55]
"Evaporated,"	food products.[56]
"Evergreen,"	candied fruits and vegetables.[57]
"Ever Ready,"	coffee mills.[58]
"Extract of Night-Blooming Cereus,"	perfume.[59]
"Faber,"	pencils.[60]
"Fairbank's Patent,"	scales.[61]
"Famous,"	stoves.[62]

46—Richards v. Butcher, L. R. (1891) 2 Ch. 522.

47—Blackwell v. Wright, 73 N. C. 310.

48—Peter Schoenhofen Brew. Co. v. Maltine Co., 30 App. D. C. 340.

49—*In re* Dole Bros., 12 Off. Gaz. 939.

50—Scriven v. North, 124 Fed. Rep. 894, 896.

51—McGrew Coal Co. v. Menefee, 144 S. W. Rep. 869; 162 Mo. App. 209.

52—Electro Steel Co. v. Lindenberg Steel Co., 43 App. D. C. 270.

53—Illinois Watch Case Co. v. Elgin Nat. Watch Co., 94 Fed. Rep. 667; reversing s. c. 89 Fed. Rep. 487.

54—*In re* Talbot, 8 R. P. C. 149.

55—Black v. Ehrich, 44 Fed. Rep. 793.

56—*In re* Alden, 15 Off. Gaz. 389.

57—Sears & Nichols Co. v. Brakeley, 38 App. D. C. 530.

58—*Ex parte* Bronson Co., 87 Off. Gaz. 1782.

59—Phalon v. Wright, 5 Phila. 464; Cox, Manual, 232.

60—von Faber-Castell v. Faber, 139 Fed. Rep. 257 (C. C. A. 2), reversing von Faber v. Faber, 124 Fed. Rep. 603.

61—Fairbanks v. Jacobus, 14 Blatchf. 337, Fed. Case No. 4608.

62—*Ex parte* Brand Stove Co., 62 Off. Gaz. 588.

Claimed as Trademark.	*Class of Goods.*
"Favorite,"	letter-file.[63]
"Ferro-phosphorated Elixir of Calisaya Bark,"	medicine.[64]
"Fire-proof,"	oil.[65]
"Flare Front,"	automobile lamps.[66]
"Flinch,"	unpatented game so named by the inventor.[67]
"French,"	paints.[68]
"French Tissue,"	medicated paper.[69]
"Fruit,"	vinegar.[70]
"Galen,"	manufactured glass.[71]
"Getwell,"	medicine.[72]
"Gibraltar,"	lamp chimneys.[73]
"Glendon,"	iron.[74]
"Globe,"	washing machines.[75]
"Golden,"	ointment.[76]
"Gold Label,"	bread.[77]
"Gold Medal,"	saleratus.[78]
"Goodyear Rubber Co.,"	as name for rubber manufacturing house.[79]

63—Cook & Cobb Co. v. Miller, 65 N. Y. Supp. 730.

64—Caswell v. Davis, 58 N. Y. 223; 17 Am. Rep. 233.

65—Scott v. Standard Oil Co., 106 Ala. 475; 31 L. R. A. 374; 19 So. Rep. 71.

66—Rushmore v. Manhattan Screw & Stamping Works, 90 C. C. A. 299; 19 L. R. A. (N.S.) 269; 163 Fed. Rep. 939.

67—H. B. Chaffee Co. v. Selchow, 131 Fed. Rep. 543.

68—*Ex parte* Marsching & Co., 15 Off. Gaz. 294.

69—Draper v. Skerrett (2), 116 Fed. Rep. 206, 208.

70—Alden v. Gross, 25 Mo. App. 123.

71—Stokes v. Landgraff, 17 Barb. 608; Cox, Am. Tr. Cas. 137.

72—*In re* Anti-Cori-Zine Chemical Co., 34 App. D. C. 191.

73—*Ex parte* Nave & McCord Merc. Co., 86 Off. Gaz. 1985.

74—Glendon Iron Co. v. Uhler, 75 Pa. St. 467; 15 Am. Rep. 599.

75—Dietz v. Horton Mfg. Co., 170 Fed. Rep. 865; 96 C. C. A. 41 (C. C. A. 6).

76—Green v. Rooke, W. N. 1872, p. 49.

77—*Ex parte* Stuhmer, 86 Off. Gaz. 181.

78—Taylor v. Gillies, 59 N. Y. 331.

79—Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 128 U. S. 598; 32 L. Ed. 535; reversing s. c., 21 Fed. Rep. 276.

Claimed as Trademark.	*Class of Goods.*
"Granite,"	enameled kitchen utensils.[80]
"Granolithic,"	artificial stone.[81]
"Granulated Dirt-Killer,"	soap.[82]
"Greatest Value for the Money,"	shoes.[83]
"Green Mountain,"	grapes.[84]
"Guaranteed,"	corset.[85]
"Guenther's Best,"	flour.[86]
"Gyrator,"	bolting machines.[87]
"Half Spanish,"	stogies and cigars.[88]
"Hamburg,"	tea.[89]
"Hand Grenade,"	fire extinguisher.[90]
"Harvey's Sauce,"	condiment.[91]
"Headache Wafers,"	medicinal compound.[92]
"Health Food,"	cereal products and prepared foods.[93]
"Health Preserving,"	corsets.[94]
"Highly Concentrated Compound Fluid Extract of Buchu,"	medicine.[95]
"Holbrook's,"	school apparatus.[96]

80—St. Louis Stamping Co. v. Piper, 33 N. Y. Supp. 443.

81—Stuart & Co. v. Scottish Val de Travers Paving Co., Ct. Sess. Cas. (4th ser.) 13, 1.

82—*Ex parte* Waeferling, 16 Off. Gaz. 764.

83—*Ex parte* Parker, Holmes & Co., 85 Off. Gaz. 287.

84—Hoyt v. J. T. Lovett Co., 71 Fed. Rep. 173; 17 C. C. A. 652; 31 L. R. A. 44; 39 U. S. App. 1.

85—Symington v. Footman, 56 L. T. N. S. 696.

86—*Ex parte* Guenther Milling Co., 86 Off. Gaz. 1986.

87—*Ex parte* Wolf, 80 Off. Gaz. 1271.

88—T. M. Kildow Cigar Co. v. Geo. B. Sprague Cigar Co., 35 App. D. C. 345.

89—Frese v. Bachof, 14 Blatchf. 432, Fed. Case No. 5110.

90—*In re* Harden Fire Extinguisher Co's Trademark, 55 L. J. Ch. 596.

91—Lazenby v. White, 41 L. J. Ch. 354.

92—Gessler v. Grieb, 80 Wis. 21; 27 Am. St. Rep. 20; 48 N. W. Rep. 1098.

93—Fuller v. Huff, 99 Fed. Rep. 439 (reversed by Fuller v. Huff, 43 C. C. A. 453; 104 Fed. Rep. 141).

94—Ball v. Siegel, 166 Ill. 137.

95—Helmbold v. Helmbold Mfg. Co., 53 How. Pr. 453.

96—Sherwood v. Andrews, 3 Am. Law Reg. N. S. 588.

Claimed as Trademark.	*Class of Goods.*
"Homeopathic Medicines,"	description of articles so called.[97]
"Hunyadi,"	mineral water.[98]
"Hydro-Bromo Soda Mint,"	medicine.[99]
"Hygienic,"	underwear.[1]
"Imperial,"	beer.[2]
"Indurated Fibre,"	wood-pulp products.[3]
"Instantaneous,"	tapioca prepared for speedy cooking.[4]
"International Banking Co.,"	as name of banking concern.[5]
"Inter-phone,"	telephone switching apparatus.[6]
"Iron Bitters,"	bitters containing iron.[7]
"Ironstone,"	water pipe.[8]
"Johnson's American Anodyne,"	liniment.[9]
"Julienne,"	soup.[10]
"Kaiser,"	beer.[11]
"KEEPCLEAN,"	toilet brushes.[12]

97—Humphrey's Spec. Homeopathic Med. Co. v. Wenz, 14 Fed. Rep. 250.

98—Saxlehner v. Wagner, 85 C. C. A. 321; 157 Fed. Rep. 745; affirmed, Saxlehner v. Wagner, 216 U. S. 375; 54 L. Ed. 525.

99—*Ex parte* Spayd, 86 Off. Gaz. 631.

1—Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co., 60 Fed. Rep. 622; s. c., 65 Fed. Rep. 424.

2—Beadleston & Woerz v. Cooke Brewing Co., 20 C. C. A. 405; 74 Fed. Rep. 229.

3—Indurated Fibre Co. v. Amoskeag Indurated Fibre Ware Co., 37 Fed. Rep. 695.

4—Bennet v. McKinley, 65 Fed. Rep. 505; 13 C. C. A. 25.

5—Kohler v. Sanders, 122 N. Y. 65; affirming s. c., 48 Hun. 48.

6—*In re* Western Electric Co., 39 App. D. C. 420.

7—Brown Chem. Co. v. Stearns, 37 Fed. Rep. 36; Brown Chem. Co. v. Meyer, 139 U. S. 540; Cox, Manual, 726; 35 L. Ed. 247.

8—*In re* Rader, 13 Off. Gaz. 596.

9—*In re* Johnson, 2 Off. Gaz. 315.

10—Godillot v. Hazzard, 81 N. Y. 263.

11—Luyties v. Hollender, 30 Fed. Rep. 632. Per *contra*, see Kaiserbrauerei v. Baltz Brewing Co., 71 Fed. Rep. 695; affirmed in J. & P. Baltz Brew. Co. v. Kaiserbrauerei, Beck & Co., 20 C. C. A. 402; 74 Fed. Rep. 222.

12—Florence Mfg. Co. v. Dowd, 171 Fed. Rep. 122; 178 Fed. Rep. 73; 101 C. C. A. 565 (C. C. A. 2).

Claimed as Trademark.	*Class of Goods.*
"Kentucky Club,"	whiskey.[13]
"Kid Nee Kure,"	medicine.[14]
"Kidney & Liver,"	bitters.[15]
"Lackawanna,"	coal.[16]
"Lake,"	glass product.[17]
"La Normandi,"	cigars.[18]
"Liebig's Extract of Meat,"	meat extract made under Liebig's formula.[19]
"Lieutenant James' Horse Blister,"	ointment.[20]
"Linoleum,"	floor-cloth.[21]
"Loch Katrine,"	whiskey.[22]
"London Shop,"	trading name.[23]
"Magnolia,"	alloy metal.[24]
"Malted Milk,"	infants' food.[25]
"Marshall's Celebrated,"	liniment.[26]
"Marshall Erecting,"	engines.[27]

13—Davies County Distilling Co. v. Martinoni, 117 Fed. Rep. 186.

14—*Ex parte* Henderson, 85 Off. Gaz. 453.

15—Spieker v. Lash, 102 Cal. 38; 36 Pac. Rep. 362.

16—Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311; 20 L. Ed. 581.

17—Stokes v. Landgraff, 17 Barb. 608; Cox, Am. Tr. Cas. 137.

18—Stuchelberg v. Ponce, 128 U. S. 686; 32 L. Ed. 569; affirming 23 Fed. Rep. 430.

19—Liebig's Extract of Meat Co. (Ltd.) v. Hanbury, 17 L. T. N. S. 298; Anderson v. Liebig's Extract of Meat Co. (Ltd.), 45 L. T. 757; Cartmell, 47; Liebig's Extract of Meat Co. v. Libby, McNeill & Libby, 103 Fed. Rep. 87; Liebig's Extract of Meat Co. v. Walker, 115 Fed. Rep. 822.

20—James v. James, L. R. 13 Eq. 421; 41 L. J. Ch. 353; 26 L. T. N. S. 568; 20 W. R. 434; Seb. 388.

21—Linoleum Mfg. Co. v. Nairn, L. R. 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. N. S. 448; 26 W. R. 463; Seb. 536.

22—Bulloch, Lade & Co. v. Gray, 19 Jour. Juris. 218; Seb. 452.

23—Rosenthal v. Blatt (N. J. Ch.), 83 Atl. Rep. 387.

24—Magnolia Metal Co.'s Trademarks, 66 L. J. Ch. N. S. 312.

25—*Ex parte* Horlick's Food Co., 84 Off. Gaz. 1870; Horlick's Food Co. v. Elgin Milkine Co., 56 C. C. A. 544; 120 Fed. Rep. 264.

26—Marshall v. Pinkham, 52 Wis. 572.

27—Marshal Engine Co. v. New Marshall Engine Co., 89 N. E. Rep. 548; 203 Mass. 410.

Claimed as Trademark.	*Class of Goods.*
"Maryland Club Rye,"	whiskey.[28]
"Masonic,"	cigars.[29]
"Matzoon,"	fermented milk.[30]
"Medicated Prunes,"	medicine.[31]
"Metallic Clinton,"	paint.[32]
"Microbe Killer,"	antiseptic.[33]
"Moline,"	plows.[34]
"Montserrat,"	lime juice.[35]
"Mountain Dew,"	whiskey.[36]
"Muffler,"	neck scarfs.[37]
"Naphtha,"	soap.[38]
"National Sperm,"	candles.[39]
"Native Guano,"	fertilizer.[40]
"New Manny,"	harvester.[41]
"New York,"	glass products.[42]
"Nonfluid,"	oil.[43]
"No sag,"	handbags.[44]

28—Cahn v. Hoffman House, 28 N. Y. Supp. 388. *Contra*, see Cahn v. Gottschalk, 2 N. Y. Supp. 13.

29—*Ex parte* Smith (3), 16 Off. Gaz. 764.

30—Dadirrian v. Yacubian, 72 Fed. Rep. 1010; Dadirrian v. Yacubian (2), 90 Fed. Rep. 812. But see Dr. Dadirrian & Sons Co. v. Hauenstein, 74 N. Y. Supp. 709.

31—*Ex parte* Smith (2), 16 Off. Gaz. 679.

32—Clinton Metallic Paint Co. v. New York Metallic Paint Co., 50 N. Y. Supp. 437.

33—Alff v. Radam, 77 Tex. 530.

34—Candee, Swan & Deere v. Deere & Co., 54 Ill. 439; 5 Amer. Rep. 125.

35—Evans v. Von Laer, 32 Fed. Rep. 153.

36—Chas. Dennehy & Co. v. Robertson, Sanderson & Co., 32 App. D. C. 355.

37—Hygienic Fleeced Underwear Co. v. Way, 70 C. C. A. 553; 137 Fed. Rep. 592 (C. C. A. 3); reversing 133 Fed. Rep. 245.

38—Fels v. Hedley, 20 Times L. R. 69.

39—*In re* Price's Patent Candle Co., L. R. 27 Ch. D. 681.

40—Native Guano Co. v. Sewage Manure Co., 8 P. R. 125.

41—*In re* Graham, 2 Off. Gaz. 618.

42—Stokes v. Landgraff, 17 Barb. 608; Cox, Am. Tr. Cas. 137.

43—New York & New Jersey Lubricant Co. v. Young, 77 N. J. Eq. 321; 77 Atl. Rep. 344; New York & New Jersey Lubricant Co. v. O. W. Young (N. J. Ch.), 94 Atl. Rep. 570.

44—*In re* Freund Bros. & Co., 37 App. D. C. 109.

Claimed as Trademark.	*Class of Goods.*
"Nourishing London,"	stout.[45]
"No Wash Up,"	cleansing preparation.[46]
"Old Bourbon,"	whiskey.[47]
"Old Country,"	soap.[48]
"Old Innishowen,"	whiskey.[49]
"Old Lexington Club,"	whiskey.[50]
"Old London Dock,"	gin.[51]
"Olive,"	bicycles having olive-colored frames.[52]
"Orange Grove,"	flour.[53]
"Orient,"	typewriter supplies.[54]
"Oriental Cream,"	cosmetic lotion.[55]
"Owl Creek,"	coal.[56]
"Paraffin,"	oil.[57]
"Parcheesi,"	game, invalid because a mere variation of the Hindoostanee name for the same game.[58]
"Parson's Purgative,"	pills.[59]
"Perfect Face Paste,"	medicine.[60]

45—Raggett v. Findlater, L. R. 17 Eq. 29; 43 L. J. Ch. 64; 29 L. T. N. S. 448; 22 W. R. 53; Seb. 431.

46—Ault & Wyborg Co. v. Cheshire, 191 Fed. Rep. 741.

47—Hardy v. Cutter, 3 Off. Gaz. 468.

48—Allen B. Wrisley Co. v. Iowa Soap Co., 104 Fed. Rep. 548; Allen B. Wrisley Co. v. Iowa Soap Co., 59 C. C. A. 54; 122 Fed. Rep. 196.

49—Watt v. O'Hanlon, 4 P. R. I.

50—Kentucky Distilleries & Warehouse Co. v. Old Lexington Club Dist. Co., 31 App. D. C. 223.

51—Binninger v. Wattles, 28 How. Pr. 206.

52—*Ex parte* Olive Wheel Co., 84 Off. Gaz. 1871.

53—H. Becker & Co. v. C. A. Gambrill Mfg. Co., 38 App. D. C. 535.

54—*In re* Crescent Typewriter Supply Co., 30 App. D. C. 324.

55—*In re* Hopkins, 29 App. D. C. 118.

56—Esseylstyn v. Holmes, 114 Pac. Rep. 118; 42 Mont. 507.

57—Young v. Macrae, 9 Jur. N. S. 322.

58—Selchow v. Chaffee & Selchow Mfg. Co., 132 Fed. Rep. 996; appeal dismissed, 72 C. C. A. 683; 140 Fed. Rep. 989. For the preliminary order, see 118 Fed. Rep. 1023.

59—*In re* Johnson, 2 Off. Gaz. 315.

60—*Ex parte* Rall, 85 Off. Gaz. 453.

Claimed as Trademark.	*Class of Goods.*
"Philadelphia,"	beer.[61]
"Pocahontas,"	coal.[62]
"Pocono,"	garage.[63]
"Pork Roll,"	pork manufactured product.[64]
"Post Office,"	directory.[65]
"Porous,"	medicinal plasters.[66]
"Prime Leaf,"	lard.[67]
"Princess," (because common to the trade),	shirt waists.[68]
"Prize Medal, 1862,"	on goods sold by one awarded a medal at the London International Exhibition of 1862.[69]
"Purity,"	oleomargerine.[70]
"Quaker City,"	cereal products.[71]
"Red,"	snuff.[72]
"Rexall,"	blood purifier.[73]
"Richardson's Patent Union,"	leather splitting machine.[74]
"Rose,"	vanilla extract.[75]

61—Eggers v. Hink, 63 Cal. 445.

62—Coffman v. Castner, 87 Fed. Rep. 457; 31 C. C. A. 55; affirmed in Castner v. Coffman, 178 U. S. 168; 44 L. Ed. 1021, and overruling Atwater v. Castner, 32 C. C. A. 77; 88 Fed. Rep. 642.

63—Pocono Pines Assembly v. Miller, 77 Atl. Rep. 1094; 229 Pa. 33.

64—Taylor Provision Co. v. Gobel, 180 Fed. Rep. 938.

65—Kelly v. Byles, 40 L. T. 623.

66—*In re* Brandreth, Seb. 626.

67—Popham v. Wilcox, 66 N. Y. 69.

68—Spiegel v. Zuckerman, 175 Fed. Rep. 979; affirmed, 110 C. C. A. 133; 188 Fed. Rep. 63.

69—Batty v. Hill, 1 H. & M. 264; 8 L. T. N. S. 791; 11 W. R. 745; 2 N. R. 265; Seb. 218.

70—*Ex parte* Capitol City Dairy Co., 83 Off. Gaz. 295.

71—Quaker City Flour Mills Co. v. Quaker Oats Co., 43 App. D. C. 260.

72—*Ex parte* Pearson Tobacco Co., 85 Off. Gaz. 295.

73—Theodore Rectanus Co. v. United Drug Co., 226 Fed. Rep. 545 (C. C. A. 6); compare Regis v. Jaynes, 77 N. E. Rep. 774; 191 Mass. 245; see "Rexall," § 48.

74—*In re* Richardson, 3 Off. Gaz. 120.

75—Clotworthy v. Schepp, 42 Fed. Rep. 62.

Claimed as Trademark.	*Class of Goods.*
"Rosendale,"	cement.[76]
"Rubberset,"	brushes, bristles set in rubber.[77]
"Ruberoid,"	waterproof roofing.[78]
"Rye and Rock,"	liquor.[79]
"Safety,"	explosive powder.[80]
"Sanitary,"	filter.[81]
"Sarsaparilla and Iron,"	tonic.[82]
"Satinine,"	starch and soap.[83]
"Satin Polish,"	boots and shoes.[84]
"Schiedam Schnapps,"	liquor.[85]
"Security,"	tires.[86]
"Selected Shore,"	mackerel.[87]
"Self-Loading,"	cartridges.[88]
"She,"	cigars.[89]

76—New York Cement Co. v. Coplay Cement Co. (1), 44 Fed. Rep. 277; New York Cement Co. v. Coplay Cement Co. (2), 45 Fed. Rep. 212.

77—Rubber & Celluloid H. T. Co. v. F. W. Devoe & C. T. Reynolds Co., 223 Fed. Rep. 150, 153.

78—Standard Paint Co. v. Trinidad Asphalt Co., 220 U. S. 446; 55 L. Ed. 536; affirming Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 90 C. C. A. 195; 163 Fed. Rep. 977.

79—Van Beil v. Prescott, 82 N. Y. 630.

80—*Ex parte* Safety Powder Co., 16 Off. Gaz. 136.

81—*In re* Atkins Filter Co., 3 P. R. 164.

82—Schmidt v. Brieg, 100 Cal. 672; Same v. McEwen, 35 Pac. Rep. 854; Same v. Crystal Soda Water Co., *Id.* 855; Same v. Steinke, *Id.*, 855; Same v. Haake, *Id.*, 855; Same v. Liberty Soda Works Co., *Id.*, 856.

83—*In re* Meyerstein, 7 R. P. C. 114; L. R. 43 Ch. D. 604; 59 L. J. Ch. 401; 62 L. T. 526; 38 W. R. 440; Cartmell, 225.

84—*Ex parte* Brigham, 20 Off. Gaz. 891.

85—Wolfe v. Goulard, 18 How. Pr. 64; Seb. 179; Cox, Am. Tr. Cas. 226; Burke v. Cassin, 45 Cal. 467; Wolfe v. Hart, 4 V. L. R. Eq. 125; Wolfe v. Alsop, 10 V. L. R. Eq. 41; 12 V. L. R. 421; Wolfe v. Lang, 13 V. L. R. 752.

86—Buffalo Rubber Mfg. Co. v. Batavia Rubber Co., 153 N. Y. S. 779.

87—Trask Fish Co. v. Wooster, 28 Mo. App. 408.

88—Winchester Repeating Arms Co. v. Peters Cartridge Co., 30 App. D. C. 505.

89—(A stock label case). Sartor v. Schaden, 101 N. W. Rep. 511; 125 Iowa, 696.

Claimed as Trademark.	*Class of Goods.*
"Shredded Whole Wheat,"	cereal product.[90]
"Singer,"	sewing machines, after expiration of the Singer patents.[91]
"Snowflake,"	crackers, the word being descriptive of the quality of flour used.[92]
"Somatose,"	meat extract, from the Greek, "soma," Angl. "body," genitive, "somatos."[93]
"Spearmint,"	chewing gum flavored with spearmint.[94]
"Splendid,"	flour.[95]
"Stage,"	playing cards.[96]
"Standard,"	phonographs.[97]
"Standard A,"	cigars.[98]
"Star,"	condensed milk.[99]
"Steel Shod,"	shoes having soles quilted with steel wire.[1]
"Sterling,"	ale.[2]
"Stoga Kip,"	boots.[3]
"Straight-Cut,"	cigarettes.[4]

90—Natural Food Co. v. Williams, 30 App. D. C. 348.

91—Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169; 41 L. Ed. 118.

92—Larrabee v. Lewis, 67 Ga. 561; 44 Am. Rep. 735.

93—Farben-fabriken T. M. K., 7 R. P. C. 439; L. R. (1894) 1 Ch. 645.

94—Wm. Wrigley, Jr., & Co. v. Grove Co., 161 Fed. Rep. 885; affirmed in 183 Fed. Rep. 99; 105 C. C. A. 391 (C. C. A. 2). See also Wm. Wrigley, Jr., & Co. v. Norris, 34 App. D. C. 138.

95—*Ex parte* Stokes, 64 Off. Gaz. 437.

96—United States Playing Card Co. v. C. M. Clark Pub. Co., 30 App. D. C. 208.

97—*In re* National Phonograph Co., 29 App. D. C. 142.

98—*Ex parte* Cohn (1), 16 Off. Gaz. 680.

99—Michigan Condensed Milk Co. v. Kenneweg Co., 30 App. D. C. 491.

1—Brennan v. Emery-Bird-Thayer Dry Goods Co., 99 Fed. Rep. 971; s. c. 108 Fed. Rep. 624; 47 C. C. A. 532.

2—Worcester Brewing Corp. v. Reuter & Co., 84 C. C. A. 665; 157 Fed. Rep. 217.

3—Walker v. Reid, Fed. Case No. 17,084.

4—Ginter v. Kinney, 12 Fed. Rep. 782.

Claimed as Trademark.	*Class of Goods*
"Stud,"	buttons.[5]
"Svenska Snusmaganiset,"	meaning Swedish snuff store.[6]
"Sweet Lotus,"	tobacco.[7]
"Swing,"	scythe-sockets.[8]
"Syphon,"	refrigerators.[9]
"TABASCO,"	pepper sauce.[10]
"Taffy Tolu,"	chewing-gum.[11]
"Tasteless,"	drugs.[12]
"Thermogene,"	cotton wadding.[13]
"Thomsonian,"	medicines.[14]
"Timekeeper,"	watches.[15]
"Tipo,"	wine.[16]
"Toothache Gum,"	remedy for toothache.[17]
"Traveler's,"	insurance company.[18]
"Trophy,"	coffee.[19]
"Tycoon,"	tea.[20]
"Tucker Spring,"	bed.[21]

5—Greene, Tweed & Co. v. Manufacturers' Belt Hook Co., 158 Fed. Rep. 640.

6—Bolander v. Peterson, 136 Ill. 215.

7—Wellman & Dwire Tob. Co. v. Ware Tob. Works, 46 Fed. Rep. 289.

8—*Ex parte* Thompson, Derby & Co., 16 Off. Gaz. 137.

9—Seeger Refrigerator Co. v. White Enamel Refrigerator Co., 178 Fed. Rep. 567.

10—New Iberia Extract of Tabasco Pepper Co. v. E. McIlhenny's Son, 61 So. Rep. 131; 132 La. 149; following the decision of the Court of Appeals, D. C., in McIlhenny v. New Iberia Extract of Tabasco Pepper Co., 34 App. D. C. 430.

11—Colgan v. Dauheiser, 35 Fed. Rep. 150.

12—*In re* Dick & Co., 9 Off. Gaz. 538.

13—Thermogene Co. v. Thermozine Co., 225 Fed. Rep. 446.

14—Thompson v. Winchester, 36 Mass. 214.

15—*Ex parte* Strasburger & Co., 20 Off. Gaz. 155.

16—Italian Swiss Colony Co. v. Italian Vineyard Co., 158 Cal. 252; 110 Pac. Rep. 913.

17—Devlin v. McLeod, 135 Fed. Rep. 164; Devlin v. Peck, 135 Fed. Rep. 167.

18—Traveler's Insurance Machine Co. v. Traveler's Insurance Co., 134 S. W. Rep. 877; 142 Ky. 523; judgment modified in 136 S. W. Rep. 154; 143 Ky. 216.

19—*In re* Meyer Bros. Coffee & Spice Co., 38 App. D. C. 520.

20—Corbin v. Gould, 133 U. S. 308; 33 L. Ed. 611.

21—Tucker Mfg. Co. v. Boyington, 9 Off. Gaz. 455, Fed. Case No. 14,229.

Claimed as Trademark	*Class of Goods.*
"Union,"	tobacco packages.[22]
"United States,"	dental rooms.[23]
"Vacuum Cup,"	tires.[24]
"Vacuum Tread,"	tires.[25]
"Valvolene,"	oil.[26]
"Vertical Top,"	cigar molds.[27]
"Victoria,"	lozenges.[28]
"Vitae-Ore,"	medicine.[29]
"V-O,"	medicine.[30]
"Water of Ayr,"	stone.[31]
"Webster's Dictionary,"	applied to the standard lexicon of that name.[32]
"Whirling Spray,"	syringes.[33]
"White Swan,"	flour.[34]
"Wire,"	glass.[35]
"Wister's Balsam of White Cherry,"	medicine.[36]
"Worcestershire,"	sauce.[37]
"Yale,"	locks.[38]

22—American Tobacco Co. v. Globe Tobacco Co., 193 Fed. Rep. 1015.

23—Cady v. Schultz, 19 R. I. 193; 61 Am. St. Rep. 763.

24—Pennsylvania Rubber Co. v. Dreadnaught Tire & Rubber Co., 225 Fed. Rep. 138.

25—Pennsylvania Rubber Co. v. Dreadnaught Tire & Rubber Co., 225 Fed. Rep. 138.

26—*In re* Horsburgh, 53 L. J. Ch. 237.

27—Sternberg Mfg. Co. v. Miller, Du Brul & Peters Mfg. Co., 88 C. C. A. 398; 161 Fed. Rep. 318 (C. C. A. 8).

28—Wotherspoon v. Gray, Ct. Sess. Cas. (3rd ser.) 2, 38.

29—Noel v. Ellis, 89 Fed. Rep. 978-981.

30—Noel v. Ellis, 89 Fed. Rep. 978-981.

31—Montgomerie v. Donald, Ct. Sess. Cas. (4th ser.) 11,506.

32—Merriam v. Texas Siftings Pub. Co., 49 Fed. Rep. 944-947.

33—Marvel Co. v. Pearl, 133 Fed. Rep. 160, 162; 66 C. C. A. 226.

34—Bulte v. Iglehart Bros., 137 Fed. Rep. 492; 70 C. C. A. 76.

35—Mississippi Wire Glass Co. v. Continuous Glass Press Co., 81 Atl. Rep. 374; 79 N. J. Eq. 277.

36—Towle v. Spear, 7 Penn. L. J. 176; Cox, Am. Tr. Cas. 67; Seb. 90.

37—Lea v. Deakin, 11 Biss. 23, Fed. Cas. No. 8,154; Lea v. Wolff, 15 Abb. Pr. N. S. 1; 46 How. Pr. 157; Seb. 407; Lea v. Millar, Seton (4th Ed.), 242; Seb. 513.

38—*Ex parte* Yale & Towne Mfg. Co., 81 Off. Gaz. 801.

§ 48. Examples of valid trademarks, fancy, arbitrary or distinctive words.—The following instances are illustrative of fancy, arbitrary or distinctive words, which have been either held properly protected against unfair competition, or their use upheld as trademarks in application to the classes of merchandise in connection with which the words have respectively been used. In some cases the question of validity was not raised, nor are all of them to be upheld as technical trademarks. These illustrations are given in their alphabetical order to facilitate reference.

Claimed as Trademark.	*Class of Goods.*
"Yucatan,"	leather and leather goods.[39]
"888,"	telephone number for trouble department.[40]
"Abricotine,"	liqueur.[41]
"Ainsworth,"	thread.[43]
"Alderney,"	oleomargerine.[44]
"Alpenkrauter,"	blood remedy.[45]
"American Cold Japan,"	paint.[46]
"American Express,"	sealing wax.[47]
"American Girl,"	shoes.[48]
"American Volunteer,"	shoes.[49]
"Anatolia,"	licorice.[50]

39—*Ex parte* Weil, 83 Off. Gaz. 1802.

40—Rocky Mountain Bell Telephone Co. v. Utah Independent Telephone Co., 88 Pac. Rep. 26; 31 Utah, 377.

41—Garnier v. Rossman, 195 Fed. Rep. 175; affirmed, Rossmann v. Garnier, 211 Fed. Rep. 401; 128 C. C. A. 73 (C. C. A. 8).

43—Ainsworth v. Walmesley, 44 L. R. 1 Eq. 518.

44—Lauferty v. Wheeler, 11 Abb. N. C. 220; 11 Daly, 194; 63 How. Pr. 488.

45—Dr. Peter H. Fahrney & Sons Co. v. Ruminer, 153 Fed. Rep. 735; 82 C. C. A. 621 (C. C. A. 7).

46—Reeder v. Brodt, 6 Ohio Dec. 248; 4 Ohio N. P. 265.

47—Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651-653.

48—Hamilton Brown Shoe Co. v. Wolf Bros. & Co., 240 U. S. 251; 60 L. Ed. —.

49—Joseph Banigan Rubber Co. v. Bloomingdale, 89 Off. Gaz. 1670.

50—McAndrew v. Bassett, 4 DeG. J. & S. 380; 33 L. J. Ch. 566; 10 Jur. N. S. 550; 10 L. T. N. S. 442; 12 W. R. 777; 4 N. R. 123; Cox, 669. Anatolia is a geographical name, but its use here was protected on the theory of unfair competition.

Claimed as Trademark.	*Class of Goods.*
"Anchor Brand,"	wire.[51]
"Angostura,"	bitters.[52]
"A. N. Hoxie's Mineral,"	soap.[53]
"Annihilator,"	medicine.[54]
"Anti-Wash-board,"	soap.[55]
"Apollinaris,"	mineral water.[56]
"Argyrol,"	antiseptic.[57]
"Atlas,"	corporate name of insurance company.[58]
"Auburn Lynn,"	shoes.[59]
"Auto,"	chocolate.[60]
"A. V. H.,"	gin.[61]
"Baco-Curo,"	remedy for tobacco habit.[62]
"B. B. B.,"	medicine.[63]
"B. B. H.," (with a crown),	iron.[64]
"Baffle,"	safes.[65]
"Balm of Thousand Flowers,"	cosmetic.[66]
"Bates,"	numbering machines.[67]

51—Edelsten v. Edelsten, 1 DeG. J. & S. 185; Cox, 667.

52—Siegert v. Gondolfi, 149 Fed. Rep. 100; 79 C. C. A. 142 (C. C. A. 2), reversing Siegert v. Gandolfi, 139 Fed. Rep. 917.

53—Hoxie v. Chaney, 143 Mass. 592.

54—Fulton v. Sellers, 4 Brewst. 42.

55—O'Rourke v. Central City Soap Co., 26 Fed. Rep. 567.

56—Apollinaris Co. v. Norrish, 33 L. T. N. S. 242; Same v. Moore, Cox, Manual, Case No. 675; Same v. Herrfeldt, 4 P. R. 478; Same v. Scherer, 27 Fed. Rep. 18.

57—Barnes v. Pierce, 164 Fed. Rep. 213.

58—Atlas Assurance Co. v. Atlas Insurance Co., 112 N. W. Rep. 232; 138 Iowa 228.

59—W. R. Lynn Shoe Co. v. Auburn-Lynn Shoe Co., 62 Atl. Rep. 499; 100 Me. 461.

60—Walter Baker & Co. v. Delapenha, 160 Fed. Rep. 746.

61—Van Hoboken v. Mohns & Kaltenbach, 112 Fed. Rep. 528.

62—Sterling Remedy Co. v. Eureka Chemical and Mfg. Co., 80 Fed. Rep. 105; 49 U. S. App. 709; 25 C. C. A. 314.

63—Foster v. Blood Balm Co., 77 Ga. 216, 3 S. E. Rep. 284.

64—Hall v. Barrows, 4 DeG. J. & S. 150; Cox, 668.

65—Talbot v. Webley, 3 R. P. C. 276; Cartmell, 324.

66—Fetridge v. Merchant, 4 Abb. Pr. 156.

67—Bates Mfg. Co. v. Bates Numbering Machine Co., 172 Fed. Rep. 892, 178 Fed. Rep. 681; 102 C. C. A. 181.

Claimed as Trademark.	*Class of Goods.*
"Beaded,"	lace tips.[68]
"Beatty's Headline,"	copy book.[69]
"Bell of Moscow."	wine.[70]
"Benedictine."	liqueur.[71]
"Best & Co., Lilliputian Bazaar,"	children's clothing store.[72]
"Bestyette,"	waterproof capes and clokes.[73]
"Bethesda,"	mineral water.[74]
"Billiken,"	dolls.[75]
"Bismark,"	paper collars.[76]
"Blackstone,"	cigars.[77]
"Blairstown,"	garage.[78]
"Blood Searcher,"	medicine.[79]
"Blue Lick,"	water.[80]
"Boker's Stomach Bitters,"	medicine.[81]
"Bonnie Rye,"	whiskey.[82]
"Bovilene."	pomade.[83]

68—United Lace & Braid Mfg. Co. v. Barthels Mfg. Co., 221 Fed. Rep. 456.

69—Gage v. Canada Publ. Co., 11 Can. Sup. Ct. 306; 6 Ont. Rep. 68; 11 Ont. App. 402.

70—*In re* Charles Narcisse Ferre, Cert. No. 8939.

71—Societe Anonyme v. Western Distilling Co., 43 Fed. Rep. 416; Societe Anonyme de la Distillerie de la Benedictine v. Micalovitch, Fletcher & Co., 36 Alb. Law J. 364; A. Bauer & Co. v. Distillerie de la Liqueur Benedictine, 56 C. C. A. 480; 120 Fed. Rep. 74.

72—Ball v. Broadway Bazaar, 87 N. E. Rep. 674; 194 N. Y. 429, reversing 106 N. Y. S. 249; 121 App. Div. 546.

73—New York Mackintosh Co. v. Flam, 198 Fed. Rep. 571.

74—Dunbar v. Glenn, 42 Wis. 118; Seb. 529.

75—Billiken Co. v. Baker & Bennet Co., 174 Fed. Rep. 829.

76—Messerole v. Tynberg, 4 Abb. Pr. N. S. 410; 36 How. Pr. 14; Cox, 479; Seb. 300.

77—Levy v. Waitt, 56 Fed. Rep. 1016.

78—Luff v. Wallace (N. J. Ch.), 93 Atl. Rep. 702.

79—Fulton v. Sellers, 4 Brewst. 42; Cox, Manual, Case No. 279.

80—Northcutt v. Turney, 101 Ky. 314; 41 S. W. Rep. 21; Parkland Hill Blue Lick Water Co. v. Hawkins, 26 S. W. Rep. 389; 95 Ky. 502; 16 Ky. Law Rep. 210; 44 Am. St. Rep. 254.

81—Funke v. Dreyfus, 34 La. Ann. 80; 44 Am. Rep. 413.

82—Bonnie & Co. v. Bonnie Bros. (Ky.), 169 S. W. Rep. 871.

83—Lockwood v. Bostwick, 2 Daly, 521.

Claimed as Trademark.	*Class of Goods.*
"Bovril,"	meat extract.[84]
"Bromidia,"	medicine.[85]
"Bromo-Caffeine,"	medicine.[86]
"Buster Brown,"	comic section of newspaper.[87]
"Carbolineum,"	paint.[88]
"Carmel,"	wine.[89]
"Carrom,"	game-board.[90]
"Cashmere Bouquet,"	toilet soap.[91]
"Celluloid,"	compound of pyroxyline.[92]
"Celery Compound,"	medicine.[93]
"Centennial,"	clothing.[94]
"Centennial,"	alcoholic spirits.[95]
"Ceresota,"	flour.[96]
"Champion,"	flour.[97]
"Chantecler,"	name of play.[98]
"Charley's Aunt,"	name of farce.[99]

84—*In re* Bovril, L. R. (1896) 2 Ch. D. 600.

85—Battle v. Finlay (2), 50 Fed. Rep. 106; Battle v. Finlay (1), 45 Fed. Rep. 796.

86—Keasbey v. Brooklyn Chemical Works, 37 N. E. Rep. 476; 142 N. Y. 467; reversing s. c., 21 N. Y. Supp. 696.

87—New York Herald Co. v. Star Co., 146 Fed. Rep. 1023, 76 C. C. A. 678 (C. C. A. 2).

88—Avenarius v. Kornely, 121 N. W. Rep. 336; 139 Wis. 247.

89—Jewish Colonization Ass'n v. Solomon & Germansky, 154 Fed. Rep. 157.

90—Luddington Novelty Co. v. Leonard, 119 Fed. Rep. 937; Williams v. Mitchell, 45 C. C. A. 265, 106 Fed. Rep. 168.

91—Colgate & Co. Cert. No. 914; Colgate v. Adams, 88 Fed. Rep. 899.

92—Celluloid Mfg. Co. v. Read, 47 Fed. Rep. 712; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94.

93—Wells & Richardson Co. v. Siegel, Cooper & Co., 106 Fed. Rep. 77.

94—Sternberger v. Thalheimer, 3 Off. Gaz. 120.

95—*In re* Bush & Co., 10 Off. Gaz. 164.

96—Northwestern Consolidated Milling Co. v. Mauser & Cressman, 162 Fed. Rep. 1004; Northwestern Consolidated Milling Co. v. Wm. Callam & Son, 177 Fed. Rep. 786.

97—Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 217; 27 Off. Gaz. 1322.

98—Frohman v. Morris, 123 N. Y. St. 1090; 68 Misc. Rep. 461.

99—Frohman v. Miller, 29 N. Y. S. 1109; 8 Misc. Rep. 379.

Claimed as Trademark.	*Class of Goods.*
"Charter Oak,"	stoves.[1]
"Chartreuse,"	liqueur.[2]
"Chatterbox,"	juvenile books, published periodically.[3]
"Chicago Waists."	corset waists.[4]
"Chicken Cock,"	whiskey.[5]
"Chinese Liniment,"	liniment.[6]
"Climax,"	stoves.[7]
"Club,"	cocktails.[8]
"Club Cocktails,"	cocktails.[9]
"Club Soda,"	carbonated water.[10]
"Coal Oil Johnny's Petroleum,"	soap.[11]
"Cocoaine,"	hair oil.[12]
"Coe's Superphosphate of Lime,"	fertilizer.[13]
"Cohesive,"	tile.[14]
"Comfort,"	periodical publication.[15]
"Compactum."	umbrellas.[16]

1—Filley v. Fassett, 44 Mo. 173; 100 Am. Dec. 275; Cox, Am. Tr. Cas. 530; 9 Am. L. Reg. N. S. 402; Seb. 313; Filler v. Child, 16 Batchf. 376.

2—Baglin v. Cusinier Co., 221 U. S. 580; 55 L. Ed. 863; Rey v. Lecouturier, L. R. (1908) 2 Ch. 726.

3—Estes v. Leslie, 29 Fed. Rep. 91; Estes v. Worthington, 31 Fed. Rep. 154; Estes v. Leslie, 27 Fed. Rep. 22; Fed. Case No. 4787.

4—Gage-Downs Co. v. Featherbone Corset Co., 83 Fed. Rep. 213.

5—G. G. White Co. v. Miller, 50 Fed. Rep. 277.

6—Coffeen v. Brunton, 4 McLean 516; 5 McLean 256.

7—Filley v. Fassett, 44 Mo. 173.

8—Heublein v. Adams, 125 Fed. Rep. 782.

9—*In re* S. C. Herbst Importing Co., 30 App. D. C. 297.

10—Cochrane v. Macnish (P. C.) L. R. (1896) A. C. 225; 65 L. J. P. C. N. S. 20; 74 Law T. R. 109.

11—Petrolia Mfg. Co. v. Bell & Bogart Soap Co., 97 Fed. Rep. 781.

12—Burnett v. Phalon, 3 Keyes, 594; 5 Abb. Pr. N. S. 212; 9 Bos. 193.

13—Bradley v. Norton, 33 Conn. 157; Cox's American Trademark Cases 331; 87 Am. Dec. 200.

14—R. Guastavino Co. v. Comerma, 184 Fed. Rep. 549.

15—Gannert v. Rupert, 127 Fed. Rep. 962, 62 C. C. A. 594, reversing s. c. 119 Fed. Rep. 221.

16—*In re* Davis Trademarks, 22 Trademark Record, 50.

Claimed as Trademark.	*Class of Goods.*
"Computing Cheese Cutter,"	machine.[17]
"Congress Water,"	mineral water.[18]
"Coon,"	molasses.[19]
"Cottolene,"	lard substitute.[20]
"Cough Cherries,"	confectionery.[21]
"Cream,"	baking powder.[22]
"Creamalt,"	bread.[23]
"Crow,"	whiskey.[24]
"Crown,"	baking products.[25]
"Cuticura,"	toilet soap.[26]
"Delsarte,"	shoes.[27]
"Derringer,"	fire arms.[28]
"Dominion,"	hotel.[29]
"Don Carlos,"	olives.[30]

17—(Strictly an unfair competition case). Computing Cheese Cutter Co. v. Dunn, 45 Ind. App. 20, 88 N. E. Rep. 93.

18—Congress, etc. Spring Co. v. High Rock Congress Spring Co., 57 Barb. 526; Cox, 599; 45 N. Y. 291; 10 Abb. P. R. N. S. 348; 6 Am. Rep. 82; 4 Am. L. T. 168; Cox, Am. Tr. Cas. 624; Seb. 354.

19—Western Grocer Co. v. Caffarelli Bros. (Tex. Civ. App.) 108 S. W. Rep. 413 (not officially reported); reversed on other grounds in Caffarelli Bros. v. Western Grocer Co., 127 S. W. Rep. 1018; 102 Tex. 104.

20—N. K. Fairbank Co. v. Central Lard Co., 64 Fed. Rep. 133; N. K. Fairbank Co. v. Ogden Packing & Provision Co., 220 Fed. Rep. 1002.

21—Stoughton v. Woodard, 39 Fed. Rep. 902.

22—Price Baking Powder Co. v. Fyfe, 45 Fed. Rep. 799; International Food Co. v. Price Baking Powder Co., 33 App. D. C. 137.

23—Geo. G. Fox Co. v. Glynn, 78 N. E. Rep. 89; 191 Mass. 344.

24—W. A. Gaines & Co. v. Rock Spring Dis. Co., 141 C. C. A. 287, 226 Fed. Rep. 531.

25—Virginia Baking Co. v. Southern Biscuit Works, 68 S. E. Rep. 261, 111 Va. 227.

26—Potter Drug & Chem. Co. v. Miller, 75 Fed. Rep. 656. Held infringed by the word "curative" and imitative devices. The mark assumed to be valid in Potter Drug & Chem. Corp. v. Pasfield Soap Co., 102 Fed. Rep. 490; Same v. Same, 106 Fed. Rep. 914, 46 C. C. A. 40.

27—Medlar & Holmes Shoe Co. v. Delsarte Mfg. Co., N. J. Eq., 46 Atl. Rep. 1089, affirmed, N. J. Eq., 61 Atl. Rep. 410.

28—Derringer v. Plate, 29 Cal. 292; Cox, Am. Tr. Cas. 324.

29—O'Grady v. McDonald, 66 Atl. Rep. 175, 72 N. J. Eq. 805.

30—(But held not infringed by "Don Caesar"). Chance v. Gulden, 165 Fed. Rep. 624; 92 C. C. A. 58 (C. C. A. 3), reversing Gulden v. Chance, 163 Fed. Rep. 447.

Claimed as Trademark.	*Class of Goods.*
"Dr. Drake's German Croup Remedy,"	medicine.[31]
"Dr. Lobenthal's Essentia Antiphthisica,"	medicine.[32]
"Dublin,"	soap.[33]
"Durham,"	smoking tobacco.[34]
"Dyspepticure,"	medicine.[35]
"Edelweiss,"	perfume.[36]
"Elastic,"	bookcases.[37]
"Electro-Silicon,"	polishing preparation.[38]
"Elk,"	cigars.[39]
"Emollia,"	toilet cream.[40]
"Empire,"	stoves.[41]
"Epicure,"	canned salmon.[42]
"Ethiopian,"	stockings.[43]
"Eureka,"	fertilizer.[44]
"Eureka,"	shirts.[45]
"Eureka,"	fire hose.[46]
"Eureka,"	pressing boards.[47]

31—Drake Medicine Co. v. Glessner, 68 Ohio St. 337, 67 N. E. Rep. 722.

32—*In re* Rohland, 10 Off. Gaz. 980.

33—*In re* Cornwall & Co., 12 Off. Gaz. 312.

34—Blackwell v. Armistead, Fed. Case No. 1474, 5 Am. L. T. 85; 3 Hughes, 163; Armistead v. Blackwell, 1 Off. Gaz. 603; Blackwell v. Dibrell, 14 Off. Gaz. 633, Fed. Case No. 1475; Blackwell v. Wright, 73 N. C. 310.

35—*Ex parte* Foley & Co., 87 Off. Gaz. 1957.

36—Rosing v. Atkinson, 27 Sol. J. 534.

37—Globe-Wernicke Co. v. Brown, 121 Fed. Rep. 185

38—Electro-Silicon Co. v. Hazard, 29 Hun. 369; 36 N. Y. Sup. Ct. 369.

39—Lichtenstein v. Goldsmith, 37 Fed. Rep. 359.

40—*In re* Grossmith, 60 L. T. N. S. 612.

41—Filley v. Fassett, 44 Mo. 173; Seb. 313.

42—George v. Smith, 52 Fed. Rep. 830.

43—Hine v. Lart, 10 Jur. 106; 7 L. T. O. S. 41; Seb. 80.

44—Alleghany Fertilizer Co. v. Woodside, 1 Hughes 115; Seb. 364.

45—Ford v. Foster, L. R. 7 Ch. D. 611; 41 L. J. Ch. 682; 27 L. T. N. S. 219; 20 W. R. 818; Seb. 384.

46—Eureka Fire Hose Co. v. Eureka Rubber Mfg. Co., 69 N. J. Eq. 159; 60 Atl. Rep. 561; 72 N. J. Eq. 555, 65 Atl. Rep. 870; affirmed in 71 Atl. Rep. 1134, 71 N. J. Eq. 300.

47—Case v. Murphey, 31 App. D. C. 245.

Claimed as Trademark.	*Class of Goods.*
"Eureka,"	steam-packing.[48]
"Excelsior,"	stoves,[49]
"Excelsior,"	soap.[50]
"Excelsior,"	step ladders.[51]
"Faber,"	pencils.[52]
"Family,"	salve.[53]
"Favorita,"	flour.[54]
"Fibre Chamois,"	dress linings.[55]
"Filofloss,"	silk.[56]
"Filtre Rapide,"	filters.[57]
"Finney's Famous,"	orchestra.[58]
"Foutz,"	animal remedies.[59]
"Freemont Undertaking Co.,"	corporate name.[60]
"G. J. G.,"	automobiles.[61]
"Glenfield,"	starch.[62]
"Glenfield,"	washing powder.[63]
"Golden Crown,"	cigars.[64]
"Golden Wedding,"	whiskey.[65]

48—Symonds v. Greene, 28 Fed. Rep. 834.

49—Filley v. Fassett, 44 Mo. 173; Seb. 313; Sheppard v. Stuart, 13 Phila. 117.

50—Braham v. Bustard, 1 H. & M. 447, 9 L. T. N. S. 199.

51—Udell-Predock Mfg. Co. v. Udell Works, 32 App. D. C. 282.

52—Faber v. Faber, 49 Barb. 357; 3 Abb. Pr. N. S. 115; Cox, Am. Tr. Cas. 401.

53—Reinhart v. Spaulding, 49 L. J. Ch. 57.

54—Menendez v. Holt, 128 U. S. 514; 32 L. Ed. 526; Cox, Manual, Case No. 707.

55—American Fibre Chamois Co. v. De Lee, 67 Fed. Rep. 329; 71 Off. Gaz. 1458.

56—Rawlinson v. Brainard & Armstrong Co., 59 N. Y. Supp. 880; 28 Misc. Rep. 287.

57—*In re* Maignen's Application, 28 W. R. 759; Cartmell, 216.

58—Finney Orchestra v. Finney's Famous Orchestra, 126 N. W. Rep. 198, 161 Mich. 289.

59—David E. Foutz Co. v. S. A. Foutz Stock Food Co., 163 Fed. Rep. 408.

60—Rosenburg v. Freemont Undertaking Co., 114 Pac. Rep. 886; 63 Wash. 52.

61—G. & J. Tire Co. v. G. J. G. Motor Car Co., 39 App. D. C. 508.

62—Wotherspoon v. Currie, L. R. 5 H. L. 508; 42 Law J. Ch. 130; 27 L. T. N. S. 393.

63—N. K. Fairbank Co. v. Luckel, etc. Soap Co., 88 Fed. Rep. 694.

64—Palmer v. Harris, 60 Pa. St. 156.

65—Pontefract v. Isenberger, 106 Fed. Rep. 499.

Claimed as Trademark.	*Class of Goods.*
"Gouraud's Oriental Cream."	cosmetic.[66]
"Grand Master,"	cigars.[67]
"Green Mountain,"	scythe-stones.[68]
"Green River,"	whiskey.[69]
"Grenade,"	syrup.[70]
"Guastavino Tile,"	arches.[71]
"Hanford's Chestnut Grove,"	whiskey.[72]
"Hansa,"	lard, sausages and bacon.[73]
"Harvard Classics,"	set of selected books.[74]
"Heliotype,"	prints.[75]
"Hero,"	jars.[76]
"High Standard,"	paints and varnishes.[77]
"H. M.,"	plumbers' supplies.[78]
"Holeproof,"	hosiery.[79]
"Home,"	sewing machines.[80]
"Hoosier,"	drills.[81]
"Howqua's Mixture,"	tea.[82]
"Hunter,"	whiskey.[83]

66—Gouraud v. Trust, 10 N. Y. Sup. Ct. 627.

67—Yale Cigar Mfg. Co. v. Yale, 30 Off. Gaz. 1183.

68—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

69—Lang v. Green River Dist. Co., 33 App. D. C. 506.

70—Rillet v. Carlier, 61 Barb. 435.

71—R. Guastavino Co. v. Comerma, 180 Fed. Rep. 920.

72—Hanford v. Westcott, 16 Off. Gaz. 1181.

73—*Ex parte* Tietgens & Robertson, 87 Off. Gaz. 2117.

74—Collier v. Jones, 120 N. Y. St. 991; 66 Misc. Rep. 97.

75—Osgood v. Rockwood, 11 Blatchf. 310; Fed. Case No. 10605.

76—Rowley v. Houghton, 2 Brewst. 303.

77—Lowe Bros. Co. v. Toledo Varnish Co., 168 Fed. Rep. 627; 94 C. C. A. 83.

78—H. Mueller Mfg. Co. v. A. Y. McDonaly & Morrison Mfg. Co., 164 Fed. Rep. 1001.

79—Holeproof Hosiery Co. v. Wallach Bros., 190 Fed. Rep. 606; decree modified, 192 Fed. Rep. 534 (C. C. A. 2).

80—New Home Sewing Machine Co. v. Bloomingdale, 59 Fed. Rep. 284.

81—Julian v. Hoosier Drill Co., 78 Ind. 408.

82—Pidding v. How, 8 Sim. 477.

83—Lanahan v. Kissel & Son, 135 Fed. Rep. 899.

Claimed as Trademark.	*Class of Goods.*
"Hunyadi Janos,"	medicinal water.[84]
"Hygeia,"	water.[85]
"Hygieniques,"	suspenders.[86]
"Ideal,"	fountain pens.[87]
"Imperial,"	automobile tires.[88]
"Indian Pond,"	scythe-stones.[89]
"Indian Root,"	pills.[90]
"In-er-seal,"	bakery products.[91]
"Inseetine,"	insect powder.[92]
"Insurance,"	oil.[93]
"Invigorator,"	spring bed bottoms.[94]
"Iron Clad,"	boots.[95]
"Java,"	face powder.[96]
"Jewel,"	stoves.[97]
"Junket,"	rennet preparation.[98]

84—Saxlehner v. Eisner & Mendelson Co. (3), 179 U. S. 19; 45 L. Ed. 60.

85—Waukesha Hygeia Mineral Springs Co. v. Hygeia Sparkling Distilled Water Co., 63 Fed. Rep. 438; 11 C. C. A. 277; Hygeia Distilled Water Co. v. Hygeia Ice Co. (2), 72 Conn. 646; 45 Atl. Rep. 957; 49 L. R. A. 147; Same v. Same (1), 70 Conn. 516, 40 Atl. Rep. 534; Consolidated Ice Co. v. Hygeia Distilled Water Co., 80 C. C. A. 506; 151 Fed. Rep. 10; affirming Hygeia Distilled Water Co. v. Consolidated Ice Co., 144 Fed. Rep. 139; Waukesha Hygeia Min. Springs Co. v. Hygeia Sparkling Distilled Water Co., 11 C. C. A. 282, 63 Fed. Rep. 443.

86—Bailly v. Nashawannuck Mfg. Co., 51 Off. Gaz. 970; 10 N. Y. Supp. 224.

87—Waterman v. Shipman, 130 N. Y. 301.

88—McGraw Tire & Rubber Co. v. Griffith, 198 Fed. Rep. 566.

89—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

90—Comstock v. White, 18 How. Pr. 421.

91—Ohio Baking Co. v. National Biscuit Co., 62 C. C. A. 116; 127 Fed. Rep. 116; affirming National Biscuit Co. v. Ohio Baking Co., 127 Fed. Rep. 160.

92—Arthur v. Howard, 19 Pa. Co. Ct. 81.

93—Insurance Oil Tank Co. v. Scott, 33 La. Ann. 946.

94—*Ex parte* Heyman, 18 Off. Gaz. 922.

95—Hecht v. Porter, 9 Pac. Coast L. J. 569.

96—Wertheimer v. Bacheller Importing Co., 185 Fed. Rep. 850.

97—American Stove Co. v. Detroit Stove Works, 31 App. D. C. 304; Barstow Stove Co. v. Detroit Stove Works, 31 App. D. C. 304.

98—Hansen v. Siegel-Cooper Co. (2), 106 Fed. Rep. 691.

Claimed as Trademark.	*Class of Goods.*
"Kaiser,"	beer.[99]
"Kathairon,"	remedy.[1]
"Keystone,"	cigars.[2]
"Keystone,"	oil.[3]
"King Bee,"	smoking tobacco.[4]
"Kitchen Crystal,"	soap.[5]
"Knickerbocker,"	shoes.[6]
"Koffio,"	cereal coffee.[7]
"La Carolina,"	cigars.[8]
"La Cronica,"	newspaper.[9]
"Lacto-Peptine,"	medicine.[10]
"La Favorita,"	flour.[11]
"Lamoille,"	scythe-stones.[12]
"La Norma,"	cigar-boxes.[13]
"La Normandi,"	cigars.[14]
"Leopold,"	woolen-cloth.[15]
"Le Page,"	glue.[16]
"Le Bon Ton."	publication.[17]
"Licensed Victuallers,"	relish.[18]

99—Kaiserbrauerei v. Blatz Brewing Co., 71 Fed. Rep. 695; s. c. affirmed, 74 Fed. Rep. 222.

1—Heath v. Wright, Cox, Am. Tr. Cas. 154, 3 Wall. Jr. 1.

2—Cohen v. Nagle, 73 N. E. Rep. 276; 190 Mass. 4.

3—Buzby v. Davis, 150 Fed. Rep. 275, 80 C. C. A. 163.

4—Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624, 35 C. C. A. 496.

5—*In re* Eastman, W. N. 1880, p. 128.

6—Burt v. Tucker, 178 Mass. 493, 59 N. E. Rep. 1111, 52 L. R. A. 112.

7—Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co., 85 Off. Gaz. 1905.

8—Havana Commercial Co. v. Nichols, 155 Fed. Rep. 302.

9—Stephens v. DeConto, 4 Abb. Pr. N. S. 47.

10—Carnrick v. Morson, Seb. 543; Cox, Manual, 543.

11—Menendez v. Holt, 128 U. S. 514; 32 L. Ed. 526.

12—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

13—*Ex parte* Egyptian Cigarette Co., 85 Off. Gaz. 1905.

14—Stachelberg v. Ponce, 23 Fed. Rep. 430.

15—Hirst v. Denham, L. R. 14 Eq. 542; 27 L. T. N. S. 56; 41 L. J. Ch. 752.

16—Russia Cement Co. v. Katzenstein, 109 Fed. Rep. 314.

17—S. T. Taylor & Co. v. Nast, 154 N. Y. S. 982.

18—Cotton v. Gillard, 44 L. J. Ch. 90.

Claimed as Trademark.	*Class of Goods.*
"Lightning,"	hay knives.[19]
"Lion,"	merchandise.[20]
"Listerine,"	antiseptic solution.[21]
"Liverpool,"	woolen cloth.[22]
"Lockport Canning Co.,"	corporate name.[23]
"London Whiffs,"	cigars.[24]
"Lone Jack,"	smoking tobacco.[25]
"Magic,"	scythe-stones.[26]
"Magnetic Balm,"	ointment.[27]
"Magnolia,"	liquor.[28]
"Maizena,"	corn flour.[29]
"Mammoth,"	toilet soap.[30]
"Marvel,"	mill products.[31]
"Medicated Mexican Balm,"	medicine.[32]
"Mellwood,"	whiskey.[33]
"Menlo Park,"	watches,[34]
"Metuchen Inn,"	hotel.[35]
"Metropolitan,"	confectionery.[36]

19—Hiram Holt Co. v. Wadsworth, 41 Fed. Rep. 34.

20—*In re* Weaver, 10 Off. Gaz. 1.

21—Lambert Pharmacal Co. v. Bolton Chemical Corporation, 219 Fed. Rep. 325; Lambert Pharmacal Co. v. Kalish Pharmacy, 219 Fed. Rep. 323.

22—Hirst v. Denham, L. R. 14 Eq. 542.

23—Lockport Canning Co. v. Pusateri, 139 N. Y. S. 640; 79 Misc. Rep. 293.

24—Feder v. Brudno, 5 Ohio N. P. 275.

25—Carroll v. Ertheiler, 1 Fed. Rep. 688.

26—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

27—Smith v. Sixbury, 25 Hun. 232; 32 N. Y. Sup. Ct. 232.

28—Kidd & Co. v. Mills, Johnson, & Co., 5 Off. Gaz. 337; Kidd v. Johnson, 100 U. S. 617; 25 L. Ed. 769.

29—Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823.

30—Summit City Soap Works v. Standard Soap Co., 37 App. D. C. 604.

31—Listman Mill Co. v. William Listman Milling Co., 60 N. W. Rep. 261; 88 Wis. 334.

32—Perry v. Truefit, 6 Beav. 56; 1 L. T. 384; Seb. 73.

33—Mellwood Dist. Co. v. Harper, 167 Fed. Rep. 389.

34—*Ex parte* Hampden Watch Co., 81 Off. Gaz. 1282.

35—Bush v. Gross, (N. J. Ch.) 64 Atl. Rep. 754.

36—Reymer & Bros. v. Huyler's, 190 Fed. Rep. 83.

Claimed as Trademark.	*Class of Goods.*
"Monitor,"	injectors and feeders for steam boilers.[37]
"Mojava."	blended coffee.[38]
"Morton Special Delivery,"	transfer business.[39]
"Mufflet,"	neck-scarfs.[40]
"Napoleon,"	cigars.[41]
"New Era,"	newspaper.[42]
"Nickel,"	soap.[43]
"Nickel-In,"	cigars.[44]
"No-To-Bac,"	medicine.[45]
"Navy,"	candy.[46]
"Necco,"	confectionery.[47]
"Norub,"	laundry aid.[48]
"Nubia,"	cigarettes.[49]
"O. F. C.,"	whiskey.[50]
"Old Crow,"	whiskey.[51]
"Old Smokehouse Blend,"	tobacco.[52]
"Old Style Lager,"	beer, with picture.[53]
"Omega Oil,"	liniment.[54]

37—Edna Smelting & Refining Co. v. Nathan Mfg. Co., 30 App. D. C. 487.

38—American Grocery Co. v. Sloan, 68 Fed. Rep. 539.

39—Morton v. Morton, 82 Pac. Rep. 664; 1 L. R. A. (N.S.) 660.

40—Hygienic Fleeced Underwear Co. v. Way, 70 C. C. A. 553, 137 Fed. Rep. 592, 595.

41—Goldstein v. Whelan, 62 Fed. Rep. 124.

42—Bell v. Locke, 8 Paige, 75; Cox, Am. Tr. Cas. 11.

43—*Ex parte* Butler, 87 Off. Gaz. 1781.

44—Schendel v. Silver, 18 N. Y. Supp. 1; 63 Hun. 330.

45—Sterling Remedy Co. v. Eureka, etc. Mfg. Co., 70 Fed. Rep. 704; 80 Fed. Rep. 105.

46—*In re* National Candy Co., 35 App. D. C. 351.

47—New England Confectionery Co. v. National Wafer Co., 224 Fed. Rep. 344.

48—Van Zile v. Norub Mfg. Co., 228 Fed. Rep. 829.

49—Perkins v. Apollo Bros., 197 Fed. Rep. 476.

50—Geo. T. Stagg Co. v. Taylor, 95 Ky. 651; 27 S. W. Rep. 247.

51—W. A. Gaines & Co. v. Leslie, 54 N. Y. Supp. 421; W. A. Gaines & Co. v. E. Whyte Grocery, Fruit & Wine Co., 107 Mo. App. 507; 81 S. W. Rep. 648.

52—Jacoway v. Young, 228 Fed. Rep. 630.

53—G. Heileman Brew. Co. v. Independent Brew. Co., 191 Fed. Rep. 489 (C. C. A. 9).

54—Omega Oil Co. v. Weschler, 71 N. Y. Supp. 983.

Claimed as Trademark.	*Class of Goods.*
"Osman,"	towels.[55]
"Otaka,"	biscuits.[56]
"Oxford,"	bibles.[57]
"Pain-Killer,"	medicine.[58]
"Parabola,"	needles.[59]
"Paris,"	garters.[60]
"Pectorine,"	medicine.[61]
"Pepto-Mangan,"	medicinal preparation.[62]
"Perfection,"	mattresses.[63]
"Persian,"	thread.[64]
"Pigs in Clover,"	puzzle.[65]
"Poplar Log,"	whiskey.[66]
"Portland,"	stoves.[67]
"Portuondo,"	cigars.[68]
"Pride,"	cigars.[69]
"Puddine,"	pudding preparation.[70]
"Queen,"	shoes.[71]
"Queen Quality,"	shoes.[72]

55—Barlow & Jones v. Johnson, 7 P. R. 395.

56—*Ex parte* Lorenz, 89 Off. Gaz. 2067.

57—Chancellor of Oxford University v. Wilmore-Andrews Pub. Co., 101 Fed. Rep. 443.

58—Davis v. Kendall, 2 R. I. 566; Davis v. Kennedy, 13 Grant Up. Can. Ch. 523.

59—Roberts v. Sheldon, Fed. Case No. 11,916; 18 Off. Gaz. 1277; 8 Biss. 398.

60—A. Stein & Co. v. Liberty Garter Co., 198 Fed. Rep. 959.

61—Smith v. Mason, W. R. (1875), p. 62.

62—M. J. Breitenbach Co. v. Spangenberg, 131 Fed. Rep. 160.

63—Kyle v. Perfection Mattress Co., 127 Ala. 39; 28 So. Rep. 545.

64—Taylor v. Carpenter (1), 3 Story, 458.

65—Lyman v. Burns, 47 Off. Gaz. 660.

66—Somers v. Newman, 31 App. D. C. 193.

67—Van Horn v. Coogan, 52 N. J. Eq. 380; 28 Atl. Rep. 788; affirmed, Van Horn v. Coogan, 52 N. J. Eq. 588, 33 Atl. Rep. 50.

68—Juan F. Portuondo Cigar Mfg. Co. v. Vincente Portuondo Cigar Mfg. Co., 70 Atl. Rep. 968; 222 Pa. 116.

69—Hier v. Abrahams, 82 N. Y. 519; 37 Am. Rep. 589.

70—Clotworthy v. Schepp, 42 Fed. Rep. 62.

71—Thomas G. Plant Co. v. May Co., 44 C. C. A. 534, 105 Fed. Rep. 375; Thomas G. Plant Co. v. May Co., 100 Fed. Rep. 72.

72—Thomas G. Plant Co. v. May Mercantile Co., 153 Fed. Rep. 229; Thos. G. Plant Co. v. Hamburger, 153 Fed. Rep. 232.

Claimed as Trademark.	*Class of Goods.*
"Radium,"	silk.[73]
"Rameses,"	cigarettes.[74]
"Ranier,"	beer.[75]
"Rexall,"	dyspepsia remedy.[76]
"Rischon-le Zion,"	wine.[77]
"Rising Sun,"	stove polish.[78]
"Roach Sault,"	insecticide.[79]
"Robe & Tanning Co.,"	trading name.[80]
"Roger Williams,"	cotton cloth.[81]
"Roof Leak,"	roof paint.[82]
"Rosebud,"	canned salmon.[83]
"Rowley,"	artificial limbs.[84]
"Royal,"	baking powder.[85]
"Royal Blue,"	carpet sweeper.[86]
"Sapolio,"	scouring brick.[87]
"Saponifier,"	concentrated lye.[88]
"Sarony,"	photographs.[89]

73—Eiseman v. Schiffer, 157 Fed. Rep. 473.

74—Stephano v. Satmatopoulos, 199 Fed. Rep. 451.

75—Kostering v. Seattle Brewing & Malting Co., 54 C. C. A. 76, 116 Fed. Rep. 620.

76—Regis v. Jaynes, 70 N. E. Rep. 480; 185 Mass. 458; affirmed in 77 N. E. Rep. 774, 191 Mass. 245; compare Theodore Rectanus Co. v. United Drug Co., 226 Fed. Rep. 545 (C. C. A. 6), see sec. 47.

77—Jewish Colonization Ass'n v. Solomon & Germansky, 154 Fed. Rep. 157.

78—Morse v. Worrell, 10 Phila. 168

79—Stern v. Barrett Chem. Co., 29 Misc. Rep. 609; reversed, Barrett Chem. Co. v. Stern, 176 N. Y. 27.

80—Dyment v. Lewis (Iowa), 123 N. W. Rep. 244.

81—Barrows v. Knight, 6 R. I. 434; Cox, Am. Tr. Cas. 238.

82—Elliott Varnish Co. v. Sears, Roebuck & Co., 221 Fed. Rep. 797.

83—*Ex parte* Kinney, 72 Off. Gaz. 1349.

84—J. F. Rowley Co. v. Rowley, 154 Fed. Rep. 744.

85—Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376; Raymond v. Royal Baking Powder Co., 85 Fed. Rep. 231, 29 C. C. A. 245.

86—*Ex parte* Grand Rapids School Furniture Co., 87 Off. Gaz. 1957.

87—Enoch Morgan's Sons Co. v. Wendover, 43 Fed. Rep. 420; Enoch Morgan's Sons Co. v. Ward, 152 Fed. Rep. 690; 81 C. C. A. 616.

88—Pennsylvania Salt Mfg. Co. v. Meyers, 79 Fed. Rep. 87.

89—Burrow v. Marceau, 109 N. Y. St. 105; 124 App. Div. 665.

Claimed as Trademark.	*Class of Goods.*
"Schnapps,"	plug tobacco.[90]
"Sefton,"	cloth.[91]
"Shawknit,"	stockings.[92]
"Shipmate,"	stoves.[93]
"Silver Grove,"	whiskey.[94]
"Six Little Tailors,"	tailoring firm's name.[95]
"Slate Roofing,"	paint.[96]
"Sliced Animals,"	toys.[97]
"Social Register,"	directory.[98]
"Sozodont,"	dentifrice.[99]
"Spanish,"	tile.[1]
"Standard T. O. C. Co.,"	corporate name.[2]
"Star,"	shirts.[3]
"Star,"	iron.[4]
"Star,"	oil.[5]
"Star,"	soap.[6]
"Star,"	lead pencils.[7]
"Star,"	tobacco.[8]
"Sterling,"	ale.[9]

90—R. J. Reynolds Tob. Co. v. Allen Bros. Tob. Co., 151 Fed. Rep. 819.

91—Hirst v. Denham, L. R. 14 Eq. 542.

92—Shaw Stocking Co. v. Mack, 12 Fed. Rep. 707.

93—Stamford Foundry Co. v. Thatcher Furnace Co., 200 Fed. Rep. 324.

94—Seltzer v. Powell, 8 Phila. 296.

95—Mossler v. Jacobs, 65 Ill. App. 571.

96—*In re* Glines, 8 Off. Gaz. 435.

97—Selchow v. Baker, 93 N. Y. 59.

98—Social Reg. Ass'n. v. Howard, 60 Fed. Rep. 270; 67 Off. Gaz. 1448.

99—Hall & Ruckel v. Ingram, 28 App. D. C. 454.

1—R. Guastavino Co. v. Comerma, 184 Fed. Rep. 549.

2—Standard Table Oil Cloth Co. v. Trenton Oil Cloth & Linoleum Co., 63 Atl. Rep. 846, 71 N. J. Eq. 555.

3—Morrison v. Case, 9 Blatchf. 548; 2 Off. Gaz. 544; Fed. Case No. 9845; Hutchinson v. Blumberg, 51 Fed. Rep. 829; Hutchinson v. Covert, 51 Fed. Rep. 832.

4—Dixon v. Jackson, 2 Scot. L. Rep. 188.

5—*In re* American Lubricating Oil Co., 9 Off. Gaz. 138.

6—*In re* Cornwall, 12 Off. Gaz. 138.

7—Faber v. Hovey, Codd. Dig. 79, 242; Seb. 481.

8—Liggett & Myer Tob. Co. v. Sam Reid Tob. Co., 155 Mo. 843; Liggett & Myer Tob. Co. v. Hynes, 20 Fed. Rep. 883.

9—Worcester Brewing Corporation v. Reuter & Co., 157 Fed. Rep. 217; 84 C. C. A. 665 (C. C. A. 1).

Claimed as Trademark.	*Class of Goods.*
"St. James,"	newspaper.[10]
"St. James,"	cigarettes.[11]
"Sunlight,"	soap.[12]
"Sunshine,"	stoves.[13]
"Swan Down,"	complexion powder.[14]
"Sweet Caporal,"	cigarettes.[15]
"Sweet Opoponax of Mexico,"	perfume.[16]
"Syrup of Red Spruce Gum."	medicine.[17]
"Tamar Indien,"	lozenges.[18]
"Teller,"	recording safe.[19]
"The Good Things of Life,"	periodical.[20]
"The Nile,"	playing cards registered as a print.[21]
"Tidal Wave,"	tobacco.[22]
"Tivoli,"	beer.[23]
"Tobasco,"	sauce.[24]
"Trilby,"	gloves.[25]
"Turpentine Shellac,"	wood filler.[26]

10—Giblett v. Read, 9 Mod. 459; Seb. 3, *Ex parte* Foss, *In re* Baldwin, 30 L. T. 354; 2 DeG. & J. 230; 27 L. J. Bkptcy. 17; 4 Jur. N. S. 522; 21 L. T. 30; Seb. 159.

11—Kinney v. Basch, Seb. 542.

12—Lever Bros. (Ltd.) v. Pasfield, 88 Fed. Rep. 484.

13—Reading Stove Works v. S. M. Howes Co., 87 N. E. Rep. 751; 201 Mass. 437.

14—Tetlow v. Tappan, 85 Fed. Rep. 774.

15—Kinney Tob. Co. v. Muller, 53 Hun, 340; 6 N. Y. Supp. 389; Hornbostel v. Kinney, 110 N. Y. 94, 17 N. E. Rep. 666.

16—Smith v. Woodruff, 48 Barb. 438.

17—Kerry v. Tompin, 60 Fed. Rep. 272.

18—Grillon v. Guenin, W. N. 1877, p. 14.

19—Automatic Recording Safe Co. v. Bankers' Registering Safe Co., 224 Fed. Rep. 506.

20—Stokes v. Allen, 9 N. Y. Supp. 846; 56 Hun. 526.

21—*Ex parte* United States Playing Card Co., 82 Off. Gaz. 1209.

22—Sorg v. Welsh, 16 Off. Gaz. 919.

23—Berliner Brauerei Gesellschaft v. Knight, W. N. 1883, p. 70.

24—E. McIlhenny's Son v. New Iberia Extract of Tabasco Pepper Co., 30 App. D. C. 337.

25—*In re* Holt & Co's Trademark (C. A.), L. R. (1891) 1 Ch. 711.

26—(As against unfair competition). Standard Varnish Works v. Fisher, Thorsen & Co., 153 Fed. Rep. 928.

Claimed as Trademark.	*Class of Goods.*
"Twin Brothers,"	yeast.[27]
"Uneeda,"	biscuit.[28]
"Valvoline,"	lubricating oil.[29]
"Velvet Grip,"	hose supporter.[30]
"Victor,"	millinery goods.[31]
"Victoria,"	millinery goods.[32]
"Virginia Leaf,"	tobacco.[33]
"Vitascope,"	machine.[34]
"Vulcan,"	matches.[35]
"Warner,"	corsets.[36]
"Waverly,"	bicycles.[37]
"Wearever,"	aluminum ware.[38]
"White House,"	coffee.[39]
"White Rock Lithia,"	water.[40]
"Willoughby Lake,"	scythe-stones.[41]
"Wistar's Balsam of Wild Cherry,"	medicine.[42]
"Yankee,"	soap.[43]

27—Burton v. Stratton, 12 Fed. Rep. 696.

28—National Biscuit Co. v. Baker, 95 Fed. Rep. 135.

29—Leonard v. White's Golden Lubricator Co., 38 Fed. Rep. 922; Leonard v. Wells, L. R. 26 Ch. D. 288. *Per contra*, *In re* Horsburgh, 53 L. J. Ch. 237.

30—E. B. Estes & Sons v. Geo. Frost Co., 176 Fed. Rep. 338; 100 C. C. A. 258.

31—Andrew McLean Co. v. Adams Mfg. Co., 31 App. D. C. 509.

32—Andrew McLean Co. v. Adams Mfg. Co., 31 App. D. C. 509.

33—American Tob. Co. v. Polacsek, 170 Fed. Rep. 117.

34—Vitascope Co. v. U. S. Phonograph Co., 83 Fed. Rep. 30.

35—Taendsticksfabriks Aktiebolaget Vulcan v. Myers, 139 N. Y. 364.

36—Warner Bros. Co. v. Wiener, 218 Fed. Rep. 635.

37—*Ex parte* Indiana Bicycle Co., 72 Off. Gaz. 654.

38—Aluminum Cooking Utensil Co. v. National Aluminum Works, 226 Fed. Rep. 815.

39—Dwinell-Wright Co. v. Co-operative Supply Co., 148 Fed. Rep. 242; 155 Fed. Rep. 909.

40—National Water Co. v. O'Connell, 159 Fed. Rep. 1001; affirmed, 88 C. C. A. 487, 161 Fed. Rep. 545 (C. C. A. 3); National Water Co. v. Hertz, 177 Fed. Rep. 607.

41—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

42—Fowle v. Spear, 7 Pa. L. J. 176.

43—Williams v. Adams, 8 Biss. 452; Fed. Case No. 17711; Williams v. Spence, 25 How. Pr. 366; Williams v. Johnson, 2 Bos. 1.

§ 49. Generic terms judicially defined.—It is confusing to the student to be told that words indicating quality can not be valid trademarks, and yet to be confronted by the physical fact and judicial dictum that the highest function of the trademark is its indication of quality. In a leading case Mr. Justice Field said that a trademark is "a sign of the quality of the article;"[44] and in the leading case of *Amoskeag Manufacturing Co. v. Spear*, the learned court says that the trademark of a manufacturer "is an assurance to the public of the quality of his goods."[45] In the same opinion, how-

44—Manhattan Medicine Co. v. Wood, 108 U. S. 218-222; 27 L. Ed. 706.

45—Amoskeag Mfg. Co. v. Spear (1849), 2 Sand. S. C. 599; Cox, 87; Seb. 100.

In a recent case Judge Bradford has called attention to the use of the word "quality" in the cases, and distinguished its two different meanings, in the following language:

"A trademark is designed to enable one legitimately to build up or protect his business, but not to deprive others of the right to use necessary or proper means for carrying on an honorable competition in trade. No one has a right to appropriate a sign or a symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. Canal Co. v. Clark, 13 Wall. 311, 324. Hence no one can acquire an exclusive right to the use, as a trademark, of a generic name, or word, which is merely descriptive of an article, or a sign, symbol, figure, letter, brand, form or device, which either on its face or by association indicates or denotes merely grade, quality, class, shape, style, size, ingredients or composition of an article or a word or words in common use designating locality, section or region of country. The word 'quality' is used in different senses in the cases. It is employed in some to denote the grade, ingredients or properties of an article, and in others to indicate generally the merit or excellence of an article as associated with or coming from a certain source. While there can be no valid trademark as denoting quality when used merely in the former sense, there may be a valid trademark as indicating quality when used in the latter sense. Thus in McLean v. Fleming, 96 U. S. 245-253, the court said:

"'Such a proprietor, if he owns or controls the goods which he exposes to sale, is entitled to the exclusive use of any trademark adopted and applied by him to the goods to distinguish them as being of a particular manufacture and quality,' etc.

"In Medicine Co. v. Wood, 108 U. S. 218, 222; 2 Sup. Ct. 439, the court said:

"'He may thus notify the public of the origin of the article and secure to himself the benefits of

ever, the judge (Duer) observes that the manufacturer "has no right to appropriate a sign or symbol which, from the nature of the fact which it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. Were such an appropriation to be sanctioned by an injunction, the action of a court of equity would be as injurious to the public as it is now beneficial; it would have the effect in many instances of creating a monopoly in the sale of particular goods as exclusive as if secured by a patent, and freed from any limitation of time."

In another early case the chancellor observed: "In respect to words, marks or devices which do not denote the goods or property or particular place of business of a person, but only the nature, kind or quality of the articles in which he deals, * * * no property in such words, marks or devices can be acquired. There is obviously no good reason why one person should have any better right to use them than another. They may be used by many different persons at the same time, in their brands, marks or labels on their respective goods, with perfect truth and fairness. They signify nothing, when fairly interpreted, by which any dealer in a similar article could be defrauded."[46] And in more recent cases the rule has been explained in somewhat similar terms: "It is true that no one can appropriate as a trademark the commercial

any particular excellence it may possess from the manner or materials of its manufacture. His trademark is both a sign of the quality of the article and an assurance to the public that it is a genuine product of his manufacture.'

"In Menendez v. Holt, 128 U. S. 514, 520; 9 Sup. Ct. 144, the court, speaking of the words 'La Favorita' as applied to flour, said:

"'It was equivalent to the signature of Holt & Co. to a certificate that the flour was the genuine article which had been determined by them to possess a certain degree of excellence. * * * And the fact that flour so marked acquired an extensive sale, because the public discovered that it might be relied on as of a uniformly meritorious quality, demonstrates that the brand deserves protection rather than it should be debarred therefrom, on the ground, as argued, of being indicative of quality only.'" Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651-657.

46—Stokes v. Landgraff, 17 Barb. 608; Cox, 137; Seb. 121.

name of an article which every man has the right to make and sell."[47]

"No manufacturer can acquire a special property in an ordinary term or expression, the use of which as an entirety is essential to the correct and truthful designation of a particular article or compound. The courts have gone a long way, and with plain justice, in protecting the honest and enterprising manufacturer of any good and useful article from the unscrupulous pirating of his special reputation; but they have been equally careful to prevent any attempted monopoly of that which is common to all."[48]

"Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients or characteristics, be employed as a trademark, and the exclusive use of it be entitled to legal protection. No one can claim protection for the exclusive use of a trademark or tradename which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed."[49]

The fact that the article to which the trademark is applied has obtained such a wide sale that the mark has become indicative of quality, as well as of origin and ownership, is not of itself sufficient to render the mark *publici juris* and so deprive its owner of the right to relief against infringers.[50]

§ 50. Marks common to the trade.—The expression "common to the trade" is used in the Trademark Act of England in the following connection (T. M. A., 1905, s. 15):

"(3) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words or figures, which was, or were, before the thirteenth day of August, one thousand eight hundred and seventy-five, publicly used by more than

47—Dreydoppel v. Young, 14 Phila. 226; Price & Stewart, 423, 424.

48—Town v. Stetson, 5 Abb. Pr. N. S. 218; Cox, 514, 515.

49—Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311-323; 20 L. Ed. 581; 5 Am. L. T. 135; 1 Off. Gaz. 279; Seb. 327.

50—Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537, 547; 34 L. Ed. 997; Burton v. Stratton, 12 Fed. Rep. 696.

three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods."

In applying the statute the English courts have interpreted the words "common to the trade" in their ordinary significance, which fact makes the English decisions concerning marks of this class valuable as precedents in this country. Speaking of this term, Mr. Justice Chitty said:

"The applicant's contention is that 'common to the trade' means that which is open to the trade to use, substituting another phrase, in order to bring out exactly the meaning which the applicant contended ought to be placed upon the words; and in support of his contention he puts this case: Supposing that there is some word which has been used by the trade largely, some ten years or so, or by twenty or thirty persons before the application for registration under this Act of 1883; but for certain reasons all those persons, except two or three, have dropped the user; they may have recourse to the user again at any time. If, says the applicant, the term 'common to the trade' is confined to user, it must mean user at the time of the application. That was also the contention on the part of the respondent, that 'common to the trade' meant common user at the date when the application was made; and I think that is a very good illustration to show that the legislature could not have intended to employ this term in that sense. But the true resolution of the question is very simple; the phrase 'common to the trade' is not to be interpreted otherwise than according to the ordinary rules of grammar, and I think 'common to the trade' means exactly what it says. I can not really make use of a better term; but I can make use of a term which I think exactly corresponds with the meaning—I do not say it is better—that it is 'open to the trade.'" [51]

In examining the cases in which marks have been found to be common to a trade some curious instances will be found.[52]

51—Burland v. Broxburn Oil Co., 6 R. P. C. 482, 489.

52—*Illustrations of marks common to the trade.* The device of a cat, to the gin trade, Boord v. Huddart, 21 R. P. C. 149; *In re* Bagots, Hutton & Co., Ltd., 32 R. P. C. 333, 347; the word "Tower," to the tea trade, Great Tower Street Tea Co. v. Smith, 6 R. P. C. 172;

§ 51. The name given an unpatented invention by the inventor.—Such names clearly should, if otherwise unobjectionable, be treated as valid trademarks in the hands of the inventor or his assigns. Under the rule discussed in the next section, if the inventor patents his invention, he can not lengthen his monopoly's duration by applying a trademark to the patented article; his right to the trademark expires with the life of the letters patent. Where he elects to dedicate his invention to the public, his right to adopt a trademark for such specimens as he himself may manufacture, is obvious. But the name by which he distinguishes his invention, being the necessary name of the article, can not be used by another, holding no assignment from the inventor.[53]

§ 52. Necessary name of a product.—The necessary name of a product, natural or manufactured, can not be a trademark, for the reasons we have discussed. This is true of goods manufactured under a patent. The descriptive name by which they are known during the life of the letters patent becomes their popular name in the trade—the name by which they are necessarily known and distinguished. When, therefore, the protection of the patent has expired the name is *publici juris*, and the manufacturer under the letters patent can claim no trademark in it.[54]

the device of a milkmaid, to the butter trade, *In re* Anglo-Swiss Condensed Milk Co., 20 R. P. C. 509; the words "Bank of England," to the sealing-wax trade, *In re* Hyde & Co., 7 Ch. D. 724; the words "Parchment" and "Bank," to the paper trade, *In re* Goodall, 42 Ch. D. 566; the words "Old Innishowen," to the whisky trade, Watt v. O'Hanlon, 4 R. P. C. 1; the words "Extra" and "Coker," to the canvas trade, *In re* Hayward & Sons, 54 L. J. Ch. 1003; the words "Braided Fixed Star," to the match trade, *In re* Palmer, 24 Ch. D. 504; the word "Selected," to the steel pen trade, *In re* Kuhn & Co., 53 L. J. Ch. 328; the words "White Swan" and the picture of a swan floating upon water, to the flour trade, Bulte v. Igleheart Bros., 137 Fed. Rep. 492, 501; 70 C. C. A. 76; the word "Velvet," to the ice-cream trade, Chapin-Sacks Mfg. Co. v. Hendler Creamery Co., 231 Fed. Rep. 550; the "saw-buck" or "cross-bar" mark, to the tea trade, Castle v. Siegfried, 103 Cal. 71; 37 Pac. Rep. 210.

53—H. B. Chaffee Mfg. Co. v. Selchow, 131 Fed. Rep. 543.

54—Centaur Co. v. Robinson, 91 Fed. Rep. 889; Same v. Neathery, 91 Fed. Rep. 891; Same v. Hughes Bros. Mfg. Co., 91 Fed. Rep. 901. The cases are collected, *ante*, § 45.

Thus, the word "Linoleum" as applied to a kind of floor covering,[55] "Singer" applied to sewing machines,[56] and "Lanoline" applied to a wool-fat preparation,[57] were held to be *publici juris* upon the expiration of the letters patent covering the articles to which they were applied.

Analogous to this class of cases is that where new combinations of old elements are found, and it is sought to distinguish such a new compound or combination by joining the descriptive names of its constituent elements. This is best illustrated by a case where the words claimed as trademark were "Ferro-phosphorated Elixir of Calisaya Bark," which claim was distinctly negatived by the New York Court of Appeals, Folger, J., saying: "They may not be appropriated by one to mark an article of his manufacture, when they may be used truthfully by another to inform the public of the ingredients which make up an article made by him."[58] For this reason the name "Acid Phosphate" applied to a medicinal preparation,[59] and "Indurated Fibre" applied to wares made of wood-pulp,[60] are not valid trademarks; and the word "Bromo-Quinine" was refused registration as a trademark for medicines,[61] as was also the word "Ferro-Manganese" as a mark for mineral waters,[62] and the word "Bromo-Celery" for a medicinal preparation.[63]

There are cases, however, where such words or combinations of words have been held not to be descriptive. Thus the word "Cocoaine" as applied to a hair wash compounded from cocoanut oil and other ingredients,[64] and "Magnetic Balm" as

55—Linoleum Mfg. Co. v. Nairn, L. R. 7 Ch. D. 834; 47 L. J. Ch. 430; 38 L. T. N. S. 448; 26 W. R. 463; Seb. 536.

56—Singer Mfg. Co. v. Bent, 163 U. S. 205; 41 L. Ed. 131; Singer Mfg. Co. v. June, 163 U. S. 169; 41 L. Ed. 118.

57—Jaffe v. Evans & Sons, Ltd., 75 N. Y. Supp. 257.

58—Caswell v. Davis, 58 N. Y. 223-233.

59—Rumford Chemical Works v. Muth, 35 Fed. Rep. 524.

60—Indurated Fibre Co., v. Amoskeag Fibre Co., 37 Fed. Rep. 695.

61—*In re* Grove, Newton, Dig. 192; s. c., *Ibid.* 191; 67 Off. Gaz. 1447.

62—*In re* Excelsior Spring Co., Newton, Dig. 153.

63—*In re* Bromo-Celery Co., Newton, Dig. 190.

64—Burnett v. Phalon, 3 Keyes, 594.

applied to a medicinal compound,[65] have been upheld as valid trademarks. The word "Electro-Silicon" applied to a polishing compound has also been upheld,[66] and it appears very clear that the words "Magnetic" or "Electric" as used in the two cases last referred to are purely arbitrary and fanciful.

We have noted that the patent office has refused registration to an applicant offering the word "Bromo-Quinine" as the name of a medicinal preparation. This decision is in hopeless conflict with some of the adjudicated cases. The word "Bromidia," as a trademark for a chemical combination of chloral hydrate, bromide of potassium and other substances, was admitted to registration and subsequently upheld as valid, the court upon final hearing saying that the word "has no meaning whatever except as connected with complainants' business, and as associated with and indicative of a soothing or soporific mixture prepared and sold by them."[67] The word "Bromo-Caffeine" was admitted to registration, and upheld judicially, the Court of Appeals of New York saying, per Peckham, J.: "We think there is a distinction between the facts in this case and that of *Caswell v. Davis*.[68] In this case the term perhaps suggests that some one among the hundreds of substances that bromine may combine with has been used in such combination together with caffeine. There are, however, some seven different ingredients in the plaintiff's preparation, and there is no free bromine among them, and there is no evidence as to what the substance is which the bromine (if any) had combined with before being used in the preparation, and so it is plain that the words 'Bromo-Caffeine' do not in fact describe the ingredients or even give any clear general idea as to what they are."[69] It is the general rule that "when an article is made that was theretofore unknown, it must be christened with a name by which it can be recognized and dealt in; and the name thus given to it becomes

65—Smith v. Sixbury, 25 Hun, 232.

66—Electro-Silicon Co. v. Trask, 59 How. Pr. 189; Electro-Silicon Co. v. Hazard, 29 Hun, 369.

67—Battle & Co. v. Finlay (preliminary hearing), 45 Fed. Rep. 796, (final hearing) 50 Fed. Rep. 106.

68—58 N. Y. 223, cited, *supra*.

69—Kensbey v. Brooklyn Chemical Works, 142 N. Y. 467-476.

public property, and all who deal in the article have the right to designate it by the name by which alone it is recognizable." [70]

Under peculiar circumstances a mark, otherwise a valid trademark, will become the common property of two or more merchants, each of whom may have a right to its use, provided he so uses it as not to pass off his goods as those of one of the others entitled to use the mark. Thus a plaintiff was refused an injunction restraining the use of the mark "Aramingo Check" to designate printed cloth made at the Aramingo Mills, where the defendant showed that the cloth sold by him under the mark was the product of the same mills, and the labels used by the respective parties differed in size and color so that confusion could not result from their use.[71]

§ 53. The trademarked article not a trademark.—It is obvious that if a commercial article itself could constitute a trademark, there would be little use for patent laws. As Judge Carpenter said, "in the very nature of the case, * * * the trademark must be something other than, and separate from, the merchandise." [72]

Nor can the article, by being colored, constitute a trademark. This is illustrated by the case in which it was sought to protect a bronzed horse-shoe nail as a trademark.[73] It is again illustrated by the attempts to hold as a trademark a "distinctively colored streak in a wire rope," [74] a "rose-colored

70—Wallace, J., in Leclancha Battery Co. v. Western Elec. Co., 23 Fed. Rep. 276.

71—Colloday v. Baird, 4 Phila. 139; Cox American Trademark Cases, 257.

72—Davis v. Davis, 27 Fed. Rep. 490, 492.

73—Putnam Nail Co. v. Dulaney, 140 Pa. 205.

74—A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 201 U. S. 166; 50 L. Ed. 710; affirming s. c., 67 C. C. A. 418; 134 Fed. Rep. 571; and s. c., 123 Fed. Rep. 152. Followed in J. A. Scriven Co. v. Morris, 154 Fed. Rep. 914, 918. To the same effect see Dodge Mfg. Co. v. Sewall & Day Cordage Co., 142 Fed. Rep. 288; A. Leschen & Sons Rope Co. v. Macomber & Whyte Rope Co., 142 Fed. Rep. 289; A. Leschen & Sons Rope Co. v. Fuller, 134 C. C. A. 570; 218 Fed. Rep. 786.

metallic capsule" for a champagne bottle,[75] or a red head with a blue tip for matches,[76] or illustrated post cards.[77]

In the case of an alleged trademark consisting of the words "Merrie Christmas," applied to ribbons by weaving, Judge Holt very correctly said, "a trademark ordinarily does not add anything to the value of the goods in the estimation of the buyer. It is simply a mark to identify the manufacturer of them. * * * Of course, a trademark is sometimes impressed upon the article sold, but I do not think that it ever properly constitutes an element of value in the thing itself."[78]

§ 54. Packages as trademarks.—It is equally obvious that a commercial package can not be a trademark. In one of the early cases upon this rule, Judge Johnson said: "It appears that the ornamental tin pail which the plaintiff employs is a common article in commerce, and that pails made of tin, ornamented or unornamented, are and have long been in use for all such purposes as any one chose to apply them to. The question whether any one can seize upon such an article and make title to its exclusive use for a special purpose, by calling it a trademark, must be far from clear in favor of the claimant. The forms and materials of packages to contain articles of merchandise, if such claims should be allowed, would be rapidly taken up and appropriated by dealers, until some one, bolder than the others, might go to the very root of things, and claim for his goods the primitive brown paper and tow string, as a peculiar property. It will be observed, that it is not a mark at all which is claimed, but the whole enveloping package, the whole surface of which is covered by the ornamental pattern."[79]

Nor can a package be made a trademark by being colored.[80] Judge Coxe concisely embodied the rule in these words: "The trend of the law is strongly towards the proposition that,

75—Mumm v. Kirk, 40 Fed. Rep. 589.

76—Diamond Match Co. v. Saginaw Match Co., 74 C. C. A. 59; 142 Fed. Rep. 727.

77—Bamforth v. Douglass Post Card & Mach. Co., 158 Fed. Rep. 355.

78—Smith v. Krause, 160 Fed. Rep. 270, 271.

79—Harrington v. Libby, Fed. Case No. 6,107; 12 Off. Gaz. 188.

80—Philadelphia Novelty Mfg. Co. v. Blakesley Novelty Co., 40 Fed. Rep. 588.

in ordinary circumstances, the adoption of packages of peculiar form and color alone, unaccompanied by any distinguishing symbol, letter, sign, or seal, is not sufficient to constitute a trademark."[81]

§ 55. Pictures as trademarks.—Pictures are peculiarly susceptible of use as trademarks, because, with but few exceptions, they are neither descriptive nor deceptive, and hence are not open to the objections which inhere in words having those characteristics. It has been judicially stated that "trademarks are of two kinds. They may consist of pictures or symbols, or a peculiar form and fashion of label, or simply of a word or words. * * * Where the trademark consists of a picture or symbol, or in any peculiarity in the appearance of the label, the imitation (to be enjoined) must be such as to amount to a false representation, liable to deceive the public, and enable the imitator to pass off his goods as those of the person whose trademark is imitated."[82] Of course a picture may, just as a word-mark, become common to the trade; in which event it is nobody's trademark, and no user can complain of its infringement.[83]

While the picture of a public building (as, the Town Hall of Glasgow) may be used as a valid trademark, it is not infringed by another view of the same building, presenting a substantially different effect to the eye.[84] Although a distinctive form of container for merchandise does not entitle the user of that container to have it protected as a trademark,[85] the picture of a dome-shaped cake of black-lead has been upheld as a valid trademark by the Court of Appeal of England, where it appeared that the picture was used as a trademark on black-lead formed in other shapes.[86]

§ 56. Words as trademarks.—As stated by Judge Rapallo, "trademarks * * * may consist * * * simply of a

81—Philadelphia Novelty Mfg. Co. v. Rouss, 40 Fed. Rep. 585, 587.

82—Rapallo, J., in Hier v. Abrahams, 82 N. Y. 519, 523.

83—*In re* Societe Anonyme Dubonnet, 31 R. P. C. 453, 468.

84—Cowie Bros. & Co. v. Herbert, 14 R. P. C. 436.

85—Moorman v. Hoge, Fed. Case No. 9,783; Harrington v. Libby, Fed. Case No. 6,107.

86—James v. Parry, 3 R. P. C. 340.

word or words."[87] It is no objection to the appropriation of a word as a trademark that it is "in common use."[88] Of course the word so adopted must neither be descriptive nor deceptive, or open to either of the other disqualifications which prevent its serving as a proper indication of origin or ownership. Possibly the most valuable word-marks in use are to be found among the newly-coined words, so-called for want of better nomenclature; they are sometimes called "made-up" words.[89] Such "new coinage," as it is termed by Judge Ray, has frequently been considered by the courts.[90] A descriptive word may be coupled with an arbitrary term to form a word which is a proper trademark.[91] Such made-up words are termed "invented words" in sec. 9 of the British Trademarks Act, 1905, and are registrable even when they have "a direct reference to the character or quality of the goods."[92]

§ 57. **Method of arranging goods as trademark.**—The arrangement of goods in a package can not constitute a trademark. Judge Welker said: "The complainants could not obtain a trademark * * * in the manner in which the gum might be placed in the boxes."[93] Judge Carpenter made the same ruling with reference to the arrangement of cakes of soap in red and yellow wrappers, the colors alternating.[94]

The importance of these rulings has vastly decreased of late years, owing to the fact that all of these matters, packages, labels, and methods of packing, are now understood to relate only to proof of fraudulent intent in competition. No technical trademark right exists in either of them; in the abstract, they are each of common right. But like size, shape, form and color, each readily becomes subservient as an instrumentality of fraud where unfair competition is intended.

87—Hier v. Abrahams, 82 N. Y. 519, 523.

88—Delaware & Hodson Canal Co. v. Clark, 13 Wall. 311; 20 L. Ed. 581.

89—Northwestern Consol. Mill Co. v. Mauser & Cressman, 162 Fed. Rep. 1004.

90—Rushmore v. Saxon, 158 Fed. Rep. 499, 508.

91—S. R. Feil Co. v. John E. Robbins Co., 136 C. C. A. 258; 220 Fed. Rep. 650.

92—*In re* Carl Lindstroem Aktiengesellschaft, 31 R. P. C. 265.

93—Adams v. Heisel, 31 Fed. Rep. 279.

94—Davis v. Davis, 27 Fed. Rep. 490.

They enter into the litigation of today, not upon the theory that property is claimed in them, but merely as badges of fraud.

§ 58. Words taken from the dead languages.—Words from the dead languages have frequently been applied to merchandise and sustained as valid trademarks, as, for example, the Greek "Eureka" as a mark for shirts[95] or for a fertilizing material,[96] and the Latin "Excelsior" for stoves[97] or soap.[98] The Latin phrase "Ne Plus Ultra" was invalid as a trademark solely because the plaintiff did not show exclusive user in himself, and the words and an accompanying device were found to be common to the trade.[99] It has been said by the Canadian Supreme Court that there can be property in a word of a dead language even if it be expressive of quality,[1] but this dictum is incorrect, as appears from the authorities reviewed in the next succeeding section. A descriptive word from a dead language can not be other than a generic term when used as a mark for goods. Thus, on an application for registration for the word "Sanitas" for medicines, Kay J., remarked: "The truth is that if this word were applied to medicines, it would mean to any ordinary person that the medicines were health medicines; that is, health-giving medicines; and that is descriptive of the quality or of the effect of the use of these medicines. How is it possible that it is not descriptive?"[2]

§ 59. Words and phrases from modern foreign languages.—This topic has been fruitful of conflicting holdings. It is not

95—Ford v. Foster, L. R. 7 Ch. D. 611.

96—Alleghany Fertilizer Co. v. Woodside, 1 Hughes, 115, Fed. Case. No. 206.

97—Sheppard v. Stuart, 13 Phila. 117; Price & Steuart, 193.

98—Braham v. Bustard, 1 H. & M. 447. "Excelsior" applied to gun-cotton goods was not upheld. Steinthal v. Samson, Seb. 546.

99—Beard v. Turner, 13 L. T. N. S. 746; Seb. 251.

1—Partlo v. Todd, 17 Can. S. C. R. 196.

2—*In re* Sanitas Co., 4 R. P. C. 533; 58 L. T. 166; Cartmell, 305.

Similar reasoning forbade the registration of "Somatose" as a trademark for a nourishing meat product; the Greek "Soma," genitive "Somatos," being the equivalent of the English "body;" "somat" being the root of many English words and "ose" a common English suffix. *In re* Farben-fabriken T. M. K., L. R. (1894) 1 Ch. D. 645.

settled what character of words so taken will be sustained as valid trademarks.

The English courts have consistently adhered to the rule announced by Chitty, J., in *Davis v. Stribolt*: "I am of the opinion that in reference to an article produced in a foreign country and imported into England, where it was previously unknown and without a name, the word used in that foreign country as the common term to describe or denote the article is not a fancy name within the meaning of the act." For these reasons the Norwegian words "Bokel" and "Bokol" (meaning "beer") were held not valid as trademarks for beer.[3]

A curious case is that of *Re Rotherham*. The house of Rotherham of Coventry had long made and exported watches to Tod & Co. of Alexandria, by whom they were sold, such watches bearing upon their dials the word "Tod" in Arabic characters; "Tod" as an Arabic substantive meaning "A high mountain." The Arabic word was registered as a trademark, Vice-Chancellor Bacon holding an order of the commissioners prohibiting registration of words in foreign languages invalid.[4]

The phrase "Flor Fina Prairie Superior Tabac" was held to be a valid trademark for cigars,[5] as have been the words "Tamar Indien" for lozenges,[6] "Intimidad" for cigars,[7] "El Destino," also for cigars,[8] "El Cabio" for tobacco,[9] and "La Favorita" for flour.[10] "Mazawattee," a compound of the Hindustani words "Maza," meaning taste or relish, and the Singalese "Wattee," meaning garden or estate, is a valid trademark because it conveys no meaning to any class of persons, English, Hindoo or Singalese, and has no reference to the quality of the goods.[11]

With reference to "Pepto-Mangan," used as a mark for a medicinal preparation, Judge Holt has said, "It seems, if

3—Davis v. Stribolt, 59 L. T. 854; Cartmell, 105.

4—*In re* Rotherham, 29 W. R. 503; Seb. 647.

5—Cope v. Evans, L. R. 18 Eq. 138; 30 L. T. N. S. 292; 22 W. R. 453; Seb. 433.

6—Grillon v. Guenin, W. N. 1877, p. 14; Seb. 532.

7—Carmcho v. Stephenson, 25 Sol. J. 929.

8—Pinto v. Badman, 8 R. P. C. 181; Cartmell, 270.

9—Solis Cigar Co. v. Pozo, 16 Colo. 388; 26 Pac. Rep. 556.

10—Menendez v. Holt, 128 U. S. 514; 32 L. Ed. 526

11—*In re* Densham, L. R. (1895) 2 Ch. D. 176.

analyzed by a person familiar with the Greek and German languages, somewhat descriptive, but I think it would seem to the general public to be an artificial and manufactured word." [12]

The rules thus far discussed in this section do not seem to apply to aboriginal words or sounds. The word (or sound) "Oomoo," taken from the language of the Australian aborigines, was admitted to English registration by Chitty, J., after a careful consideration;[13] on the other hand, the word "Kokoko," meaning "owl" in the language of the Chippeway Indians, was refused registration as a trademark for cotton goods.[14]

It was held in a dictum of the Supreme Court of Canada, in the very thoroughly considered case of *Partlo v. Todd,* that a descriptive foreign word, or a word in a dead language not known to people in general, because it is not understood, may become the trademark of the person who first uses it upon a particular article sold by him.[15] This theory has been affirmed by a New York state court and denied by Judge Showalter in the federal circuit court for the Northern District of Illinois, in two suits of the same complainant, involving the right to the word "Matzoon" as a trademark for a food product made of fermented milk. "Matzoon" or "Maadzoon" appears to be the sound of the name which Armenians give to a similar article made of fermented milk in Turkey. The New York court says: "I do not think that such a term can properly be regarded as descriptive in this country. It would be absolutely meaningless to all but a little group of Armenians in the millions of inhabitants of the United States. It would be equally meaningless in most of Europe. A Choctaw word would signify just as much. To the medical profession, among whom the plaintiff sought approval for his product, and to the drug trade, the name 'Matzoon' was practically an arbitrary or fanciful designation. It was not incorporated into the English language. It was derived from a language

12—M. J. Brietenbach Co. v. Spangenberg, 131 Fed. Rep. 160.

13—*In re* Burgoyne, 6 R. P. C. 227; 61 L. T. 39; Cartmell, 85.

14—*In re* Jackson Company's Trademark, 6 R. P. C. 80; Cartmell, 177.

15—Partlo v. Todd, 17 Can. S. C. R. 196-213.

hardly known here, and to the vest majority of our people it meant nothing. Hence the rule upon which the defendant relies has no application here." It was accordingly held to be a valid trademark.[16] That this rule is dangerous to the law of trademarks is apparent. If it is left to the courts to say when a descriptive word taken from a modern foreign language may or may not be used as a trademark, practically endless litigation is opened to future generations. The court forgot the rule that a trademark must be capable of universal use, and knows no territorial restriction.[17] As Chitty, J., remarked in *Davis v. Stribolt*: "If the argument were well founded, the importer into this country of any foreign article not previously known in this country could restrain any one else from using the name by which it was called in the country in which it was produced."[18] Upon the application to Judge Showalter for a preliminary injunction to restrain the use of the same word "Matzoon," that learned court said: "The strong contention is that Dr. Dadirrian introduced into this country a product which was unknown here, and by a name which was equally unknown, and that, since the name has become identified here with the article as made by him his property in the name should be recognized. But, as already said, the product was in fact old, as was also the name. The ignorance of people in this country touching it, its uses and its name, can not be treated as property, and be, in a manner, capitalized as an element in the goodwill of this complainant. This would be the case if no other dealer was permitted to tell what Matzoon is, and what a considerable portion of the human race has found it useful for, after an experience with it under that name which, according to the record, dates back some eight centuries." The application was accordingly denied, and the ruling of the trial court was followed in the first circuit and subsequently upheld by the United States Circuit Court of Appeals for that circuit.[19]

16—Dadirrian v. Yacubian, 37 N. Y. Supp. 611.

17—Subject to the exceptions noted *ante*, § 14.

18—Davis v. Stribolt, 59 L. T. N. S. 854, cited *supra*.

19—Dadirrian v. Yacubian, 72 Fed. Rep. 1010-1014; 75 Off. Gaz. 1856; followed in Dadirrian v. Yacubian (2), 90 Fed. Rep. 812. Latter case affirmed on appeal, Dadirrian v. Yacubian (3), 98 Fed. Rep.

The German word "Ansatz," meaning "Compound," has been refused registration as a trademark for bitters,[20] as have been the words "Chili Colorow" (meaning red pepper in provincial Spanish), as a trademark for codiments.[21]

Vice-Chancellor Shadwell held a complainant who marked watches manufactured by him for the Turkish trade with the Turkish word "Pessendede" (meaning warranted) in Turkish characters, entitled to the exclusive right to so mark his watches. This was, however, not necessary to the decision of the case, and was a mere dictum.[22]

The case of *Broadhurst v. Barlow* was that of plaintiffs who used, beside a symbol of a lion in a scroll, the words "Exactly 12 Yards," in Turkish, Armenian and Greek, upon the rolls of cloth made by them for exportation to Greece and Turkey. With other relief, the defendant was enjoined from using the words "Exactly 12 Yards" in the languages used by plaintiffs. This relief would seem to be incidental to the portion of the injunction which related to fanciful scrollwork used by both parties.[23]

The use of the word "Grenadine" as a trademark for a syrup made of pomegranite juice was protected by injunction against a defendant who began the sale of another syrup under the name of "Grenade Syrup," notwithstanding the word "Grenade" in French signifies "Pomegranite." This was purely a case of unfair competition.[24] The patent office has refused registration for the words "Fur Familien-Gebrauch" (For

872; 39 C. C. A. 321. Followed in Selchow v. Chaffee & Selchow Mfg. Co., 132 Fed. Rep. 996.

20—*In re* Weisman, Newton, Dig. 119.

21—*In re* Railton, Newton, Dig. 213.

22—Gout v. Aleploglu, 6 Beavan, 69; 5 Leg. Obs. 495; Seb. 51.

23—Broadhurst v. Barlow, W. N. 1872, p. 212; L. J. Notes of Cases, p. 183; Seb. 411. The use of labels printed in several languages was enjoined in Siegert v. Findlater, L. R. 7 Ch. D. 801; Siegert v. Ehlers, Seb. 432; Curtis v. Bryan, 2 Daly, 212; Cox, 434; Siegert v. Abbott (2), Cox, Manual, 718; Societe Anonyme v. Western Distilling Co., 43 Fed. Rep. 416; Fischer v. Blank, Cox, Manual, 731; 138 N. Y. 244.

24—Rillet v. Carlier, 61 Barb. S. C. 435; 11 Abb. Pr. N. S. 186; Seb. 334. The word "Ethiopian" printed in Egyptian characters upon stockings was protected from infringement, but in a case of unfair competition. Hine v. Lart, 10 Jur. 106; 7 L. T. 41.

Family Use) and "Lawrence Feiner Familien-Flannel" (Lawrence Fine Family Flannel), but upon the ground that they were mere words in common use and not distinctive.[25] And it is now the fixed rule of that office that no descriptive words reproduced in letters from a foreign language will be admitted to registration, when registration would be refused to their English equivalents.[26]

The Court of Chancery of New Jersey has held that the French "brassiere" (brace) is not susceptible of appropriation as a trademark for a combined corset cover and bust supporter,[27] and a similar ruling has been made as to the Italian "Conserva Di Tomate" (preserved tomato).[28] So also of "Tipo Chianti" (Chianti Type) for wine.[29]

§ 60. Words become generic through use.—A word originally fanciful and indicative of origin or ownership may through the laches of the owner become *publici juris*. Thus the word "Chlorodyne," while originally a good trademark, became generic through the failure of the manufacturer to prosecute a suit brought by him to restrain its use,[30] and because it had become the name of the article.[31] This, of course, is substantially a holding that the trademark has been abandoned by the owner's neglect. The American courts have been averse

25—*In re* Lawrence & Co., 10 Off. Gaz. 163; Seb. 504.

26—*Ex parte* Stuhmer, 86 Off. Gaz. 181. In this case the applicant sought registration for the words "Gold Label" produced in Hebrew characters.

27—Charles R. De Bevoise Co. v. H. & W. Co., 60 Atl. Rep. 407; 69 N. J. Eq. 114.

28—Roncoroni v. Gross, 86 N. Y. Supp. 1112.

29—Italian Swiss Colony v. Italian Vineyard Co., 158 Cal. 252; 110 Pac. Rep. 913.

30—Browne v. Freeman (1), 12 W. R. 305; 4 N. R. 476.

31—Browne v. Freeman (2), W. N. 1873, 178; to same effect, see Amoskeag Mfg. Co. v. Garner, 55 Barb. 151; 6 Abb. Pr. N. S. 265; Cox, 541.

In this case the controlling fact was that the complainant's and defendant's marks were used on different classes of goods. The court, however, expressly names the laches of the complainant as a ground for withholding relief, citing, in support of this proposition, *inter alia*, the opinion of Chancellor Walworth in Smith v. Adams, 6 Paige, 435-443; and the copyright case of Lewis v. Chapman, 3 Beavan, 133, where a delay of six years was held to disentitle the plaintiff from relief.

to so holding. It was said in *Taylor v. Carpenter* that the court was "not aware that a neglect to prosecute, because one believed he had no rights, or from mere procrastination, is any defense at law, whatever it may be in equity, except under the statute of limitations pleaded and relied on, or under some positive statute, like that as to patents, which avoids the right if the inventor permits the public to use the patent some time before taking out letters."[32] Words primarily indicative of origin or ownership remain valid as trademarks notwithstanding the fact that the articles to which they are applied may obtain such extensive sales that the marks have also become indicative of quality.[33]

Whether or not a word has become public property, in that it has acquired a generic meaning, descriptive of a general kind, quality, or class of goods is a pure question of fact to be determined from the evidence in each particular case.[34]

§ 61. The use of generic names protected.—Possibly the widest deviation from the narrow path of trademark protection which has been accomplished by the law of unfair competition is to be found in the cases involving the deceptive use of generic terms. The Supreme Court of the United States has held in regard to the name of a person used as a descriptive name of a patented article, during the life of a patent, that while that name becomes *publici juris* upon the expiration of the patent, it must be so used by manufacturers other than the original maker as not to deceive the public into the belief that the goods offered for sale are the goods of such original maker.[35] The same rule has been established in England.[36]

So it was held by Mr. Justice McKenna, when circuit judge, that "Syrup of Figs" was entitled to injunctive protection.

32—Taylor v. Carpenter, 2 Wood. & M. 1; 9 L. T. 514; Cox, 32.

33—Burton v. Stratton, 12 Fed. Rep. 696-702; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-547; 34 L. Ed. 997.

34—Williams Mfg. Co. v. Noera, 158 Mass. 110; 32 N. E. Rep. 1037.

35—Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169; 41 L. Ed. 118; Singer Mfg. Co. v. Bent, 163 U. S. 205; 41 L. Ed. 131. See also, to the same effect, Fairbanks v. Jacobus, 14 Blatchf. 337; Fed. Case No. 4608; Adee v. Peck Bros. & Co., 39 Fed. Rep. 209; Singer Mfg. Co. v. Brill, Cox, Manual, 672.

36—Singer Mfg. Co. v. Loog, H. L. 8 A. C. 15; 53 L. J. Ch. 481; 48 L. T. 3; 31 W. R. 325; Cartmell, 306.

He said: "Respondent urges that the words 'Syrup of Figs' are descriptive, and that complainant deceives when it uses them to designate its compound: The deceit does not appear on the face of the bill, and it is unimportant if they are descriptive. The question is now, not whether complainant has the exclusive right to use the words 'Syrup of Figs' or 'Fig Syrup,' but it is whether respondent has, by use of them and other words, and by the other imitations alleged and exhibited, so far imitated the form of complainant's device and description to represent its goods as its goods, and appropriate its reputation and trade. The *gravamen* of the action is the simulation of complainant's devices and the deception of purchasers. This is the principle of the best considered cases, uniting them, notwithstanding their diverse facts."[37]

In affirming the decision of Judge McKenna, however, the Circuit Court of Appeals held that "Syrup of Figs" was not a generic name.[38] The later case of *California Fig Syrup Co. v. Worden*[39] put the plaintiff's right to relief upon the proper ground of unfair competition, aside from any technical trademark right in the words.

37—California Fig Syrup Co. v. Improved Fig Syrup Co., 51 Fed. Rep. 296-297; citing Burton v. Stratton, 12 Fed. Rep. 696; Baking Powder Co. v. Fyfe, 45 Fed. Rep. 799; Nervo Food Co. v. Baumbach, 32 Fed. Rep. 205; Anonyme, etc., Societe v. Western Dis. Co., 43 Fed. Rep. 417.

38—Improved Fig Syrup Co. v. California Fig Syrup Co., 4 C. C. A. 264; 54 Fed. Rep. 175-178. It is very difficult to understand how the court could conclude that "Syrup of Figs" was not a generic name. It lacks every requisite of a valid trademark, and is undoubtedly either deceptive or merely descriptive of one of the ingredients of the medicine (a liquid laxative). It has been so held in California Fig Syrup Co. v. Stearns, 67 Fed. Rep. 1008; s. c., 73 Fed. Rep. 812-814; California Fig Syrup Co. v. Putnam, 66 Fed. Rep 750. Since the foregoing was written, the United States Supreme Court has held the mark to be deceptive. Clinton E. Worden & Co. v. California Fig Syrup Co., 187 U. S. 516; 47 L. Ed. 282; reversing Clinton E. Worden & Co. v. California Fig Syrup Co., 42 C. C. A. 383; 102 Fed. Rep. 334; the latter affirming the injunction granted *in limine* in California Fig Syrup Co. v. Clinton E. Worden & Co., 86 Fed. Rep. 212, and on final hearing in California Fig Syrup Co. v. Worden, 95 Fed. Rep. 132.

39—(1) 86 Fed. Rep. 212-215; California Fig Syrup Co. v. Worden (2), 95 Fed. Rep. 132.

From the doctrine stated by the Federal Supreme Court [40] it follows that the designs, symbols and marks used by a patentee during the life of the patent upon packages containing the patented article may not be imitated by another upon the expiration of the patent, and such imitation will be enjoined.[41]

The rule of unfair competition, that no man has a right to represent his goods as the goods of another, is distinctly applied in several of the more recent English decisions to terms strictly generic and of which technical trademark rights could not be predicated. Thus where the manufacturers of "Reddaway Camel Hair Belting" sought to enjoin a rival manufacturer from styling his product "The Bentham Camel Hair Belting," Lord Justice Lindley, in the Court of Appeal, said: "The catch-words are 'Camel Hair Belting.' * * * The use of the catch-words alone may establish the plaintiff's right to relief. The plaintiffs have no right to the exclusive use of these words; but they have a right to restrain any one from so using them as to pass his goods off as the goods of the plaintiffs." [42] So an injunction was granted. Very similar to this was the case in which the plaintiffs manufactured a soap under the name "The Self-Washer." The defendants thereafter applied the term "Self-washing" to their soaps. It was held that the terms "Self-washer" or "Self-washing" were used in a descriptive sense and therefore neither could be appropriated as a valid technical trademark; but because of the paper used by the defendants in wrapping their soap, being an imitation parchment paper, and the type used by them, which closely resembled that used by the plaintiffs the defendants were enjoined. Lord Justice Cotton, in the Court of Appeal, observing: "There may be no monopoly at all in the individual things separated, but if the

40—Singer Mfg. Co. v. June, 163 U. S. 169; 41 L. Ed. 118; Singer Mfg. Co. v. Bent, 163 U. S. 205; 41 L. Ed. 131.

41—Greene v. Woodhouse, 38 Off. Gaz. 1891; Centaur Co. v. Killenberger, 87 Fed. Rep. 725; Same v. Robinson, 91 Fed. Rep. 889; Same v. Neathery, 91 Fed. Rep. 891; Same v. Hughes Bros. Mfg. Co., 91 Fed. Rep. 901. In this connection it is probable that the name by which the patented article was known during the life of the patent (if otherwise valid as a trademark) may be continued in use, with the prefix "original." Cocks v. Chandlers, L. R. 11 Eq. 447.

42—Reddaway v. Bentham Hemp Spinning Co., 9 R. P. C. 503; L. R. (1892) 2 Q. B. 639; 67 L. T. 301; Cartmell, 282.

whole are so joined together as to attempt to pass off, and to have the effect of passing off the defendants' soap as the plaintiffs', then, although the plaintiffs have no monopoly either in 'Self-washing' or 'Self-washer' or in the parchment paper or in the spaced printing, yet if those things in which they have no sole right are so combined by the defendants as to pass off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the old common-law doctrine in respect of which equity will give to the aggrieved party an injunction in order to restrain the defendant from passing off his goods as those of the plaintiff."[43]

These cases, with those cited in the foot-note, will sufficiently demonstrate the fact that the rule under consideration is not only important but well established, and that the user of a strictly generic term will be protected in the business he has established under that term, as against a dishonest use of it by a competitor.[44]

The doctrine of unfair competition, by which the use of descriptive words has sometimes been restrained, has engrafted upon it this important qualification—than in no case will the use of a merely descriptive word be restrained as deceptive, unless in circumstances which show fraud on the part of the user.[45] The English leading cases upon this proposition are the "Camel Hair Belting" case,[46] to which we have already re-

43—Lever v. Goodwin, 4 R. P. C. 492-506; 36 Ch. D. 1; 57 L. T. 583; 36 W. R. 177; Cartmell, 209.

44—Lever v. Bedingfield, 80 L. T. N. S. 100; Barlow v. Johnson, 7 R. P. C. 395; Cartmell, 73; Curtis v. Pape, 5 R. P. C. 146; Cartmell, 105; Jay v. Ladler 6 R. P. C. 136; 40 Ch. D 649; 60 L. T. 27; 37 W. R. 505; Cartmell, 184; Powell v. Birmingham Vinegar Brewery Co., L. R. (1894) 3 Ch. D. 449-462; Reddaway v. Banham, L. R. (1896) A. C. 199; Brown Chemical Co. v. Meyer, 31 Fed. Rep. 453; Jennings v. Johnson, 37 Fed. Rep. 364; Meyer v. Bull Medicine Co., 7 C. C. A. 558; 58 Fed. Rep. 884; Morgan Envelope Co. v. Walton, 30 C. C. A. 383, 86 Fed. Rep. 605; VanHorn v. Coogan, 52 N. J. Eq. 380; 28 Atl. Rep. 788; Anheuser-Busch Brewing Ass'n v. Fred Miller Brewing Co., 87 Fed. Rep. 864; Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326; Goodman v. Bohls, 3 Tex. Civ. App. 183; 22 S. W. Rep. 11.

45—Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326-341. The language of the text is quoted and approved by Ray, J., in Rushmore v. Saxon, 158 Fed. Rep. 499, 509.

46—Reddaway v. Banham, L. R. (1896) A. C. 199.

ferred, and the "Cellular Clothing" case.[47] In the former case the defendant said expressly that by using the term "Camel Hair Belting" he would be enabled to sell his goods as those of the plaintiff. Each case involved the use of a descriptive word. In the belting case, however, the word had acquired an additional meaning. The mere use of the words "Camel's Hair" had come to be understood in the trade as indicating belting of the plaintiff's manufacture. It was proved in addition to this that the defendant's acts were done in consummation of a fraudulent design to sell his goods as those of the plaintiff. For these reasons the use of the words by the defendant was restrained.[48] The Cellular Clothing case differed from this on the facts. As in the belting case, the words "Cellular Clothing" were originally purely descriptive, being applied to a cloth of cellular structure. It was not shown that the term had so acquired a technical and secondary meaning, arising from its natural meaning, that it could be excluded from the use of every one else,[49] and it was not shown that the defendant had intended to defraud the plaintiff, or that any one had bought of the defendant in the belief that he was getting plaintiff's goods.[50] The Cellular Clothing case demonstrates very clearly that one who takes upon himself to prove that words which are merely descriptive or expressive of the quality of the goods have acquired a secondary meaning and indicate that the goods are of his manufacture has assumed a burden which, while it is not impossible, is, in the language of Lord Davey, "at the same time extremely difficult to discharge—a much greater burden than that of a man who undertakes to prove the same thing of a word, not significant and not descriptive, but what has been compendiously called a 'fancy' word."[51]

47—Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326.

48—See opinion of Lord Halsbury in Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326-335, and Reddaway v. Banham, L. R. (1896) A. C. 199, 204, 205.

49—Lord Halsbury in Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326-337.

50—Lord Watson in Cellular Clothing Co. v. Maxton, L. R. (1899) 326-337.

51—Lord Davey in Cellular Clothing Co. v. Maxton, L. R. (1899) 326-343.

§ 62. "Distinctive names," under the Food and Drugs Act (June 30, 1906, Chap. 3915, 34 Stat. at L. 768).—Whether a name used in a trademark capacity on an article of food or drink can be held to be a mis-branding under the Food and Drugs Act is a problem of considerable difficulty in some cases.

The expression "distinctive names" as used in the act itself, sec. 8, has been further illuminated by regulation 20, adopted October, 1906, and providing as follows:

> "(a) A 'distinctive name' is a trade, arbitrary, or fancy name which clearly distinguishes a food product, mixture, or compound from any other food product, mixture, or compound.
>
> "(b) A distinctive name shall not be one representing any single constituent of a mixture or compound.
>
> "(c) A distinctive name shall not misrepresent any property or quality of a mixture or compound.
>
> "(d) A distinctive name shall give no false indication of origin, character, or place of manufacture, nor lead the purchaser to suppose that it is any other food or drug product."

We are, of course, interested only in those cases in which the trademark or tradename itself is charged to be misbranding. The charge of misbranding turns necessarily upon the question of the name having true trademark quality. It is difficult to conceive of a true word trademark constituting a misbranding in its use.

But tradenames having no trademark quality, for example "London Dry Gin,"[52] "Grenadine Syrup,"[53] and the like, may not constitute the basis for a charge of misbranding when interpreted by the evidence to relate to a well-known class or kind of merchandise.

The United States Supreme Court has elaborated the subject under discussion as follows:

"A distinctive name is a name that distinguishes. It may be a name in common use as a generic name, *e. g.*, coffee, flour, etc. Where there is a trade description of this sort by which

52—United States v. Thirty-Six Bottles, 205 Fed. Rep. 111; but compare 210 Fed. Rep. 271.

53—United States v. Thirty Cases, 199 Fed. Rep. 932.

a product of a given kind is distinctively known to the public, it matters not that the name had originally a different significance. Thus, soda water is a familiar trade description of an article which now, as is well-known, rarely contains soda in any form. Such a name is not to be deemed either 'misleading' or 'false,' as it is in fact distinctive. But unless the name is truly distinctive, the immunity can not be enjoyed; it does not extend to a case where an article is offered for sale 'under the distinctive name of another article.' Thus, that which is not coffee, or is an imitation of coffee, can not be sold as coffee; and it would not be protected by being called 'X's Coffee.' Similarly, that which is not a lemon extract could not obtain immunity by being sold under the name of 'Y's Lemon Extract.' The name so used is not 'distinctive,' as it does not appropriately distinguish the product; it is an effort to trade under the name of an article of a different sort. So, with respect to 'mixtures or compounds,' we think that the term 'another article' in the proviso embraces different compounds from the compound in question. The aim of the statute is to prevent deception, and that which appropriately describes a different compound can not secure protection as a 'distinctive name.'

"A 'distinctive name' may also, of course, be purely arbitrary or fanciful, and thus, being the trade description of the particular thing, may satisfy the statute, provided the name has not already been appropriated for something else so that it's use would tend to deceive."[54]

§ 63. Systems of licensing and inspection of goods made from a basic ingredient bearing a trademark.—The manufacturer of a basic ingredient, such as a syrup, which is known by a trademark or tradename, and which is to be treated by the trade by the addition of a diluent, has the right to maintain the integrity of his product by controlling the use of his basic ingredient, to the extent of granting exclusive licenses and maintaining a system of inspection of the final product as sold

54—United States v. Forty Barrels, 241 U. S. 265; 60 L. Ed. —; reversing the judgment in 191 Fed. Rep. 431, which was affirmed, 215 Fed. Rep. 535; 132 C. C. A. 47 (C. C. A. 6). For the same question under the New York statute, see Crescent Mfg. Co. v. Wilson, 233 Fed. Rep. 282.

to the consumer. A system of contracts of this kind was attacked as being in violation of the Sherman Act (July 2, 1890, c. 647, 26 Stat. at L. 209 and amendments), to which defense the court responded: "The trademark laws, like the patent laws, give the owner a monopoly which neither the Sherman Act nor any other Act of Congress forbids. It would be a paradox to say that the exercise of a right, expressly granted by law, is unlawful."[55] In the same case the defendant, an infringer, urged the contracts in question to be in violation of sec. 3 of the "Clayton Act" (October 15, 1914, c. 323, 38 Stat. at L. 730), reading—

> "That it shall be unlawful for any person engaged in commerce, in the course of such commerce, to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies or other commodities, whether patented or unpatented, for use, consumption or resale within the United States or any territory thereof or the District of Columbia or any insular possession or other place under the jurisdiction of the United States, or fix a price charged therefor, or discount from, or rebate upon, such price, on the condition, agreement or understanding that the lessee or purchaser thereof shall not use or deal in the goods, wares, merchandise, machinery, supplies or other commodities of a competitor or competitors of the lessor or seller, where the effect of such lease, sale, or contract for sale or such condition, agreement or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce."

It was argued that the plaintiff's contracts made it impossible for the defendant to secure the plaintiff's product, and that the plaintiff had actually refused to sell that product to the defendant. This defense was disposed of by the court saying "whether that act is to be construed so as to compel one to sell his wares or manufactures to any one applying therefor can not be determined in this case, as this is not an action to obtain relief of that nature, and is therefore not involved."[56]

55—Trieber, J., in Coca-Cola Co. v. Butler, 229 Fed. Rep. 224, 232.

56—*Ibid.* at p. 233, citing, for the interpretation of the Clayton Act, Union Pacific Coal Co. v. United States, 173 Fed. Rep. 737; 97 C. C. A. 578; Great Atlantic & Pacific Tea Co. v. Cream of Wheat Co., 224 Fed. Rep. 566, affirmed 227 Fed. Rep. 26 (C. C. A. 2).

§ 64. The test of "origin or ownership."—One of the primary methods—if indeed it is not the fundamental test—in determining the validity of a trademark has been broadly announced by the Supreme Court of the United States in these words: "The office of a trademark is to point out distinctively the origin or ownership of the article to which it is affixed, or, in other words, to give notice who was the producer."[57] And it has recently been said: "That such mark or symbol (*i. e.*, any mark or symbol claimed as trademark) must be designed, as its primary object and purpose, to distinguish each of the articles to which it is affixed from like articles produced by others, seems to be the clear consensus of all the cases which are authoritative."[58]

Substantially this form of expression has been employed by the American courts from their earliest trademark decisions. Our profoundly learned chancellor, Walworth, stated the rule as well as any court that has followed him, when he said: "The court proceeds upon the ground that the complainant has a valuable interest in the goodwill of his trade or business. And that having appropriated to himself a particular label, or sign or trademark, indicating to those who wish to give him their patronage that the article is manufactured or sold by him, or by his authority, or that he carries on business at a particular place, he is entitled to protection against a defendant who attempts to pirate upon the goodwill of the complainant's friends or customers, or the patrons of his trade or business, by sailing under his flag without his authority or consent."[59] In the light of this statement, the words of the supreme court assume a broader meaning. In 1849, the year following that in which the opinion last quoted from was rendered, it was said in an opinion of the Superior Court of New York City,

57—Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311; 20 L. Ed. 581; 5 Am. L. T. 136; 1 Off. Gaz. 279; Seb. 327.

58—Lurton, J., in Deering Harvester Co. v. Whitman-Barnes Mfg. Co., 33 C. C. A. 558, 91 Fed. Rep. 376-378; citing Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311; 20 L. Ed. 281; Amoskeag Mfg. Co. v. Trainer, 101 U. S. 54; 25 L. Ed. 993; Lawrence Mfg. Co. v Tennessee Mfg. Co., 138 U. S. 537; 34 L. Ed. 997; Columbia Mill Co. v. Alcorn, 150 U. S. 460; 37 L. Ed. 1144.

59—Partridge v. Menck, 2 Sand. Ch. 622; 2 Barb. Ch. 101; 1 How. App. Cas. 558; Cox, 72; Seb. 91.

that "the owner of a trademark has no right to an exclusive use of any words, letters, figures or symbols which have no relation to the origin or ownership of the goods."[60] And the same court, by the same judge (Duer), repeated the statement in very nearly the same words in 1857, saying that a name could be rightfully used and protected as a trademark only "where the name is used merely as indicating the true origin or ownership of the article offered for sale, never where it is used to designate the article itself and has become, by adoption and use, its proper appellation."[61] And in 1868, the Supreme Court of California stated the rule to be that trademarks will be protected "only so far as such marks serve to designate the true origin or ownership of the goods to which they are attached."[62] So that when the doctrine as first stated by the federal supreme court was announced, it had become well settled in our jurisprudence that a trademark must indicate origin or ownership, and the only difficulty presented by the maxim to bench and bar is that of its application to each new state of facts as it arises. It must be noted, however, that "It is, of course, no fatal objection to the validity of a trademark that it does not include the name of the manufacturer or producer. The sign, symbol or mark may be purely fanciful, and convey no information as to the name of the producer. But the essential thing is that it shall be designed and used to indicate the origin of the article and that all articles having the same mark come from a common source."[63]

It is self-evident that while a mark may be indicative of origin and ownership, it may, because generic or deceptive, fall short of being a valid trademark. But every valid trademark must be indicative of origin or ownership in the sense in which those words are used in the decisions.

60—Amoskeag Mfg. Co. v. Spear, 2 Sand. S. C. 599; Cox, 87; Seb. 100.

61—Fetridge v. Wells, 4 Abb. Pr. 144; 13 How. Pr. 385; Cox, 180; Seb. 144.

62—Falkinburg v. Lucy, 35 Cal. 52; and Eggers v. Hink, 63 Cal. 445. See also Osgood v. Allen (Maine), 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124; Seb. 410.

63—Lurton, J., in Deering Harvester Co. v. Whitman & Barnes Mfg. Co., 33 C. C. A. 558, 91 Fed. Rep. 376-380. To the same effect see Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651-656.

One who manufactures for the trade, furnishing his goods in cartons having labels which represent the dealer to be the manufacturer, can not enjoin such dealer from the use of the same cartons when they cease to buy the goods from him.[64]

§ 65. Geographical names.—The rule that geographical names can not be exclusively appropriated for the purposes of trademark has been recognized from the infancy of trademark law. It was said by the United States Supreme Court that "No one can apply the name of a district of country to a well-known article of commerce and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation. It is only when the adoption or imitation of what is claimed to be a trademark amounts to a false representation, express or implied, designed or incidental, that there is any title to relief against it.'[65]

64—Shelley v. Sperry, 121 Mo. App. 429; 99 S. W. Rep. 488.

65—Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311; 20 L. Ed. 581; 5 Am. L. T. 135; 1 Off. Gaz. 279; Seb. 327; and to the same effect, see Columbia Mill Co. v. Alcorn, 150 U. S. 460; 37 L. Ed. 1144; Candee, Swan & Co. v. Deere & Co., 54 Ill. 439; 5 Am. Rep. 125; 4 Am. L. T. 266; 10 Am. L. Reg. N. S. 694; Seb. 339; *In re* Tolle, 2 Off. Gaz. 415; Seb. 405; Osgood v. Allen, 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124; Seb. 410; Glendon Iron Co. v. Uhler, 75 Pa. St. 467; 15 Am. Rep. 599; 13 Am. L. Reg. N. S. 543; 6 Off. Gaz. 154; Seb. 439; Bulloch, Lade & Co. v. Gray, 19 Journ. of Jurisp. 218; Seb. 452; Wolfe v. Goulard, 18 How. Pr. 64; Clinton Met. Paint Co. v. N. Y. Met. Paint Co., 50 N. Y. Supp. 437; Gabriel v. Sicilian Asphalt Co., 52 N. Y. Supp. 722; Morgan Envelope Co. v. Walton, 30 C. C. A. 383, 86 Fed. Rep. 605; Wm. Rogers Mfg. Co. v. Rogers & S. Mfg. Co., 11 Fed. Rep. 495; Burgess v. Burgess, 17 Eng. L. & Eq. 257; Brooklyn White Lead Co. v. Masury, 25 Barb. 416; Lea v. Wolff, 13 Abb. Pr. N. S. 389; 15 *Id.* 1; 46 How. Pr. 157; 1 Am. L. T. N. S. 400; Seb. 407; Carmichel v. Latimer, 11 R. I. 395; Eggers v. Hink, 63 Cal. 445; Dunbar v. Glenn, 42 Wis. 118; Anheuser-Busch Brewing Association v. Pisa, 23 Blatchf. 245; Lea v. Deakin, Fed. Case No. 8154, 11 Biss. 23; Pratt's Appeal, 117 Pa. St. 401; Smith v. Walker, 37 Mich. 456; Smith v. Imus, 32 Alb. L. J. 455; Burton v. Stratton, 12 Fed. Rep. 696; Evans v. Van Laer, 32 Fed. Rep. 153; Gabriel v. Sicilian Asphalt Co. (2), 56 N. Y. Supp. 30; Gebbie v. Stitt, 31 N. Y. Supp. 102; Weyman v. Soderberg, 108 Fed. Rep. 63; Telephone Mfg. Co. v. Sumter Mfg. Co., 63 S. C. 313;

§ 66. As employed by sole owner of a natural product and its place of production.—There can be no doubt that, where the owner of a geographical site productive of a salable article is the sole owner, he may have an exclusive right in the name of his site. This rule has been followed in several cases where the proprietor of the commodity was the owner of the place of its production, and the name of that place was a prominent and controlling part of the trademark. Lord Cranworth so held in the case of a wine-grower who used the name of his vineyard as a trademark for his wines.[66] And the use of the words "Congress Water" as designating the product of "Congress Spring" was sustained on the suit of the sole owner of the springs.[67]

§ 67. When geographical names will be protected as trademarks.—In many cases the use of geographical words has been protected on the ground of unfair competition. It was so held where the complainants applied the word "Durham," the name of a town in North Carolina, to tobacco manufactured by them at that locality. The defendant, whose business was conducted at Richmond, was enjoined from applying the word to tobacco produced by him.[68] And the usual rule by which geographical names have been protected against infringers by injunction was thus tersely stated by the Patent Office: "Undoubtedly courts of equity have granted injunctions to restrain the fraudulent use of words of this character; but the grounds of such decisions have been invariably, I think, the fraud of the defendants, and not any exclusive right of the plaintiffs."[69]

41 S. E. Rep. 322. Even though the word "Raleigh" was that of an historical personage, registration was refused because it was also a geographical name. *Ex parte* Oliver, 18 Off. Gaz. 923; Price & Steuart, 59; Esselstyn v. Holmes, 42 Mont. 507; 114 Pac. Rep. 118.

66—Seixo v. Provezende, L. R. 1 Ch. 192; 12 Jur. N. S. 215; 14 L. T. N. S. 314; 14 W. R. 357; Seb. 256.

67—Congress & Empire Spring Co. v. High Rock Congress Spring Co., 4 Am. L. T. 168; 10 Abb. Pr. N. S. 348; 6 Am. Rep. 82; 57 Barb. 526; 45 N. Y. 291; Cox, 599; to the same effect, see La Republique Francaise v. Schultz, 57 Fed. Rep. 37; City of Carlsbad v. Kutnow, 68 Fed. Rep. 794; s. c., 71 Fed. Rep. 167; City of Carlsbad v. Schultz, 78 Fed. Rep. 469; Notheutt v. Turney, 101 Ky. 314; 41 S. W. Rep. 21.

68—Blackwell & Co. v. Dibrell & Co., 3 Hughes, 151; Fed. Case No. 1,475; Price & Steuart, 10.

69—*Ex parte* Farnum & Co., 18 Off. Gaz. 412; Price & Steuart, 68

Probably a more accurate statement, however, is that of the United States Circuit Court of Appeals in the very well considered opinion in *Pillsbury-Washburn Co. v. Eagle:*[70] "The distinction, both in the English and American cases, is between those where a geographical name has been adopted and claimed as a trademark proper, and those where it has been adopted first as merely indicating the place of manufacture, and afterwards, in the course of time, has become a well-known sign and synonym for superior excellence. In the latter class of cases, persons residing at other places will not be permitted to use the geographical name so adopted as a brand or label for similar goods for the mere purpose, by fraud and false representation, of appropriating the goodwill and business which long continued industry and skill and a generous use of capital has rightfully built up. It will be of no avail in such cases, where the facts are admitted or proven, to allege a want of power in a court of equity to find a remedy." In other words, geographical names can never be appropriated as trademark; but with the development of the law of unfair competition has come the incidental protection of geographical names applied to merchandise, not as technical trademark, but as an indication to the public of the true place of its manufacture. And no manufacturer can defend, any more than he could maintain, a suit in equity, where he is falsely representing the place where his manufacture is conducted.

§ 68. Geographical names—The underlying principle.—Judge Lacombe has recently given this concise expression of

70—86 Fed. Rep. 608; 30 C. C. A. 386; overruling s. c., 82 Fed. Rep. 816. The false use of a geographical name will not be tolerated when it is so used as to promote unfair competition and to induce the sale of spurious goods. Collins-platt v. Finlayson, 88 Fed. Rep. 693.

"Whatever might have been the doubts some years ago, we think that now it is pretty well settled that the plaintiff, merely on the strength of having been first in the field may put later comers to the trouble of taking such reasonable precautions as are commercially practicable to prevent their lawful names and advertisements from deceitfully diverting the plaintiff's custom." This was said of the word "Waltham" as applied to watches by Holmes, J., in American Waltham Watch Co. v. United States Watch Co., 173 Mass. 85; 53 N. E. Rep. 141; followed in American Waltham Watch Co. v. Sandman, 96 Fed. Rep. 330.

the rule applied by courts of equity to geographical names falsely used in unfair competition: "Whatever may be the decisions in the state courts, it is abundantly settled by authority in the federal courts that they will not tolerate a false use of a geographical name when it is so used as to promote unfair competition and to induce the sale of spurious goods."[71] In a later case, the rule has been illustrated and applied as follows: "The respondents concede that they put up in cans pears grown in Maryland and adjoining states, and keep the cans without labels until they are sold, and then, at the desire of their customers, they label them as California pears, canned by some pretended packer at some place in California. This is a clear case of fraudulent competition by the use of a geographical name which the complainants are entitled to use, but the respondents are not. It is true that no one single packer can acquire an exclusive right to use as a private trademark, 'California Pears,' or 'California,' as a label on canned pears; but all the persons who put up California grown pears in California have a right to use it; and it has acquired, the bill alleges, an especial trade significance of value. With regard to articles of food, and particularly with regard to fruits, the place where they are grown creates often an essential distinction as to quality and flavor; and this distinction, when it has become known in trade by the geographical name of the place where grown, the growers of the fruit are entitled to the benefit of, and the consumers should not be deceived. The present is such a case, and presents, I think, indisputable ground for application of the equitable jurisdiction which prevents unfair and fraudulent competition by simulated trade designations."[72]

71—Collinsplatt v. Finlayson, 88 Fed. Rep. 693. To the same effect see Jewish Colonization Ass'n v. Solomon (2), 154 Fed. Rep. 157; International Cheese Co. v. Phenix Cheese Co., 103 N. Y. Supp. 362.

72—Morrow, J., in California Fruit Canners' Ass'n v. Myer, 104 Fed. Rep. 82, citing Pillsbury-Washburn Co. v. Eagle, 30 C. C. A. 386; 86 Fed. Rep. 608-618. The leading English case is the Stone Ales Case, Thompson v. Montgomery (1891), App. Cas. 217; 8 R. P. C. 365. Of this decision a very learned English law writer has said: "There are dicta in the Stone Ales Case, in the House of Lords, which suggest that a practical monopoly might be acquired of the use of the name of a place where goods are manufactured; but they must, it is submitted, be read by reference to the facts of the case, which was one of deliberate fraud." Kerly on Trademarks (London, 1894), p. 44.

The Supreme Court of the United States has clearly excluded geographical names from use as technical trademarks.

It was said by Mr. Justice Jackson: "The general principles of law applicable to trademarks, and the conditions under which a party may establish an exclusive right to the use of a name or symbol, are well settled by the decisions of this court, * * * which * * * establish the following general propositions: * * * (3) That the exclusive right to the use of the mark or device claimed as a trademark is founded on priority of appropriation; that is to say, the claimant of the trademark must have been the first to use or employ the same on like articles of production. (4) Such trademarks can not consist of words in common use as designating locality, section, or region of country."[73]

The reasons for this rule have been more fully expressed by Mr. Justice Strong, in these words: "No one can claim protection for the exclusive use of a trademark or tradename, which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected; for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trademark, and the exclusive use of it be entitled to a legal protection. * * * He has no right to appropriate a sign, or a symbol, which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. And it is obvious that the same reasons which forbid the exclusive appropriation of generic names, or of those merely descriptive of the article manufactured, and which can be employed with truth by other manufacturers, apply with equal force to the appropriation of geographical names designating districts of country. Their nature is such that they can not point to the origin (personal origin) of the articles of trade to which they may be applied. * * * It must be considered as sound doctrine than no one can apply the name of a district of country to a well-known article of commerce, and obtain thereby such an exclusive right to the

73—Columbia Mill Co. v. Alcorn, 150 U. S. 460; 37 L. Ed. 1144

application as to prevent others inhabiting the district, or dealing in similar articles coming from the district, from truthfully using the same designation."[74]

Is it not a reasonable conclusion from these and the kindred cases which we have heretofore examined, that there can be no technical trademark in a geographical name? To the author's mind that conclusion is inevitable, and there is but one class of geographical names which are to be excepted from the operation of the rule, namely, those applied to a natural product and its sole place of production. The name so used may very properly be a trademark, indicative of the origin and ownership of the natural product, and at the same time indicating the locality of its production. Here the name undoubtedly is a trademark if there is but one owner of the entire locality, and the courts have uniformly so held.[75] The same scientific objection to geographical names as trademarks obtains as in the case of proper names. They are generic, in that every manufacturer who sees fit to locate in that city or vicinage and inaugurate a competing business has an equal right with all those who have preceded him in the locality, and all those who may thereafter so locate, in using the name of that locality in advertising his wares and in preparing them for commerce.[76]

Being generic they can not be used as trademarks, with the one exception we have noted, that of the title to the entire locality being vested in one owner. In that case no one else can locate there and institute competition; the name of the locality is not generic, and that fact exempts it from the operation of the rule.

In the course of a well-considered opinion Judge Showalter has held the name "Elgin" as applied to watch-movements

74—Delaware & Hudson Canal Co. v. Clark, 13 Wall. 323; 20 L. Ed. 581.

75—City of Carlsbad v. Schultz, 78 Fed. Rep. 469; City of Carlsbad v. Kutnow, 71 Fed. Rep. 167; affirming 67 Fed. Rep. 794; Hill v. Lockwood, 32 Fed. Rep. 389; Northcutt v. Turney, 101 Ky. 314; 41 S. W. Rep. 21.

76—Blackwell v. Dibrell, Fed. Case No. 1475, 3 Hughes, 160; Newman v. Alvord, 49 Barb. 588; 35 How. Pr. 108; Cox, 404; Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311; 20 L. Ed. 581; New York Cement Co. v. Coplay Cement Co., 45 Fed. Rep. 212.

to be a strictly technical trademark, even though the name is that of the town where the factory is situated, because, in the words of the court: "This mark has this significance (designating complainant's manufacture) where the town of Elgin is entirely unknown." But this is purely a dictum, and presented in a case of fraudulent competition, where the defendants had moved their factory from Chicago to Elgin "with the purpose * * * of giving some color of right to a designed trespass on complainant's goodwill." [77]

In applying the doctrine of geographical names to trademarks, there is frequently occasion to exercise common sense. "A word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, we agree with Mr. Justice Kekewich that the word 'Monkey' is not proved to be a geographical name, by showing merely that a small and by no means generally-known island has been called by that name. If, indeed, in its primary and obvious meaning, the word has reference to a locality, as the word 'Melrose' in *Van Duzer's case*, or the word 'Eboli' in *Sir Titus Salt and Company's case* (from which Mr. Justice Chitty declined to distinguish the derivative 'Eboline') it may well be a geographical name." [78]

§ 69. A false geographical name vitiates trademark.—To all that has been said in the last preceding section must be noted one broad qualification. He who seeks to uphold a trademark in a court of equity must do so with clean hands, so that a trademark otherwise good will be vitiated and the right to it destroyed by the use of a false geographical name in connection with it.[79] And this is true, as expressed by Judge Showalter, even though "No actual or substantial wrong may have resulted to any one from this misrepresentation." [80]

77—Elgin Nat. Watch Co. v. Illinois Watch Co. (1), 89 Fed. Rep. 487; reversed on jurisdictional grounds, Illinois Watch Co. v. Elgin Nat. Watch. Co., 94 Fed. Rep. 667; 35 C. C. A. 237; the latter decision affirmed in Elgin Nat. Watch Co. v. Illinois Watch Co. (2), 179 U. S. 665; 45 L. Ed. 365.

78—Rigby, L. J., *In re* Magnolia Metal Company's Trademarks, 14 R. P. C. 621, 627.

79—Manhattan Med. Co. v. Wood, 108 U. S. 218; 27 L. Ed. 706; and cases cited *ante*, § 40.

80—Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376-382. To same effect, see American Cereal

This rule, however, has its practical limitations. Like other forms of misrepresentation, it may be that the use of a geographical name, by one not residing or manufacturing within the locality named, amounts to a mere collateral misrepresentation. Thus, the fact that one of the mills of manufacturers who are joined in an action to restrain the fraudulent use of the name of the city in which they are situated, is situated outside the limits of the city, is not a bar to equitable relief, when the mill is practically a portion of a plant, the remainder of which is within the city.[81]

There is a class of words usually treated as "geographical names fancifully used" that have been treated as trademarks. So of "Alderney" oleomargarine,[82] "Vienna" bread,[83] "German" sweet chocolate ("German" being the name of an individual).[84] But in their last analysis, the "fanciful use" ascribed to those words by the courts is simply a convenient excuse for avoiding the harsh doctrine of *Manhattan Medicine Co. v. Wood*. The misrepresentation may be implied from the language employed though not in express words.[85]

§ 70. The right to complain of unfair use of geographical name.—The right to use the name of a locality in the manufacture and sale of goods is a general right of all who manufacture in that locality.[86] It therefore follows that where any one not living in that locality uses its name to indicate his merchandise, he is resorting to a trick to divert business from the dealers in the same kind of merchandise who in fact live in the locality and honestly use its name as a mark upon their goods.[87]

Co. v. Eli Pettijohn Cereal Co. (1), 72 Fed. Rep. 903, 908.

81—Pillsbury-Washburn Flour Mills Co. v. Eagle, 86 Fed. Rep. 608, 30 C. C. A. 386, 58 U. S. App. 490, 41 L. R. A. 162.

82—Lanferty v. Wheeler, 63 How. Pr. 488.

83—Fleischmann v. Schuckmann, 62 How. Pr. 92.

84—Walter Baker & Co. v. Baker, 77 Fed. Rep. 181.

85—Prince Mfg. Co. v. Prince's Metallic Paint Co., 135 N. Y. 24; 31 N. E. Rep. 990, 17 L. R. A. 129.

86—Pillsbury-Washburn Co. v. Eagle, 86 Fed. Rep. 608, 30 C. C. A. 386.

87—*Ibid.* "A palpable trick," it was termed by Gresham, J., in Southern White Lead Co. v. Cary, 25 Fed. Rep. 125-127. California Fruit Canners' Ass'n v. Myer, 104 Fed. Rep. 82.

The action to restrain such an unfair competition may be brought either by one[88] or all[89] of the merchants who are entitled to the use of the name of the locality and are using it upon the same class of merchandise.

§ 71. When relief will be granted against fraudulent use of geographical names.—It would be a vain task to enumerate the various forms of misuse of geographical names which have been enjoined. An examination of the cases will show the versatility of the fraudulent dealer in devising schemes to deceive the public and deprive the legitimate dealer of his trade. The printing of an American label in the French language has been treated as evidence of unfairness in competition against French exporters to the United States;[90] and so of the manufacture of "Canadian Type" whiskey in the United States, to be sold as a substitute for "Canadian Club;"[91] and the statement upon a package that its contents were "Chicorien Kaffee aus der fabrik von E. B. Muller & Co., in Roulers (Belgien)," was held to be misleading and unfair where the facts showed that the only part of the manufacture done in Belgium was to "harvest" the chicory root, the other processes being done in the United States.[92] In brief, it is particularly true of the subject under discussion that "a court of equity keeps pace with the rapid strides of the sharp competitors for the prize of public favor and insists that it shall be won only by fair trade."[93] Some of the cases are cited in the footnote.[94]

88—Newman v. Alvord, 49 Barb. 588; 35 How. Pr. 108; Cox, 404; 51 N. Y. 189; 10 Am. Rep. 588; Klotz v. Hecht, 73 Fed. Rep. 822; Scheuer v. Muller, 20 C. C. A. 161; 74 Fed. Rep. 225; Gage-Downs Co. v. Featherbone Corset Co., 83 Fed. Rep. 213; Southern White Lead Co. v. Coit, 39 Fed. Rep. 492; A. F. Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

89—Pillsbury-Washburn Co. v. Eagle, 86 Fed. Rep. 608; Key West Cigar Mfrs. Ass'n v. Rosenbloom, 171 Fed. Rep. 296.

90—Klotz v. Hecht, 73 Fed. Rep. 822.

91—Hiram Walker & Sons v. Grubman, 224 Fed. Rep. 725; Hiram Walker & Son v. Grubman, 222 Fed. Rep. 478

92—Scheuer v. Muller 74 Fed. Rep. 225-228; 20 C. C. A. 161.

93—R. Heinisch's Sons Co. v. Boker, 86 Fed. Rep. 765-768.

94—Anheuser-Busch Brewing Ass'n v. Piza, 24 Fed. Rep. 149; A. F. Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896; Southern White Lead Co. v. Cary, 25

§ 72. **Proper names as trademark.**—It is a self-evident proposition that every one has the right to use his own name for purposes of trade. It was held by Vice-Chancellor Wood that a man's own name might be his trademark even when united with other words, themselves generic and hence incapable of exclusive appropriation. In sustaining the words "Ainsworth's Thread" as a trademark he said: "Is not a man's name as strong an instance of trademark as can be suggested?—subject only to this inconvenience, that if a Mr. Jones or a Mr. Brown relies on his name, he may find it a very inadequate security, because there may be several other manufacturers of the same name."[95] But any name may be used by any one who cares to designate himself by it, and in this sense a proper name can never be an essential part of a trademark,[96] because, as we have seen, a valid trademark must be exclusive, as against all the world. The decisions as to this are conflicting, very confusing, and in many instances the result of careless use of language. Thus Chancellor Westbury said: "It is true that a name or the style of a firm may by long usage become a mere trademark."[97] In another case the same learned chancellor said: "A name, though originally the name of the first maker, may in time become a mere trademark or sign of quality, and cease to denote or to be current as indicating that any particular person is the maker. In many cases a name once affixed to a manufactured article continues

Fed. Rep. 125; Same v. Coit, 39 Fed. Rep. 492; City of Carlsbad v. Thackeray, 57 Fed. Rep. 18; Cahn v. Gottschalk, 2 N. Y. Supp. 13; Hiram Walker & Sons v. Mikolas, 79 Fed. Rep. 955; Von Mumm v. Frash, 56 Fed. Rep. 830; Lea v. Wolff, 15 Abb. Pr. N. S. 1; 46 How. Pr. 147; Seb. 407; Anheuser-Busch Brewing Co. v. Fred Miller Brewing Co., 87 Fed. Rep. 864; Manitowoc Pea-Packing Co. v. William Numsen & Sons, 93 Fed. Rep. 196; 35 C. C. A. 267.

95—Ainsworth v. Walmsley, L. R. 1 Eq. 518; 35 L. J. Ch. 352; 12 Jur. N. S. 205; 14 L. T. N. S. 220; 14 W. R. 363; Seb. 257.

96—"In a technical sense, there can be no trademark in the name of a person, because all such names are generic, and because speaking in a general sense, every person has the right to use his own name for the purposes of trade." Davis, J., in Drake Medicine Co. v. Glessner, 68 Ohio St. 337; 67 N. E. Rep. 722.

97—Leather Cloth Co. v. American Leather Cloth Co., 4 DeG. J. & S. 137-142; Seb. 223.

to be used for generations after the death of the individual who first affixed it."[98] In the first named case, any one named "Ainsworth" might lawfully use the word as a trademark. He would be restrained only where he resorted to unfair competition by so preparing or advertising his thread as to deceive customers into the belief that they were buying the thread made by another Ainsworth. As to the dicta of Lord Westbury, they are meaningless, for the same reason. If a man's name is not a valid trademark for his goods in his lifetime, because any one of the same name may use it for the same purpose, how can it possibly become a trademark in the use of his successors after his death?

§ 73. "Secondary Meaning" doctrine applied to proper names.—The theory upon which proper names are protected in equity has been thus admirably stated: "A surname is not the subject-matter of a technical trademark. This is due to the fact that it can not be a clearly distinguishing mark on goods, inasmuch as any one bearing the name has a right to use it in connection with property of his manufacture. It may, however, by appropriation and actual exclusive use, in course of time come to denote in the minds of the public, the product of some particular person or factory or business, and thus acquire a secondary signification. Such a secondary signification, when established, is the subject-matter of exclusive right."[99] To this may be added the very apt dictum of Judge Baker: "If his trade creates a new meaning for the name, then he is entitled to just as full protection in the use of that meaning as if that were the only one. Others may use the common word in its common meaning, but they can not use it in the particular meaning created by the complainant."[1]

As to this doctrine, as recognized in the English cases, we find this admirable summing up by Lord Parker: "Independent of any trademark legislation, whenever a person uses upon or in connection with his goods some mark which has become

98—Hall v. Barrows, 4 DeG. J. & S. 150; 33 L. J. Ch. 204; 10 Jur. N. S. 55; 9 L. T. N. S. 561; 12 W. R. 322; 3 N. R. 259; Seb. 215.

99—Mack, J., in Chickering v. Chickering & Sons, 131 C. C. A. 538, 542; 215 Fed. Rep. 490, 494.

1—Hanover Star Milling Co. v. Allen & Wheeler Co., 125 C. C. A. 515; 208 Fed. Rep. 513.

generally known to the trade or to the public as his mark, and thus operates to distinguish his goods from the goods of other persons, he is entitled in equity to an injunction against the user of the same or any colorable imitation of the same which is in any manner calculated to deceive the trade or the public. Equity has never imposed any limitation on the kind of word entitled to this protection, but in every case it has to be proved that the mark has by user become in fact distinctive of the plaintiff's goods."[2]

§ 74. **Names of celebrities.**—Far different is the rule as to names which are those of celebrities, their use as trademarks being universally recognized.[3] Yet here the scientific objection remains that any one bearing the name of the ill-fated Corsican would have the undoubted right to manufacture "Napoleon" cigarettes, notwithstanding the prior appropriation of that word as a trademark by another manufacturer. If the words "Emperor Napoleon" were so appropriated, they would undoubtedly be good as against the world.[4]

2—Registrar v. Du Cros, Ltd., 83 L. J. Ch. 1.

3—"'Roger Williams,' though the name of a famous person, long since dead, is, as applied to cotton cloth, a fancy name, as would be so applied the names of Washington, Greene, Perry, or of any other heroes, living or dead." Ames, C. J., in Barrows v. Knight, 6 R. I. 434; Cox, 238; Seb. 184. It has been so held of the word "Bismarck" (used as a trademark for paper collars) during the life-time of Bismarck. Messerole v. Tynberg, 36 How. Pr. 14; 4 Abb. Pr. N. S. 410.

4—The learned English barrister Sebastian, in his work on trademarks, thus states the rule: "There is between a name of an individual or firm used as a trademark, and a fancy name or arbitrary symbol used for the same purpose, a broad distinction which was early perceived and which caused some difficulty in the universal acceptance of a name as an efficacious trademark. The difference is, that a name is in its very nature generic, and is properly applied to designate, not one individual in the world, but, it may be, many thousands, to all of whom it is equally appropriate. The addition of the christian to the surname does, indeed, diminish the number of persons to whom the appellation belongs; but the christian name is commonly abbreviated to an initial letter, and in any case, the surname is the important part of the name, beyond which many persons do not care to investigate." Sebastian, Trademarks (4th ed.), 24.

§ 75. In general, of one's own name.—Although the custom is universal for male persons to bear the name of their parents, there is nothing in the common law prohibiting a man from taking any other name he may choose.[5] This doctrine has long been settled beyond peradventure. It is, of course, equally certain that one must not use his name so as to work a fraud upon others of the same name.[6] Subject

5—England v. New York Pub. Co., 8 Daly, 375; Price & Steuart, 14; *In re* Snook, 2 Hilt. 566. Linton v. First National Bank of Kittanning, 10 Fed. Rep. 894-897.

The right to assume a name.—Lord Chelmsford observes: "In this country we do not recognize the absolute right of a person to a particular name to the extent of entitling him to prevent the assumption of that name by a stranger. The right to the exclusive use of a name in connection with a trade or business is familiar to our law; and any person using that name, after a relative right of this description has been acquired by another, is considered to have been guilty of a fraud, or at least of an invasion of another's right, and renders himself liable to an action, or he may be restrained from the use of the name by an injunction. But the mere assumption of a name which is the patronymic of a family by a stranger who had never before been called by that name, whatever cause of annoyance it may be to the family, is a grievance for which our law affords no redress." Du Boulay v. Du Boulay, L. R. 2 P. C. 430-441; and see Olin v. Bate, 98 Ill. 53; 38 Am. Rep. 98, where injunction to restrain the use of an assumed name was denied under peculiar circumstances.

6—The doctrine is well settled that "every one has the absolute right to use his own name honestly in his own business, even though he may thereby incidentally interfere with and injure the business of another having the same name; in such case the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria*. But although he may thus use his name, he can not resort to any artifice or do any act calculated to mislead the public as to the identity of the business firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name." Devens, J., in Russia Cement Co. v. Le Page, 147 Mass. 206-208; 17 N. E. Rep. 304; quoted and followed in Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169-187; 41 L. Ed. 118. This is the rule announced in Burgess v. Burgess, 3 DeG. M. & G. 896; 22 L. J. Ch. 675; 17 Jur. 292; 21 L. T. 53. And see Linoleum Mfg. Co. v. Nairn, 7 Ch. Div. 834-837; 47 L. J. Ch. 430; 38 L. T. N. S. 448; 26 W. R. 463; Dig. 536; Croft v. Day, 7 Beavan, 84; Dig. 76; Holloway v. Holloway, 13 Beavan, 209; Dig. 106; Wotherspoon v. Currie, L. R. 5 H. L. 508; Montgomery v. Thompson, (1891) App. Cas. 217; Rogers v. Rogers, 53

to this restriction a man will never be restrained from the full enjoyment of his name, whether that name be that of his parents or adopted by himself. As stated by Turner, L. J.: "Where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff. It is a question of evidence in each case whether there is false representation or not."[7] Hence we see that the subject of this section is more properly treated under the head of unfair competition, and it is therefore considered in that connection in the next section.

§ 76. The use of proper names in trade.—We have in the preceding sections given some consideration to the subject of proper names, considered with reference to their exclusive appropriation for mercantile purposes. The conclusion reached was that in a scientific sense there can be no trademark in a proper name, because all proper names are generic. The author believes that this rule is well sustained by the reasons heretofore given at length. In their anxiety to effect perfect justice the courts have frequently said that such words were valid trademarks,[8] but the reasoning of the opinions indicates that the use of the language adopted was careless and erroneous. The proper method of reading the class of

Conn. 121; 55 Am. Rep. 78; 33 Alb. L. J. 70; Gilman v. Hunnewell, 122 Mass. 139; Cox, 541; Meneely v. Meneely, 62 N. Y. 427; 1 Hun, 673; 2 Thomp. & C. 540; 62 N. Y. (17 Sickels), 427; 20 Am. Rep. 489; 2 Am. L. T. N. S. 482; Dig. 472; Pillsbury v. Pillsbury, 24 U. S. App. 395-404; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537; 34 L. Ed. 997; 31 Fed. Rep. 776; Brown Chem. Co. v. Meyer, 139 U. S. 540; 35 L. Ed. 247; 31 Fed. Rep. 453; Coats v. Merrick Thread Co., 149 U. S. 562; 37 L. Ed. 847; 45 Off. Gaz. 347; Singer Mfg. Co. v. Larsen, Fed. Case No. 12902; 8 Bissell, 151-153; Price & Steuart, 72; Singer Mfg. Co. v. Bent, 163 U. S. 205; 41 L. Ed. 131.

7—Burgess v. Burgess, 3 DeG. M. & G. 896; 22 L. J. Ch. 675; 17 Jur. 292; 21 L. T. O. S. 53; Cox, 117. A man can not sell his own name to another for the purpose of carrying on a rival trade against another bearing the name so attempted to be used. Melachrino v. Melachrino Cigarette Co., 4 R. P. C. 215; Cartmell, 223.

8—Standinger v. Standinger, 19 Leg. Int. 85; Fulton v. Sellers, 4 Brews. 42; Candee v. Deere, 54 Ill. 439; Howe v. Howe Sewing Machine Co., 50 Barb. 236; Gillis v Hall, 3 Brews. 509.

cases just referred to is to bear in mind that, while the courts recognized the law of unfair competition, they did not know or recognize it by that name. The tendency was to restrain fraudulent competition, but to restrain it by invoking trademark law. In the inaccurate reasoning of the courts, the fact that a man whose name was "R. P. Hall" came into equity seeking an injunction against a defendant bearing a different name, but printing "R. P. Hall" upon his merchandise, suggested that the easiest manner of disposing of the issues was to say that Hall had a trademark right in his own name, which right the defendant was infringing.[9] So the defendant was very properly enjoined, justice was done, and the technical error of the decision was overlooked. For error it was, because the proper name Hall, even prefixed by the initials R. P., is a generic name which any one may use, provided that he does not use it as to pass off his goods upon the purchasing public as the goods of another.

If any further proof were needed to show the rule to be accurate, we could examine the cases in which the use of a proper name could not possibly give a right of trademark, because the name was not used in application to merchandise. One of the most striking instances of this kind is afforded by the case in which a theatrical combination was protected in the use of the name "Christy's Minstrels."[10]

The doctrine under consideration has been condensed in these words: "No person can acquire a right to use his surname as a trademark or tradename, to the exclusion of others bear-

9—Gillis v. Hall, 3 Brews. 509.

10—Christy v. Murphy, 12 How. Pr. 77. In his opinion, Judge Clarke makes these prefatory remarks: "It is now well established that the court will grant an injunction against the use by one tradesman of the trademarks of another. Will this protection be extended to enterprises undertaken for the purpose of affording amusement or recreation to the public?" The court instinctively, in his sense of equity, saw that a wrong was being committed and that it ought to be enjoined, and he enjoined it. The remedy was just as effective and proper as if he had comprehended the law of unfair competition as treated in the later decisions. But if he had understood the principles he administered he would not have referred to the law of trademarks to justify his conclusion.

ing the same surname."[11] While the mere right to use a name is not assignable,[12] there are no decisions asserting "that it may not be assigned to an outgoing partner or to a successor in business as an incident to its good will."[13]

§ 77. The proper name cases classified.—From this preliminary discussion of the principles of unfair competition we can now undertake to classify what we may term, for want of a better phraseology, the proper name cases.

(*a*) Where the defendant is using his own name in good faith. In these cases there is no unfairness in the competition between the parties, and the defendant will not be restrained.[14]

11—Matteson, J., in Harson v. Halkyard, 22 R. I. 102; 46 Atl. Rep. 271.

12—Chadwick v. Covell, 151 Mass. 190; 23 N. E. Rep. 1068; 6 L. R. A. 839; 21 Am. St. Rep. 442.

13—Aetna Mill & Elec. Co. v. Kramer Milling Co., 82 Kan. 679; 109 Pac. Rep. 692.

14—Burgess v. Burgess, 3 DeG. M. & G. 806; 17 Jur. 292; Seb. 117; Coats v. Platt, 17 Leg. Int. 213; Faber v. Faber, 49 Barb. 357; 3 Abb. Pr. N. S. 115; Cox, 401; Seb. 278; Wolfe v. Burke, 56 N. Y. 115; Meneely v. Meneely, 1 Hun, 367; 62 N. Y. 427; Seb. 472; Decker v. Decker, 52 How. Pr. 218; Seb. 525; Prince Metallic Paint Co. v. Carbon Metallic Paint Co., Seb. 573; Rodgers v. Nowill, 6 Hare, 325; Seb. 82; Clark v. Clark, 25 Barb. 76; Cox, 206; Seb. 148; Comstock v. White, 18 How. Pr. 421; Cox, 232; Binninger v. Wattles, 28 How. Pr. 206; Cox, 318; Seb. 240; Hardy v. Cutter, 3 Off. Gaz. 168; Seb. 427; Carmichel v. Latimer, 11 R. I. 395; 23 Am. Rep. 481; 16 Alb. L. J. 73; Seb. 521; Gilman v. Hunnewell, 122 Mass. 139; Seb. 541; McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828; 13 Off. Gaz. 913; Brown Chemical Co. v. Meyer, 139 U. S. 540; 35 L. Ed. 247; Cox, Manual, 726; Wm. Rogers Mfg. Co. v. Rogers & S. Mfg. Co., 11 Fed. Rep. 495; Landreth v. Landreth, 22 Fed. Rep. 41; Wm. Rogers Mfg. Co. v. R. W. Rogers Co., 66 Fed. Rep. 56; affirmed, 17 C. C. A. 57; 70 Fed. Rep. 1019; Wm. Rogers Mfg. Co. v. Rogers, 84 Fed. Rep. 639; Rogers v. Taintor, 97 Mass. 291; White v. Trowbridge, 216 Pa. 11; 66 Atl. Rep. 862; Gordon Hollow Blast Grate Co. v. Gordon, 142 Mich. 488; 105 N. W. Rep. 1118; Donnell v. Herring-Hall-Marvin Safe Co., 208 U. S. 267; 52 L. Ed. 481; Thynne v. Shove, L. R. (1890) 45 Ch. D. 577-582; Investor Pub. Co. v. Dobinson, 82 Fed. Rep. 56; Marcus Ward & Co. v. Ward, 15 N. Y. Supp. 913; 61 Hun, 625; Drummond Tobacco Co. v. Randle, 114 Ill. 402; 2 N. E. Rep. 536; Newark Coal Co. v. Spangler, 54 N. J. Eq. 354; 34 Atl. Rep. 932; American Cereal Co. v. Eli Pettijohn Cereal Co. (2), 76 Fed. Rep. 372; 22 C. C. A. 336;

As stated by Judge Seaman, of the use of a proper name by persons bearing that name, it is "within their right, unless barred by contract or estoppel, or the use is deceptive or fraudulent." [15] The Supreme Court of the United States has extended this rule to corporate names embodying proper names, thus: "We hold that, in the absence of contract, fraud, or estoppel, any man may use his own name in all legitimate ways, and as the whole or a part of a corporate name." [16] Of course the rule does not avail a corporation whose "name is selected with an intention to mislead." [17]

An Indiana court has thus stated the rule under consideration: .

> "It may be stated as a general proposition that a man's name in his own property, and he has the right to its use and enjoyment the same as any other property right, and so long as such use be a fair and reasonable exercise of such right he can not be held liable for incidental damages to a rival in business using the same name, but he must make an honest use of his name, and not injure the goodwill and reputation of a rival by palming off his goods or business as that of such rival. Nor will he be permitted to use his name fraudulently so as to appropriate the goodwill of an established business of his competitor." [18]

affirming s. c., 72 Fed. Rep. 903; Duryea v. National Starch Mfg. Co., 25 C. C. A. 139; 45 U. S. App. 649; 79 Fed. Rep. 651; affirmed, National Starch Mfg. Co. v. Duryea, 41 C. C. A. 244; 101 Fed. Rep. 117; Wm. Rogers Mfg. Co. v. Simpson, 54 Conn. 527; Foster v. Webster Piano Co., 13 N. Y. Supp. 338; 59 Hun, 624; Tussaud v. Tussaud, 38 W. R. 440; Iowa Seed Co. v. Dorr, 70 Ia. 481; Turton & Sons (Ltd.) v. Turton, 42 Ch. D. 128; Bingham School v. Gray, 122 N. Car. 699; 30 S. E. Rep. 304; 41 L. R. A. 243; Harson v. Halkyard, 22 R. I. 102., 46 Atl. Rep. 271; Von Faber v. Faber, 124 Fed. Rep. 603, 611; reversed in Von Faber-Castell v. Faber, 71 C. C. A. 383; 139 Fed. Rep. 257.

15—Hall Safe & Lock Co. v. Herring-Hall-Marvin Safe Co., 74 C. C. A. 361; 143 Fed. Rep. 231, 237.

16—Howe Scale Co. v. Wyckoff, Seamans & Benedict, 198 U. S. 118, 140; 49 L. Ed. 972. To the same effect see Schinasi v. Schinasi, 155 N. Y. S. 867.

17—Lacombe, J., in Wm. Rogers Mfg. Co. v. R. W. Rogers Co., 66 Fed. Rep. 56, 57.

18—Deister Concentrator Co. v. Deister Mach. Co. (Ind. App.), 112 N. E. Rep. 909, citing Penberthy Injector Co. v. Lee, 120 Mich. 174; 78 N. W. Rep. 1074; Rogers v. Rogers, 53 Conn. 121; 1 Atl. Rep. 807; 5 Atl. Rep. 675; 55 Am. Rep. 78; 38 Cyc. 809; Brown Chemical Co. v. Meyer, 139 U. S. 540; 11 Sup. Ct. 625; 35 L. Ed. 247; Howe

Actual fraudulent intent to invade the goodwill of another by the use of the proper name in question is never material in this class of cases.[19]

But in this connection it should be observed that one who enters into competition with another person of the same name, who has an old and established business, is under an obligation to more widely differentiate his goods from those of the latter than is required of third persons having different names.[20] A court of equity may direct a defendant, in such a case, how to use his name so as not to injure the complainant who bears the same name.[21] This direction has at times taken the form of an injunction restraining the party at fault from using his name in connection with his product, except in conjunction with the words "No connection with the original ——" (giving the name and location of the other party), or words of like import.[22]

Scale Co. v. Wycoff, Seamans & Benedict, 198 U. S. 118; 25 Sup. Ct. 609; 49 L. Ed. 972; International Silver Co. v. Rogers, 72 N. J. Eq. 933; 67 Atl. Rep. 105; 129 Am. St. Rep. 722; L. E. Waterman Co. v. Modern Pen Co., 235 U. S. 88; 35 Sup. Ct. 91; 59 L. Ed. 142.

19—Dodge Stationery Co. v. Dodge, 145 Cal. 380; LePage Co. v. Russia Cement Co., 51 Fed. Rep. 941; 2 C. C. A. 555; Jameson v. Dublin Distillers' Co. (1900), Ir. Ch. 43.

20—Baker & Co. v. Baker, 77 Fed. Rep. 181; 78 Off. Gaz. 1427; Walter Baker & Co. v. Sanders, 26 C. C. A. 220; 80 Fed. Rep. 889-895.

21—Baker & Co. v. Baker, 77 Fed. Rep. 181; 78 Off. Gaz. 1427; Tarrant & Co. v. Hoff, 22 C. C. A. 644; 76 Fed. Rep. 959; affirming s. c., 71 Fed. Rep. 163; Walter Baker & Co. v. Sanders, 80 Fed. Rep. 889-894; City of Carlsbad v. Schultz, 78 Fed. Rep. 469. In the last named case Judge Coxe designed a label for the defendant's use, a copy of which is embodied in his opinion.

In another case Judge McPherson granted an injunctive order directing the defendant's initials and location to be printed or written in type of specified relative size. Baker v. Sanders, 97 Fed. Rep. 948. A similar direction is contained in International Silver Co. v. Wm. H. Rogers Corporation, 66 N. J. Eq. 119; 57 Atl. Rep. 1037; reversed in International Silver Co. v. Wm. H. Rogers Corp., 67 N. J. Eq. 646; 60 Atl. Rep. 187.

22—Allegretti Chocolate Cream Co. v. Keller, 85 Fed. Rep. 643. This paragraph quoted and approved by Ray, J., in Rushmore v. Saxon, 158 Fed. Rep. 499, 509. See also International Silver Co. v. Rogers, 72 N. J. Eq. 933; 67 Atl. Rep. 105; reversing International Silver Co. v. Rogers, 71 N. J. Eq. 560; 63 Atl. Rep. 977; Knabe Bros. Co. v. American Piano Co., 229 Fed. Rep. 23; and 232 Fed. Rep. 140 (C. C. A. 6).

(*b*) Where the defendant is using his own name or that of another in a manner wilfully calculated to deceive the public into a belief that his goods, or business are the goods, or business of the plaintiff who bears the same name. This presents a state of facts that warrants the invocation of the injunctive power of equity; the decisions being practically unanimous.[23]

23—Holloway v. Holloway, 13 Beav. 209; Seb. 106; Burgess v. Burgess, 3 DeG. M. & G. 896; 22 L. J. Ch. 675; 17 Jur. 292; 21 L. T. 53; Seb. 117; Taylor v. Taylor, 2 Eq. R. 290; 23 L. J. Ch. 255; 22 L. T. 271; Seb. 124; Clark v. Clark, 25 Barb. 76; Cox, 206; Seb. 148; Stonebraker v. Stonebraker, 33 Md. 252; Seb. 333; Holmes, Booth & Haydens v. Holmes, Booth & Atwood Mfg. Co., 37 Conn. 278; 9 Am. Rep. 324; Seb. 340; James v. James, L. R. 13 Eq. 421; 41 L. J. Ch. 353; 26 L. T. N. S. 568; 20 W. R. 434; Seb. 388; McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828; 13 Off. Gaz. 913; Thorley's Cattle Food Co. v. Massam, 42 L. T. N. S. 851; Cox, Manual, 668; Russia Cement Co. v. LePage, 147 Mass. 206; 17 N. E. Rep. 304; 44 Off. Gaz. 823; Cox, Manual, 706; Brown Chemical Co. v. Meyer, 55 Off. Gaz. 287; 139 U. S. 540; 35 L. Ed. 247; Meyer v. Bull Medicine Co., 66 Off. Gaz. 197; 18 U. S. App. 372; 7 C. C. A. 558; 58 Fed. Rep. 884; Higgins Co. v. Higgins Soap Co., 144 N. Y. 462; 39 N. E. Rep. 490; 43 Am. St. Rep. 769; Wm. Rogers Mfg. Co. v. R. W. Rogers Co., 66 Fed. Rep. 66; 73 Off. Gaz. 970; DeLong v. DeLong Hook & Eye Co., 74 Off. Gaz. 809; Garrett v. Garrett & Co., 24 C. C. A. 173, 79 Off. Gaz. 1681; 78 Fed. Rep. 472-478; Baker & Co. v. Baker, 77 Fed. Rep. 181; 78 Off. Gaz. 1427; Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co., 11 Fed. Rep. 495; Price & Steuart, 621; Tuerk Power Co. v. Tuerk, 36 N. Y. Supp. 384; 92 Hun, 65; Gillis v. Hall, Cox, 596; Devlin v. Devlin, 69 N. Y. 212; Tussaud v. Tussaud, 38 W. R. 440; Frazer v. Frazer Lubricator Co., 121 Ill. 147; 13 N. E. Rep. 639; Shaver v. Shaver, 54 Ia. 208; India Rubber Comb Co. v. Rubber Comb Co., 45 N. Y. Super. Ct. R. 258; Gage v. Canada Pub. Co., 11 Can. Sup. 306; Rogers Co. v. Wm. Rogers Mfg. Co., 70 Fed. Rep. 1017; 17 C. C. A. 576; Landreth v. Landreth, 22 Fed. Rep. 41; Manufacturing Co. v. Simpson, 54 Conn. 527; Rogers v. Rogers, 53 Conn. 121; Hohner v. Gratz, 52 Fed. Rep. 871; Williams v. Johnson, 2 Bos. 1; Cox, 214; Stuart v. F. G. Stewart Co., 33 C. C. A. 480; 91 Fed. Rep. 243; reversing s. c., 85 Fed. Rep. 778; International Silver Co. v. Simeon L. & George H. Rogers Co., 110 Fed. Rep. 955; Chickering v. Chickering & Sons, 120 Fed. Rep. 69; 56 C. C. A. 475; Royal Baking Powder Co. v. Royal, 58 C. C. A. 499; 122 Fed. Rep. 337; International Silver Co. v. Wm. G. Rogers Co., 113 Fed. Rep. 526; Robinson v. Storm, 103 Tenn. 40; 52 S. W. Rep. 880; Wm. A. Rogers, Ltd. v. Cohannet Silver Co., 186 Fed. Rep. 241; Rock Springs Distillery v. Monarch, 15 Ky. L. Rep. 866; 22 S. W. Rep. 1028; Morton v. Morton, 148 Calif.

"Every one has the absolute right to use his own name honestly in his own business, even though he may thereby incidentally interfere with and injure the business of another having the same name. In such case the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria*. But, although he may thus use his name, he can not resort to any artifice or to any act calculated to mislead the public as to the identity of the business firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name. Where the name is one which has previously thereto come to indicate the source of manufacture of particular devices, the use of such name by another, unaccompanied with any precaution or indication, in itself amounts to an artifice calculated to produce the deception alluded to in the foregoing adjudications."[24]

"A person may use his name, which he has the right to use, in such a way as to deceive, and, when he does this with fraudulent intent, may be liable. It is a question of evidence."[25]

In a flagrant case the defendant has been absolutely enjoined from the use of his own name in connection with the manufacture and sale of artificial limbs.[26] But the decree was modified on appeal, permitting the use of his name provided an explanation was attached.[27]

(*c*) Where the defendant is a corporation whose corporate name includes a proper name and was selected by its incorporators with the intent and for the purpose of deceiving

142; 82 Pac. Rep. 664; Gordon Hollow Blast Grate Co. v. Gordon, 142 Mich. 488; 105 N. W. Rep. 1118.

24—Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169; 41 L. Ed. 118; Rushmore v. Saxon, 158 Fed. Rep. 499, 509. "A man may not use his own name to accomplish a fraud, designed or constructive." Jenkins, J., in Stuart v. F. G. Stewart Co., 91 Fed. Rep. 243-248; 33 C. C. A. 480. The use of a surname by a defendant with whose business no one of that name is connected is evidence of fraudulent intent as against an older business bearing a similar name. Scanlan & Bartell v. Williams, 114 S. W. Rep. 862; 53 Tex. Civ. App. 28.

25—Ray, J., in Allen v. Walton Wood & Metal Co., 178 Fed. Rep. 287.

26—J. F. Rowley Co. v. Rowley, 154 Fed. Rep. 744.

27—Rowley v. J. F. Rowley Co., 161 Fed. Rep. 94; 88 C. C. A. 258.

the public into the belief that its goods are the goods of the plaintiff. Such frauds will of course be enjoined.[28]

(*d*) Where the defendant has, solely for the purpose of unfair trade, secured from some person having the same name as the plaintiff a license to use that name for the purpose of fraudulently competing with the plaintiff. This, being an artifice in promotion of unfair trade, renders the defendant liable to injunction.[29]

In such a case, the licensor is a joint tort-feasor with the licensee.[30]

Finally, in regard to the assignment of the right to use one's name, the law is well settled that a man can so assign the right to use his name subject only to the general rules of public policy governing contracts in restraint of trade.[31]

"It is well settled that a person who has adopted and used his surname as a trademark, or tradename, may transfer the same with the goodwill of a business and thereby divest himself of the right to use his name in connection with such a business." [32] Having so divested himself "he may, of course, be enjoined from using his name in that business." [33]

The right to use the name Booth, in connection with a theatre, described in the assignment of a lease as "Booth's

28—Wm. Rogers Mfg. Co. v. Rogers, 73 Off. Gaz. 970; 84 Fed. Rep. 639; Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co., 11 Fed. Rep. 495; Higgins v. Higgins Soap Co., 144 N. Y. 462; 39 N. E. Rep. 490; 43 Am. St. Rep. 769; Plant Seed Co. v. Michel Plant & Seed Co., 23 Mo. App. 579; Garrett v. T. H. Garrett & Co., 24 C. C. A. 173; 78 Fed. Rep. 472; Clark Thread Co. v. Armitage, 21 C. C. A. 178; 74 Fed. Rep. 936; Stuart v. F. G. Stewart Co., 91 Fed. Rep. 243; reversing s. c., 85 Fed. Rep. 778; Dodge Stationery Co. v. Dodge, 145 Cal. 393; 78 Pac. Rep. 879; Nesne v. Sundet, 101 N. W. Rep. 490; 93 Minn. 299.

29—Melachrino v. Melachrino Egyptian Cigarette Co., 4 R. P. C. 215; Cartmell, 223; Sawyer v. Kellogg, 7 Fed. Rep. 720; Cox, Manual, 681; R. Heinisch's Sons Co. v. Boker, 86 Fed. Rep. 765; Garrett v. T. H. Garrett & Co., 78 Fed. Rep. 472; 24 C. C. A. 173.

30—Wm. G. Rogers Co. v. International Silver Co., 55 C. C. A. 83; 118 Fed. Rep. 133.

31—Brewer v. Lamar, 69 Ga. 656; 47 Am. Rep. 766.

32—Knapp, J., in Guth v. Guth Chocolate Co., 140 C. C. A. 410; 224 Fed. Rep. 932; affirming Guth Chocolate Co. v. Guth, 215 Fed. Rep. 750.

33—Lurton, J., in Royal Baking Powder Co. v. Royal, 58 C. C. A. 499, 508; 122 Fed. Rep. 337, 346.

Theatre," was held to pass to the assignee because it had become affixed to the establishment;[34] and it may follow that proper names attached to or used in connection with places of amusement generally would pass to an assignee without specific enumeration in the instrument of assignment.

It was suggested in the case of *Christy v. Murphy*, involving the right to use the words "Christy's Minstrels," that if the plaintiff had seen fit to do so he could have conveyed to the defendants an irrevocable license to use that name in connection with that form of theatrical enterprise.[35] But in the more recent case of *Messer v. The Fadettes*, the Supreme Court of Massachusetts, Lathrop, J., dissenting, refused to recognize an assignment of the name of an orchestra, holding that while the organizer and conductor of a musical organization may have some right of ownership in it, such right is purely personal, depending upon the personal reputation or skill of the conductor, and is therefore not assignable; and that the continued use of the name would mislead and therefore work a fraud upon the public.[36] While the name involved ("The Fadettes") is not the name of a person, the decision is properly noticed here as a striking departure from the doctrine of *Christy v. Murphy*, *supra*, and from what the author conceives to be the law. The dissenting opinion of Justice Lathrop is well grounded on authority, and the reader is referred to it for his reasoning. Briefly, the court ought to havedone as has been occasionally done in the federal courts, namely, it should have instructed the assignee of the name "The Fadettes" how to use that name ini ts advertising matter so as not to deceive the public into a belief that the orchestra was still under the personal direction of its former manager and director. To hold that the assignment was void was to put a premium on dishonesty.

It is interesting to note that in a subsequent case the same court affirms a decree directing a defendant to clearly mark his goods so as to indicate they are not the plaintiff's.[37]

34—Booth v. Jarrett, 62 How. Pr. 169; Seb. 524.

35—Christy v. Murphy, 12 How. Pr. 77; Cox, 164; Seb. 137.

36—Messer v. The Fadettes, 168 Mass. 140.

37—Flagg Mfg. Co. v. Holway, 178 Mass. 83; 59 N. E. Rep. 667.

One who has assigned the right to use his name in specific trade will be enjoined from using his own name in that trade, in competition with his assignee, for such competition would be unfair and fraudulent.[38] Promoters of a corporation whose names have been used as a part of the corporate name can not be permitted to use their names in connection with and as the name of a rival company. Such conduct will be enjoined because of "the injury to the party aggrieved, and the imposition upon the public, by causing them to believe that the goods of one man or firm are the production of another."[39]

In conclusion, the general rule underlying this class of cases has been aptly stated as follows: "All these cases in equity depend upon an appropriation by one person of the reputation of another, sometimes actually fraudulent, and sometimes only constructively so."[40]

Where competing pencil manufacturers named "Faber" entered into a contract defining how the name should be used by them respectively, the contract was upheld as valid, and in the absence of proof that the defendant had wilfully violated its terms, a decree for injunction, upon the ground of unfair competition in the use of the name, was reversed.[41]

The mere assignment of a patent carries with it no right to the use of the patentee's name as a trademark for articles made under the patent.[42]

38—Meyers v. Kalamazoo Buggy Co., 54 Mich. 215; Thynne v. Shove, L. R. (1890) 45 Ch. D. 577; Wood v. Sands, Seb. 467; Russia Cement Co. v. Le Page, 147 Mass. 206; 17 N. E. Rep. 304; Kidd v. Johnson, 100 U. S. 617; 25 L. Ed. 769; Spieker v. Lash, 102 Cal. 38-45; Hoxie v. Chaney, 143 Mass. 592; 10 N. E. Rep. 713; Skinner v. Oakes, 10 Mo. App. 45; Grow v. Seligman, 47 Mich. 647; Churton v. Douglas, Johns, 174; 28 L. J. Ch. 841; 5 Jur. N. S. 887; 33 L. T. 57; 7 W. R. 365. And where the assignor has acquiesced in the opening of mail addressed to him, by his assignee, he will be enjoined from receiving and opening such mail addressed to him. Dr. David Kennedy Corp. v. Kennedy, 55 N. Y. Supp. 917.

39—Holmes, Booth & Haydens v. The Holmes, Booth & Atwood Mfg. Co., 37 Conn. 278; 9 Am. Rep. 324; Seb. 340.

40—Lowell, J., in Wm. Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co., 11 Fed. Rep. 495-499.

41—Von Faber-Castell v. Faber, 71 C. C. A. 383; 139 Fed. Rep. 257; reversing Von Faber v. Faber, 124 Fed. Rep. 603; modified in Von Faber-Castell v. Faber (2), 76 C. C. A. 538; 145 Fed. Rep. 626.

42—Dr. A. Reed Cushion Shoe Co. v. Frew, 162 Fed. Rep. 887, 889; 89 C. C. A. 577.

§ 78. Fictitious proper names.—Whether the use of a fictitious proper name will vitiate an accompanying trademark so as to deprive its owner of relief in equity depends upon whether fraud is accomplished through the use of the name. Thus, one Thomas Nelson Dale, marking thread made and sold by him with the fictitious firm name "Thomas Nelson & Co." was granted an injunction against an infringer, the court saying "the public is not in fact deceived, as it is shown that no such firm exists as Thomas Nelson & Co. who are known to be manufacturers of thread."[43] Upon the same principle, if a manufacturing or business establishment has a firm name which it uses upon its merchandise, it is no fraud upon the public if the firm name no longer represents the same individuals that it did when first adopted.[44]

In cases of this class, if the two proper names involved are *idem sonans*, a difference in spelling is no defense.[45]

§ 79. Revocation of license to use one's own name.—When a person has permitted another to build up a business under his name, the license may become irrevocable. It was so held by the Supreme Court of Pennsylvania, where the purchaser of the machinery and stock of goods of an insolvent partnership at a sheriff's sale was given permission to continue the use of the firm name. A bill was filed four years subsequently to enjoin the purchaser from continuing to use the name, and for an account of profits. Among other controlling facts, it appeared that at the time of the sheriff's sale the goodwill and firm name were valueless, and that their sole value was due to the efforts of the purchaser. This decision seems to be sound, and it is chiefly of value because of the distinction between the license here involved, and the license which is implied in the case of the infringer of a technical trademark, and which has been held to be revocable at any time. Mestre

43—Dale v. Smithson, 12 Abb. Pr. 237; Cox, American Trademark Cases, 282.

44—Leather Cloth Co. Ltd. v. American Leather Cloth Co. Ltd., L. R., 11 H. L. C. 523, 542.

45—As, "McLean" and "McLane" (McLean v. Fleming, 96 U. S. 248; 24 L. Ed. 829); "Rogers" and "RoDgers" (International Silver Co. v. Rogers Bros. Cutlery Co., 136 Fed. Rep. 1019); "Stuart" and "Stewart" (Stuart v. F. G. Stewart Co., 91 Fed. Rep. 243; 33 C. C. A. 480).

zat, J., said: "It is undoubtedly true that a mere license without consideration is determinable at the pleasure of the licensor. But that is not the rule in this state, where the enjoyment of the license must necessarily be and is preceded by the expenditure of money. In such cases the license becomes an agreement on a valuable consideration, and is irrevocable."[46]

§ 80. **Corporate names.**—The general rule governing the supervision of equity over the names of corporations has been comprehensively stated as follows: "In respect to corporate names, an injunction lies to restrain the simulation and use by one corporation of the name of a prior corporation which tends to create confusion, and to enable the later corporation to obtain, by reason of the similarity of names, the business of the prior one. The courts interfere in these cases, not on the ground that the state may affix such corporate names as it may elect to the entities it creates, but to prevent fraud, actual or constructive. The names of corporations organized under general laws, and in most other cases, are chosen by the promoters, and it would be an easy way to escape from the obligations which are enforced as between individuals if a corporation were granted immunity by reason of their corporate character."[47]

Probable confusion of business is usually a prominent factor in the disposition of cases of this class.[48]

"A corporation may be enjoined from using a name or conducting a business under a name so similar to the name of a previously established corporation, association, partnership, or individual, engaged in the same line of business, that confusion or injury results therefrom."[49]

"It is unquestionable that such deception may be practiced by fraudulent use of a corporate name."[50]

46—Harris v. Brown, 202 Pa. 16; 51 Atl. Rep. 586.

47—Higgins Co. v. Higgins Soap Co., 144 N. Y. 462; 39 N. E. Rep. 490; 43 Am. St. Rep. 769.

48—Drummond Tobacco Co. v. Randle, 114 Ill. 412; 2 N. E. Rep. 536; Original LaTosca Social Club v. LaTosca Social Club, 23 App. D. C. 96.

49—Mount, J., in Martell v. St. Francis Hotel Co., 51 Wash. 375; 98 Pac. Rep. 1116; quoted and followed in Rosenburg v. Fremont Undertaking Co., 63 Wash. 52; 114 Pac. Rep. 886.

50—Seaman, J., in Keystone Oil & Mfg. Co. v. Buzby, 135 C. C. A. 185, 188; 219 Fed. Rep. 473, 476.

The courts are confused in their phraseology with reference to the character of corporate names. There can be no trademark right in a corporate name, for the conclusive reason that it is not, as such, applied to the subject-matter of commerce. In an early case Judge Deady, of Oregon, said, "The corporate name of a corporation is a trademark from the necessity of the thing,"[51] and this very phrase, with other dicta, has been quoted with approval in a more recent case.[52] The author has in a former section collected the judicial definitions of trademark, and it is a scientific impossibility to bring Judge Deady's dictum within the scope of either of those definitions, or to extend the definitions to include that dictum. Mr. Justice Clifford's definition may be referred to as making the author's position clearer.[53] It is entirely erroneous to treat a corporate name as being a trademark.

This error has arisen from the unfamiliarity of the courts with the essential requirements of technical trademarks, and the fact that equitable relief had to be administered in cases where the courts had no precedents at hand except in the trademark decisions, which afforded similar reasoning to support their conclusions.

The reason why equity intervenes to protect corporate names from imitation is that they are essential parts of the being of corporations, or, as expressed by the Supreme Court of Missouri, its name is a necessary element of the existence of a corporation.[54]

As the Rhode Island court has phrased it: "The principles upon which these cases rest are that, although a corporation may be legally created, it can no more use its corporate name in violation of the rights of others than an individual can use his name, legally acquired, so as to mislead the public and to injure another."[55] The courts, therefore, will protect a cor-

51—Newby v. Railroad Co., Fed. Case No. 10144, Deady, 609. "The name of a corporation has been said to be the 'knot of its combination,' without which it can not perform its corporate functions." Wallace, J., in Goodyear Rubber Co. v. Goodyear's Rubber Mfg. Co., 21 Fed. Rep. 276.

52—Investor Pub. Co. v. Dobinson, 72 Fed. Rep. 603, 606.

53—McLean v. Fleming, 96 U. S. 245-254; 24 L. Ed. 828.

54—State v. McGrath, 92 Mo. 357.

55—Armington v. Palmer, 21 R. I. 109; 43 L. R. A. 95; 42 Atl. Rep. 308.

poration in the use of its name in the absence of any express statutory enactment.[56] The exercise of this power is an enforcement of the law of unfair competition as shown in the following language of Bradley, J.: "Fair competition in business is legitimate, and promotes the public good; but an unfair appropriation of another's business, by using his name or trademark, or an imitation thereof calculated to deceive the public, or in any other way, is justly punishable by damages, and will be enjoined by a court of equity."[57] This dictum is contained in the opinion in the Celluloid case, where the corporate name happened to be the trademark applied by the corporation to merchandise manufactured and sold by it. It is a self-evident proposition that a generic word embodied in a corporate name is not entitled to protection in equity. The rule was thus stated by Mr. Justice Field, in delivering the opinion of the United States Supreme Court in a case where the Goodyear Rubber Co. sought to restrain another corporation from using the name "Goodyear's Rubber Manufacturing Co." He said: "The name of 'Goodyear Rubber Company' is not one capable of exclusive appropriation. 'Goodyear Rubber' are terms descriptive of well-known classes of goods produced by the process known as Goodyear's invention. Names which are thus descriptive of a class of goods can not be exclusively appropriated by any one. The addition of the word 'Company' only indicates that parties have formed an association or partnership to deal in such goods, either to produce or to sell them. Thus parties united to produce or sell wine, or to raise cotton or grain, might style themselves wine company, cotton company, or grain company; but by such description they would in no respect impair the equal right of others engaged in similar business to use similar designations, for the obvious reason that all persons have a right to deal in such articles and to publish the fact to the world.

56—Farmers' Loan & Trust Co. v. Farmers' Loan & Trust Co. of Kansas, 1 N. Y. Supp. 44; William Rogers Mfg. Co. v. Rogers & Spurr Mfg. Co., 11 Fed. Rep. 495; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94; Investor Pub. Co. v. Dobinson, 72 Fed. Rep. 603; Industrial Mutual Deposit Co. v. Central Mutual Deposit Co., 112 Ky. 937; 66 S. W. Rep. 1032.

57—Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94.

Names of such articles can not be adopted as trademarks, and be thereby appropriated to the exclusive right of any one, nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name."[58]

In a leading opinion upon this subject, the United States Supreme Court, speaking through Mr. Chief Justice Fuller, says "the principle that one corporation is not entitled to restrain another from using in its corporate title a name to which others have a common right, is sustained by the discussion in *Columbia Mill Co. v. Alcorn* (150 U. S. 460), and

58—Mr. Justice Field, in Goodyear Co. v. Goodyear Rubber Co., 128 U. S. 598-602; 32 L. Ed. 535; reversing s. c., 21 Fed. Rep. 276. Thus in an action by one fire insurance company to restrain another from the use of the word "Continental" in its corporate name, the court said: "The distinguishing feature of the names of the two incorporated companies is the word 'Continental.' It is the use of this word by the defendant which the complainant seeks to enjoin. It is the contention of the complainant that, by reason of the long-continued use of this word by it, and the fact that it has built up a large and lucrative business under this distinguishing name, it has secured a property right in said word 'Continental,' in connection with its incorporated name, and it is entitled to the exclusive use of the word 'Continental,' in connection with its insurance business, in the sections of the country where it is engaged in such business. Upon the showing made by the complainant, it might be entitled to the relief sought, were the distinguishing word of its corporate name such a one as could be exclusively appropriated in the designation or conduct of a business by a person, firm or corporation. The word 'continental' is in general and prevalent use, and means pertaining to or characteristic of a continent. As applied to or designating an insurance company, it would be descriptive of the bounds within which such company carried on its business. The scope of the business carried on by many insurance companies is continental in extent. A term which can be truthfully used by many in the description of a business or occupation can not be exclusively appropriated by any one of them. The word 'continental' is a generic term, and it is not the policy of the law to permit the exclusive appropriation of words or terms which are generic; that is, which pertain to a class of related things, and which are of general application. The right to use such words should remain vested in the public." Meek, J., in Continental Ins. Co. v. Continental Fire Ass'n, 96 Fed. Rep. 846-848; affirmed, 41 C. C. A. 326; 101 Fed. Rep. 255. To the same effect see Goodyear Rubber Co. v. Day, 22 Fed. Rep. 44.

is, we think, necessarily applicable to all names *publici juris.*"[59]

A foreign corporation can not, by application to a court in the state in which a new corporation is being organized, secure an injunction restraining the formation of the new corporation under the same corporate name as that of the plaintiff. But in dismissing a bill brought for such a purpose, Judge Gresham said: "I do not say what may be done if the defendants succeed in creating their corporation bearing the complainant's name, and a suit shall be brought by the complainant to prevent individuals claiming to be officers or managers of such corporation from interfering with the complainant's business."[60]

In conclusion, there is no practical difference, so far as equitable rights and remedies are concerned, between corporate names and the name of a copartnership or an individual.

"There is no distinction between corporations and natural persons in the principle, which is to prevent a fraud."[61]

As said by Mr. Justice Bradley, on circuit, in dealing with the names of corporations plaintiff and defendant, "the fact that both are corporate names is of no consequence in this connection. They are the business names by which the parties are known, and are to be dealt with precisely as if they were the names of private firms or partnerships."[62]

And in a similar case, the Supreme Court of Illinois has said, "Even if the corporate names of the two corporations are some-

59—Howe Scale Co. v. Wyckoff, Seamans & Benedict, 198 U. S. 118; 49 L. Ed. 972; citing America Cereal Co. v. Eli Pettijohn Cereal Co., 72 Fed. Rep. 903; 76 Fed. Rep. 372; Hazelton Boiler Co. v. Hazelton Tripod Boiler Co., 142 Ill. 494; Monarch v. Rosenfeld, 19 Ky. Law Rep. 14; 39 S. W. Rep. 236.

60—Lehigh Valley Coal Co. v. Hamblen, 23 Fed. Rep. 225, 226.

61—Mr. Justice Holmes in Waterman Co. v. Modern Pen Co., 235 U. S. 88, 94; 59 L. Ed. 142. The degree of resemblance which will result in enjoining the use of a corporate name of course depends largely on the court. One court has held that the names "Travelers' Insurance Company" and "Travelers' Insurance Machine Company" were so "unlike * * * that it was not probable that confusion will arise." Travelers' Ins. Mach. Co. v. Travelers' Ins. Co., 143 Ky. 216; 134 S. W. Rep. 877.

62—Celluloid Mfg. Co. v. Celluloite Mfg. Co., 32 Fed. Rep. 94, 97. To the same effect, see Baker v. Baker, 53 C. C. A. 157; 115 Fed. Rep. 297; Howe Scale Co. v. Wyckoff, Seamans & Benedict, 198 U. S. 118; 49 L. Ed. 972.

what similar, yet, in the absence of any intent, act, or artifice to mislead dealers in the market or the public at large as to the identity of the corporations, the Elgin Creamery Company has the same right to use its corporate name in the transaction of its business that the Elgin Butter Company has to use its corporate name. It would seem that the same rule should apply to corporations in this regard that obtains in respect to natural persons; and, in the absence of any fraudulent intention or act, or any contract to prohibit it, every natural person has the absolute right to his own name in his own business."[63]

As to the use of a proper name of an incorporator as part of the corporate name, Judge Lochren has stated the rule as follows: "While any person has the right to use his own name in the conduct of his business, in describing the articles of his manufacture, and which he is dealing in, he has not the right to use the name of any other dealer; and it is well settled by the authorities that a corporation has not the right to use the name of one of its incorporators for the purpose of unfair competition with an older dealer, where it is likely to do him injury, and that it will not be permitted to use that name if it is the name by which the older article is usually called for and described."[64]

A corporation can not, by securing a license from or employing a person bearing the desired proper name, so use that name as part of its corporate name as to maintain an unfair competition with an older business employing the name.[65]

It is not necessary that the complainant be a corporation having the same corporate name. If the trade name of the complainant's product is taken as a corporate name by the defendant it will be enjoined.[66]

A foreign corporation (established in a country foreign to the United States) can not enjoin the use of its name by a

63—Baker, J., in Elgin Butter Co. v. Elgin Creamery Co., 155 Ill. 127; 40 N. E. Rep. 616.

64—J. & P. Coats v. John Coates Thread Co., 135 Fed. Rep. 177, 179. To the same effect see David E. Fontz Co. v. S. A. Fontz Stock Food Co., 163 Fed. Rep. 408.

65—Garrett v. T. H. Garrett & Co., 78 Fed. Rep. 472; 24 C. C. A. 175.

66—Bates Mfg. Co. v. Bates Numbering Mach. Co., 172 Fed. Rep. 892; affirmed in Bates Numbering Mach. Co. v. Bates Mfg. Co., 178 Fed. Rep. 681; 102 C. C. A. 181.

corporation established under the laws of one of the United States, where laches is chargeable to it.[67]

Under a penal statute of Illinois providing a punishment for any person, company or association not incorporated, assuming "a corporate name," relief in equity has been denied individuals doing business as "Aetna Iron Works."[68] And in another instance it has been held that individuals doing business as "Hazleton Boiler Company" could not convey the right to use said name.[69] In the former case, the rule is broadly laid down that in that state a copartnership can have no property in a name importing a corporation.

In the latter case, it was held by the Supreme Court of Illinois that a foreign corporation had no standing in the courts of Illinois to contest the right of an Illinois corporation to use the same name. Judge Jenkins has remarked that this holding "is not in accord with the decisions of the federal and of other state courts."[70]

Even where the corporate name attacked so nearly resembles the corporate name of the relator as to be calculated to deceive, and where it is manifest that the secretary of state should have refused to file and record the later prepared certificate of incorporation, thus effecting the incorporation, *certiorari* will not lie to review his action; as his action is not conclusive and the courts have frequently granted relief to a prior corporation aggrieved.[71] Mandamus will not lie to compel a secretary of state to issue a certificate of incorporation under a name whose use could subsequently be enjoined by a prior user of a substantially identical name.[72]

67—Liebig's Extract of Meat Co. v. Liebig Extract Co., 172 Fed. Rep. 158.

68—Clark v. Aetna Iron Works, 44 Ill. App. 510.

69—Hazelton Boiler Co. v. Hazelton Tripod Boiler Co., 142 Ill. 494; 30 N. E. Rep. 339.

70—The Peck Bros. & Co. v. Peck Bros. Co., 51 C. C. A. 251; 113 Fed. Rep. 291, 302; citing Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94; Rogers Co. v. Rogers Mfg. Co., 17 C. C. A. 576; 70 Fed. Rep. 1017; Publishing Co. v. Dobinson, 72 Fed. Rep. 603; Higgins Co. v. Higgins Soap Co., 144 N. Y. 462; 39 N. E. Rep. 490; 27 L. R. A. 42; 43 Am. St. Rep. 769; Holmes, Booth & Hayden v. Holmes, Booth & Atwood Mfg. Co., 37 Conn. 278, 293; 9 Am. Rep. 324.

71—People *ex rel* Columbia Chem. Co. v. O'Brien, 91 N. Y. Supp. 649; 101 App. Div. 296.

72—People *ex rel* Power v. Rose, 219 Ill. 46; 76 N. E. Rep. 42.

§ 81. **Names of unincorporated associations.**—The general principles governing the infringement of corporate names apply to the names of unincorporated associations. The general rule is that relief in equity will be refused where no intent to deceive is proven, and no such similarity of names of the two organizations exists as is calculated to mislead the ordinary citizen of average intelligence.[73]

§ 82. **"Secondary meaning" defined.**—Of late years the expression "secondary meaning" has been frequently employed in opinions in cases of unfair competition. The expression has come to indicate a meaning that may be "secondary" either in point of intent, or in point of time.

Thus, in a leading English case, Lord Macnaghten said: "The appellants concede—they can not, indeed, any longer dispute—that everybody who makes belting of camel hair, is entitled to describe his belting as 'Camel-hair Belting,' provided he does so fairly. But they contend, and I think with reason, that neither Banham nor anybody else is entitled to steal Reddaway's trade under color of imparting accurate and possibly interesting information. Practically the only difference which the unexpected turn in the evidence has made is this: the case now comes under the second branch of the proposition laid down by Lord Justice James, if 'Camel-hair Belting' had kept its place as a fanciful term, it would have fallen under the first. The learned counsel for the respondents maintained that the expression 'Camel-Hair Belting,' used by Banham, was the 'simple truth.' Their proposition was that, 'where a man is simply telling the truth as to the way in which his goods are made, or as to the materials of which they are composed, he can not be held liable for mistakes which the public may make.' That seems to me to be rather begging the question. Can it be said that the description 'Camel-Hair Belting,' as used by Banham, is the simple truth? I will not call it an abuse of language to say so, but certainly it is not altogether a happy expression. The whole merit of that description—its

73—Perham v. Richman, 158 Fed. Rep. 546; Supreme Lodge K. of P. v. Improved Order K. of P., 113 Mich. 133; 71 N. W. Rep. 470; 38 L. R. A. 658; American Order of Scottish Clans v. Merrill, 151 Mass. 558; 24 N. E. Rep. 918; 8 L. R. A. 320.

one virtue for Banham's purposes—lies in its duplicity. It means two things. At Banham's works, where it can not mean Reddaway's belting, it may be construed to mean belting made of camel's hair. Abroad, to the German manufacturer, to the Bombay mill owner, to the up-country native, it must mean Reddaway's belting; it can mean nothing else. I venture to think that a statement which is literally true, but which is intended to convey a false impression, has something of a faulty ring about it; it is not sterling coin; it has no right to the genuine stamp and impress of truth."[74]

Here, both in point of time and point of intent, "Camel-Hair" meant primarily belting having camel's hair as a component.

Where the mark in its first application is a valid trademark, "the mere fact that the article has obtained such a wide sale that the mark has also become indicative of quality is not of itself sufficient to debar the owner of protection or make it the common property of the trade."[75]

Where, on the other hand, the mark in the first instance is generic, because merely descriptive or geographical, or the name of a person, and under that mark a particular trader has occupied the market, a subsequent invasion of the market by another using the mark may (though it does not necessarily) constitute unfair competition; but no matter how long the use continues, the mark will never become a technical trademark.[76]

The rule has been frequently applied and illustrated. It has been admirably stated by Judge Lurton in the following terms:

"That a descriptive word or sign or symbol, descriptive from popular use in a descriptive sense, may acquire a secondary significance denoting origin or ownership, is true. But this secondary significance is not protected as a trademark, for a descriptive word is not the subject of a valid trademark; the only office of a trademark being to indicate origin

74—Reddaway v. Banham (1896), App. Cas. 199.

75—Brown, J., in Burton v. Stratton, 12 Fed. Rep. 696, 702.

76—Brennan v. Emery-Bird-Thayer Dry-goods Co., 47 C. C. A. 532; 108 Fed. Rep. 624, 627; Computing Scale Co. v. Standard Computing Scale Co., 55 C. C. A. 459; 118 Fed. Rep. 965, 968.

or ownership. When a descriptive or geographical word or symbol comes by adoption to have a secondary meaning denoting origin, its use in this secondary sense may be restrained, if it amounts to unfair competition. In such case, if the use of it by another be for the purpose of palming off the goods of one as and for the goods of another, a court of equity will interfere for the purpose of preventing such a fraud. But this kind of relief depends upon the facts of each case, and does not at all come under the rules applicable to the infringement of a trademark."[77]

As to the secondary meaning of geographical names, Mr. Justice Brown has said, "geographical names often acquire a secondary significance indicative not only of the place of manufacture or production, but of the name of the manufacturer or producer and the excellence of the thing manufactured or produced, which enables the owner to assert an exclusive right to such name as against every one not doing business within the same geographical limits; and even as against them, if the name be used fraudulently for the purpose of misleading buyers as to the actual origin of the thing produced, or of passing off the productions of one person as those of another."[78]

77—Vacuum Oil Co. v. Climax Refining Co., 56 C. C. A. 90; 120 Fed. Rep. 254, 256. To the same effect see Standard Varnish Works v. Fisher, 153 Fed. Rep. 928. "It is well settled that words which are not in themselves a valid trademark may, by association with the goods of a particular manufacturer, acquire a secondary signification differing from their primary meaning and denoting the product of that manufacturer, and when this is made to appear their use in that sense will be protected by restraining the use of the words by others in such a way as to amount to a fraud or deception on the public and to cause injury to those to whose employment of them a special meaning has become attached, upon the principle, which underlies the law pertaining to trademarks, that the manufacturer of the particular goods is entitled to the reputation or goodwill which they have acquired, and the public is entitled to the means of distinguishing between them and other goods, or, in other words, to state it concisely, that no one may pass off his goods as and for the goods of another." Haight, J., in Rubber & Celluloid H. T. Co. v. F. W. DeVoe & C. T. Reynolds Co., 233 Fed. Rep. 150, 154.

78—La Republique Francaise v. Saratoga Vichy Spring Co., 191 U. S. 427, 435; 48 L. Ed. 247, 252; affirming La Republique Francaise

The general doctrine has been stated with admirable conciseness by Judge Lurton, as follows: "When the word is incapable of becoming a valid trademark, because descriptive or geographical, yet has by use come to stand for a particular maker or vendor, its use by another in this secondary sense will be restrained as unfair and fraudulent competition, and its use in its primary or common sense confined in such a way as will prevent a probable deceit by enabling one maker or vendor to sell his article as the product of another."[79]

Further illustrative cases are collected in the note.[80]

v. Saratoga Vichy Springs Co., 46 C. C. A. 418; 107 Fed. Rep. 459. To the same effect see Elgin National Watch Co. v. Loveland, 132 Fed. Rep. 41, 47; American Waltham Watch Co. v. United States Watch Co., 173 Mass. 85; 53 N. E. Rep. 141.

79—Computing Scale Co. v. Standard Computing Scale Co., 55 C. C. A. 459; 118 Fed. Rep. 965, 967. Citing Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537, 549; 11 Sup. Ct. 396; 34 L. Ed. 997; Chemical Co. v. Meyer, 139 U. S. 540; 11 Sup. Ct. 625; 35 L. Ed. 247; Mill Co. v. Alcorn, 150 U. S. 460; 14 Sup. Ct. 151; 37 L. Ed. 1144; Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169; 16 Sup. Ct. 1002; 41 L. Ed. 118; Bennett v. McKinley, 13 C. C. A. 25; 65 Fed. Rep. 505.

80—"Easy Emptying" grass catchers for lawn-mowers, Zittlosen Mfg. Co. v. Boss, 135 C. C. A. 551; 219 Fed. Rep. 887; and Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537; 11 Sup. Ct. 396; 34 L. Ed. 997; Coats v. Merrick Thread Co., 149 U. S. 562; 13 Sup. Ct. 966; 37 L. Ed. 847; Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169; 16 Sup. Ct. 1002; 41 L. Ed. 118; Elgin Nat. Watch Co. v. Illinois Watch Co., 179 U. S. 665; 21 Sup. Ct. 270; 45 L. Ed. 365; French Republic v. Saratoga Vichy Co., 191 U. S. 427; 24 Sup. Ct. 145; 48 L. Ed. 247; Herring, etc., Safe Co. v. Hall's Safe Co., 208 U. S. 554, 559; 28 Sup. Ct. 350; 52 L. Ed. 616; Standard Paint Co. v. Trinidad Asphalt Co., 220 U. S. 446; 31 Sup. Ct. 456; 55 L. Ed. 536; Davids Co. v. Davids, 233 U. S. 461, 471; 34 Sup. Ct. 648; 58 L. Ed. 1046; Trinidad Asphalt Co. v. Standard Paint Co., 163 Fed. Rep. 977; 90 C. C. A. 195 (C. C. A. 8th Cir.); Standard Paint Co. v. Rubberoid Roofing Co., 224 Fed. Rep. 695; 140 C. C. A. 235 (C. C. A. 7th Cir.); Samson Cordage Works v. Puritan Cordage Mills, 211 Fed. Rep. 603; 128 C. C. A. 203; L. R. A. 1915F, 1107 (C. C. A. 6th Cir.); Vacuum Oil Co. v. Climax Refining Co., 120 Fed. Rep. 254, 256; 56 C. C. A. 90 (C. C. A. 6th Cir.); Fuller v. Huff, 104 Fed. Rep. 141; 43 C. C. A. 453; 51 L. R. A. 332 (C. C. A. 2nd Cir.); Scriven v. North, 134 Fed. Rep. 366; 67 C. C. A. 348 (C. C. A. 4th Cir.); United Lace & Braid Mfg. Co. v. Barthels Mfg. Co., 221 Fed. Rep. 456; International Silver Co. v. Rogers Corp'n, 66 N. J. Eq. 119; 57 Atl. 1037; 2 Ann. Cas. 407; affirmed 67 N. J. Eq. 646; 60 Atl. Rep. 187; 110 Am. St. Rep. 506; 3 Ann. Cas. 804; Rubber & Celluloid Har-

§ 83. Words of double meaning.—In connection with the subject of "secondary" meanings, we may consider, briefly, the decisions concerning the appropriation to trade uses of the class of words having double meanings, being in one sense arbitrary and in another descriptive.

A careful search of the decisions involving words of this character fails to disclose a clearer statement of the correct rule than is embodied in the following language of Judge Wallace: "No principle of the law of trademark is more familiar than that which denies protection to any word or name which is descriptive of the qualities, ingredients, or characteristics of the article to which it is applied. An exclusive right to the use of such a word, as a trademark, when applied to a particular article or class of articles, can not be acquired by the prior appropriation of it, because all persons who are entitled to produce and vend similar articles are entitled to describe them, and to employ any appropriate terms for that purpose. Whether a word claimed as a trademark is available because it is a fanciful or arbitrary name, or whether it is obnoxious to the objection of being descriptive, must depend upon the circumstances of each case. The word which would be fanciful or arbitrary when applied to one article may be descriptive when applied to another. If it is so apt, and legitimately significant of some quality of the article to which it is sought to be applied, that its exclusive concession to one person would tend to restrict others from properly describing their own similar articles, it can not be the subject of a monopoly. On the other hand, if it is merely suggestive, or is figurative only, it may be a good trademark, notwithstanding it is also indirectly or remotely descriptive."[81]

In the opinion quoted from, the word "instantaneous" was held to be aptly descriptive of one of the qualities of the goods to which it was applied. In a later case it has been held that the words "Queen," or "Queen Quality," as applied to

ness Trimming Co. v. Rubber-Bound Brush Co., 81 N. J. Eq. 419; 88 Atl. Rep. 210; Ann. Cas. 1915B, 365; affirmed 81 N. J. Eq. 519; 88 Atl. Rep. 210; Ann. Cas. 1915B, 365; Thompson v. Montgomery, 41 Ch. D. 35; Wotherspoon v. Currie, L. R. 5 H. L. 508; Reddaway v. Banham (1896), A. C. 199; 25 Eng. Rul Cas. 193.

81—Bennett v. McKinley, 13 C. C. A. 25; 65 Fed. Rep. 505, 506.

shoes, are not so descriptive as to preclude their exclusive appropriation as a "tradename," Judge Severens apparently using the word "tradename" as synonymous with "trademark."[82]

"It has been repeatedly ruled that a word which suggests even the composition, quality, or characteristics of an article to which it is applied may yet be a good trademark."[83]

§ 84. The mark's validity to be judged as of the date of its adoption.—In our consideration of what may and what may not be appropriated as a technical trademark, it must be borne in mind that the question must be judged as of the time when its claimant first applied it to merchandise, and "before he had taught the trade its meaning. * * * That," says Judge Sanborn, "is the true test."[84]

82—Thomas G. Plant Co. v. May Co., 44 C. C. A. 534; 105 Fed. Rep. 375, 379.

83—Showalter, J., in Beadleston & Woerz v. Cooke Brewing Co., 20 C. C. A. 405; 74 Fed. Rep. 229, 234; citing Keasbey v. Chemical Works, 142 N. Y. 467; 37 N. E. Rep. 476.

84—Dissent in Wolf Bros. & Co. v. Hamilton-Brown Shoe Co., 165 Fed. Rep. 413, 418; 91 C. C. A. 363; citing Wellcome v. Thompson & Capper, 1 L. R. Ch. Div. 1904, 736, 742, 749, 750, 754; Keasbey v. Brooklyn Chem. Works, 142 N. Y. 467, 471, 474, 475, 476; 37 N. E. Rep. 476; 40 Am. St. Rep. 623. Judge Sanborn's dissent has been approved by the Supreme Court of Hamilton-Brown Shoe Co. v. Wolf Bros. & Co., 240 U. S. 641; 60 L. Ed. —.

CHAPTER IV.

TRADEMARK RIGHTS IN TITLES OF BOOKS, PERIODICALS AND PLAYS.

§ 85. **Trademark in title of a book.**—Upon this subject there has been less harmony of opinion than would be expected. It has been said by the Court of Appeals of Maryland that "A publisher has either in the title of his work or in the application of his name to the work, or in the particular marks which designate it, a species of property similar to that which a trader has in his trademark."[1]

Mr. Browne in his learned treatise on trademarks says: "Can printed books be protected by trademarks? Yes, as mere merchandise; no, as literary productions."[2] This is true, in so far as it asserts that marks or devices may be used to distinguish the product of the publisher or book dealer.[3] He says further: "There seems to be no sufficient reason why the title of a book may not be deemed a valid trademark,"[4] and thereby expresses the error contained in the careless dictum of the Maryland court quoted above. The correct view is stated in clear terms by Mr. Rowland Cox, in his note to *Clemans v. Belford:*[5] "It is necessarily true that the name of a book is, under all circumstances, a descriptive term which means a particular thing. The book is created and given a name, and the name is added to the language as a term of description. If a copyright is taken, the owner of the copyright enjoys, as long as the privilege continues, the exclusive right to the use of the name; and when the privilege expires, the name, always a descriptive term, becomes *publici juris*. If the book is not copyrighted, the literary matter becomes *publici juris* as soon

1—Robertson v. Berry, 50 Md. 591; Price & Stewart, 153.

2—Browne, Trademarks, sec. 116.

3—Mr. Browne cites six cases in support of this proposition, neither one of which is applicable. All related to property right in the title of a periodical publication.

4—Browne, Trademarks, sec. 118.

5—14 Fed. Rep. 728; Cox, Manual, 685.

as it is published, and the name of the literary matter goes to the public as an incident of that which it describes. If there is language in some of the cases which seems to indicate that the name of a book can be protected as a trademark, reflection will demonstrate that it can not be made good. The names of periodicals and newspapers, as distinguished from books, are protected as in the nature of trademarks; and in many instances the publications in connection with which the names have been used were proper subjects of copyright. In some cases they contained, or might have contained, articles in connection with which the statutory privilege had been acquired. But the name which has been protected has never been simply the name of a book, but always that of a constantly changing series. Thus the term 'Old Sleuth Library' was distinctly arbitrary, and never the name of a particular book or literary production, and for this reason it was in an accurate sense a trademark, and must continue to be as long as the publication was continued. But if the publication of the periodical were discontinued for a period of years, the name would cease to be arbitrary and take its place in literature as indicating a definite collection of articles, pictures, etc., and as soon as it acquired that settled meaning, it would, in the absence of copyright, become *publici juris.*"

It is now established law that there is no trademark right in the title of a book. Judge Wallace stated the rule very lucidly when he said: "Neither the author or proprietor of a literary work has any property in its name. It is a term of description, which serves to identify the work; but any other person can with impunity adopt it, and apply it to any other book, or to any trade commodity, provided he does not use it as a false token to induce the public to believe that the thing to which it is applied is the identical thing which it originally designated. If literary property could be protected upon the theory that the name by which it is christened is equivalent to a trademark, there would be no necessity for copyright laws."[6] This doctrine is fully sustained by the later cases.[7]

6—Black v. Ehrich, 44 Fed. Rep. 793, 794.

7—Merriam v. Holloway Pub. Co., 43 Fed. Rep. 450 (opinion by Mr. Justice Miller on circuit); Merriam v. Famous Shoe and Clothing Co., 47 Fed. Rep. 411 (opinion by Judge Thayer); Mer-

Here, as elsewhere, the broad doctrines of unfair competition may be invoked, even in the absence of copyright. In a case where the plaintiff published an uncopyrighted compilation of hymns and poems, bound and illustrated in distinctive fashion, and the defendant copied the work, in a cheaper manner, the court said: "The injury likely to be done plaintiff is twofold. First, it is threatened with a loss of sales and subsequent profit; and, secondly, it is threatened with a loss of reputation as a producer of fine and artistic books. * * * Upon the general right of the plaintiff to protective relief we can not see any reason why the same rule should not be applied to a book that has been applied to a game, or to cigars, or to anything else which is distinguished by a label, or by the distinctive form or style of the package. The decisive fact is that the defendants are unfairly and fraudulently attempting to trade upon the reputation which plaintiff has built up for its books."[8]

§ 86. **Trademark in title of periodical.**—In 1859 Vice-Chancellor Stuart enjoined a defendant who had begun the publication of "The Penny Bell's Life and Sporting News" from publishing any newspaper under that name, or any other name in which the words "Bell's Life" should occur, the application being made by the proprietors of "Bell's Life in London." In the course of his opinion the vice-chancellor said: "This is an application in support of the right to property."[9] Thus was distinctly recognized the right of trademark in the title of a periodical publication. Long prior to this time, however, equity had suppressed this species of piracy between publishers, the first reported case being that of *Hogg v. Kirby*, where the complainant was the proprietor of a magazine called "The Wonderful Magazine" and the defendant's publication bore substantially the same name with the addition of the words "New Series, Improved." The injunction was granted by Lord Eldon.[10]

riam v. Texas Siftings Pub. Co., 49 Fed. Rep. 944 (opinion by Judge Shipman); Kipling v. G. P. Putman's Sons, 120 Fed. Rep. 631; 57 C. C. A. 295.

8—E. P. Dutton & Co. v. Cupples, 102 N. Y. Supp. 309.

9—Clement v. Maddick, 1 Giff. 98; 5 Jur. N. S. 592; 33 L. T. 117; Seb. 174.

10—Hogg v. Kirby, 8 Ves. 215; Seb. 10. Lord Eldon also restrained a defendant from the publication of a court calendar which

In the United States Chancellor Sandford was the first to recognize this right, in 1825, although he refused to enjoin the use of the title "The New York National Advocate" on the application of the proprietor of "The National Advocate," both names being applied to newspapers published in the city of New York, holding the names to be substantially different; and this notwithstanding the fact that the defendant had been the editor for the publisher who had sold "The National Advocate" to the complainant. The chancellor did not expressly hold the title of the paper to be a trademark, but treated it as part of the goodwill of the printing establishment.[11] Indeed he seems to have treated the subject solely from the standpoint of unfair competition, ignoring the question of technical property right, as did Chancellor Walworth in 1840 in refusing to enjoin the use of the title "New Era" on the application of complainants who published the "Democratic Republican New Era," saying *inter alia*, "There could be very little excuse for the editor of a new paper who should adopt the precise name and dress of an old established paper, which would be likely to interfere with the goodwill of the latter by actually deceiving its patrons." [12]

In 1867, however, a clear cut opinion of the Court of Common Pleas of the City of New York recognized the property right in unmistakable terms. The plaintiffs, proprietors of the "National Police Gazette," applied for an injunction to restrain the publication of the "United States Police Gazette" by the defendants. Brady, J., said: "The title of a newspaper may be a purely original one, and the proprietor for that reason entitled to its exclusive use. He may create a word, or combination of words, for the particular designation of his paper, and in that way acquire an exclusive right to the use of the name employed. He may combine, as the plaintiffs have, well-known English words in common use. * * * It also appears that the plaintiff's paper has been published weekly under that name for many years, * * * that its

he was issuing as a continuation of the complainant's work. Longman v. Winchester, 16 Ves. 269; Seb. 15.

11—Snowden v. Noah, Hopkins, Ch. R. 347; Cox, 1; Seb. 41

12—Bell v. Locke, 8 Paige, 75; Cox, 11; Seb. 65.

circulation is large and valuable, and that it was the only police gazette, *eo nomine*, published in the United States at the time of the publication of the paper complained of by them. * * * From these facts it is apparent that the plaintiffs have acquired a right connected with the publication of a newspaper called the National Police Gazette, which must be preserved against any fraud attempted to be perpetrated against them."[13]

In 1870, in the Philadelphia Court of Common Pleas, Judge Paxson said: "the name of a newspaper is a trademark. As much so as a label stamped upon a bale of muslin."[14] But this was mere *obiter dictum*, as the learned court was dealing with the mark and dress of a stove polish.

Subsequently the Superior Court of New York City, per Monell, J., said: "I do not understand that the protection which the law affords to 'trademarks,' even assuming the name of a newspaper to be a trademark, goes so far as is claimed in this case. The protection which has been granted to that species of property has never, I believe, been extended over anything that was the subject of a patent or a copyright, but is confined to appropriations of names designating some particular manufacture or business. There can be no such property in a newspaper except, perhaps, in the name or title of the paper, which is the only continuing portion of it. The contents of each issue are the composition or creation of the editor or contributors, are varied each day, and when given to the public all literary proprietorship in them is lost. And the law of trademarks, like the law of copyright, can not be applied to a work of so fluctuating and fugitive a character."[15]

As late as 1881 Sir George Jessel, master of the rolls, said: "It does not appear to me that there was any invention in the combination of 'Splendid Misery,' any more than there

13—Matsell v. Flanagan, 2 Abb. Pr. N. S. 459; Cox, 367; Seb. 270.

14—Dixon Crucible Co. v. Guggenheim, 2 Brewster, 321; Cox, 559.

15—Stephens v. De Conto, 7 Robertson, 343; 4 Abb. Pr. N. S. 47; Cox, 442; Seb. 295. The learned court cites an opinion holding that a newspaper or price current can not be copyrighted because the term science can not, with any propriety, be applied to a work of so fluctuating and fugitive a form. Clayton v. Stone, 2 Paine, 382-392.

would be in the words 'Miserable Sinner,' or anything of that kind. The adoption of the words as the title of a novel might make a trademark."[16]

In 1898 the Appellate Division of the Supreme Court of New York said it could not follow the reasoning of counsel "when he contends that the public, by its short way of referring to the 'Commercial Advertiser,' has given the plaintiff some kind of an undefined trademark in this popular form of speech,—a doctrine which would equally apply to a 'sobriquet' or diminutive; that its unauthorized use by the defendant, whether likely to injure the plaintiff or not, should be absolutely enjoined as an invasion of a strict property right."[17]

While on the other hand, the United States Circuit Court for the District of New Jersey had held in 1894 that the words "Social Register," applied by a publisher to a directory of a certain locality, containing names of persons resident therein, selected with reference to the personal and social standing of such persons, "become a trademark, and are entitled to protection as such."[18]

From our cursory view of the foregoing decisions and dicta it is plainly manifest that the right to technical trademark in the title of a periodical has been affirmed and denied with some show of reason upon each side. The subject has been ably discussed by Mr. Browne, who concludes that the name so used is a technical trademark.[19] In that conclusion we must coincide, and it is well sustained by the reasoning of Mr. Rowland Cox, which we have before quoted.[20] But the fact is patent that it is still a mooted question, and that the solicitor attempting to restrain piracy of this kind would better frame his bill upon unfair competition and not upon technical

16—Dicks v. Yates, L. R. 18 Ch. D. 76-88.

17—Commercial Advertiser Ass'n v. Haynes, 49 N. Y. Supp. 938-942.

18—Social Register Ass'n v. Howard, 60 Fed. Rep. 270, 271. The same ruling was made in Social Register Ass'n v. Murphy, 128 Fed. Rep. 116.

19—Browne, Trademarks (2d Ed.), § 115. As instances of injunction restraining use of infringing titles of periodicals, see Edmonds v. Benbow, Seton (3d Ed.), 905; *In re* Edinburgh Corrospondent Newspaper, Ct. of Sess. Cas. 1st. ser. I (new ed.), 407 n; Cox, Manual, No. 34.

20—Note to Clemens v. Belford, 14 Fed. Rep. 728; Cox, Manual, 684; *ante*, § 85.

trademark. The New York Supreme Court, in its decision above referred to, says that "the fundamental doctrine upon which relief in this class of cases is afforded" is that of "misleading or the tendency to mislead, with consequent injury, actual or probable."[21]

In a decision of the United States Circuit Court of Appeals for the Second Circuit, rendered since the foregoing was written, it is distinctly held that the name of a periodical is a technical common law trademark.[22]

In harmony with this doctrine it has been held that the words "Buster Brown" at the head of a single page of a comic section of a newspaper constitute a valid trademark.[23]

§ 87. **Play titles as trademarks.**—The principles stated by Judge Wallace in the language which we have heretofore quoted in reference to book titles as trademarks, "If literary property could be protected upon the theory that the name by which it is christened is equivalent to a trademark, there would be no necessity for copyright laws," applies with equal cogency to the name by which a play is designated. But there is this distinction between the titles of plays and the titles of books; the former are comprehensive of something more than the mere title of the literary composition which is produced as a play, while the latter are strictly limited to the literary

21—Commercial Advertiser Ass'n v. Haynes, 49 N. Y. Supp. 938-942; citing Bradbury v. Beeton, 39 Law J. Ch. 57; Ingram v. Stiff, 5 Jur. N. S. 947; Lee v. Haley, 5 Ch. App. Cas. 155; Clement v. Maddick, 5 Jur. N. S. 592. And to the same effect see Snowden v. Noah, Hopkins, Ch. 347; Bell v. Locke, 8 Paige, 75; Tallcot v. Moore, 6 Hun, 106; Stephens v. DeConto, 4 Abb. Pr. N. S. 47; Matsell v. Flanagan, 2 Abb. Pr. N. S. 459; Publishing Co. v. Dobinson, 82 Fed. Rep. 56; Richardson & Boynton Co. v. Richardson & Morgan Co., 8 N. Y. Supp. 53; Farmers' Loan & Trust Co. v. Farmers' Loan & Trust Co., 1 N. Y. Supp. 44; Borthwick v. Evening Post, L. R. 37 Ch. D. 449; Estes v. Leslie (2), 29 Fed. Rep. 91; Estes v. Leslie (1), 27 Fed. Rep. 22; Estes v. Worthington, 31 Fed. Rep. 154.

22—Gannett v. Rupert, 62 C. C. A. 594; 127 Fed. Rep. 962; reversing s. c., 119 Fed. Rep. 221; to the same effect, see S. T. Taylor Co. v. Nast, 154 N. Y. Supp. 982.

23—New York Herald Co. v. Star Co., 146 Fed. Rep. 204; affirmed 146 Fed. Rep. 1023; 76 C. C. A. 678.

production itself. Practically, in all of the cases involving play titles with which the courts of this country have had to do, there was some scheme of production involved which represented the business enterprise of the manager, as well as the presentation of the ideas of the author. The ideas of the author again are not entirely embodied in language which reaches the audience in word sung or spoken. The "business" of the play is sometimes never reduced to writing, and in the majority of cases the production of the brain of a third person, the skilled stage manager, is of the very essence of the play, and is at times the determining factor which makes the play a success. So, in its last analysis, the name of a play is the medium which signifies to the patrons of the theatre three things: the literary production of the playright, the artistic aid of the stage manager, and the moneyed investment as well as the skill in cast selection of the manager. And these three things disregard the accompanying investiture of costumes, scenery, and incidental music which represent the efforts of the musician, the landscape painter, the costumer, and the skilled selector of furniture and other accessories. A play title then stands for a kind of personal property which is strictly *sui generis*, the distinguishing mark by which the production is identified to the public before and after the first performance. It is manifest that a play title also carries with it a specific and unique form of goodwill to which all of the things which we have enumerated help to contribute.

The extent to which courts of equity will protect a play from piracy, aside from any question of copyright, is not yet fully determined. The cases are few in number, but are sufficient to establish the general principle that the broad doctrine of unfair competition in trade which we have considered in this book may be invoked wherever deception of the public and injury to the complainant will probably result from a refusal of the injunction. This fact is more important because of the difficulty attendant upon making out a case of copyright infringement where the subject matter involved is a dramatic composition.

In a case in which "L'Aiglon" was the play involved, and in an opinion in which he refers to that name as being a

trademark for the plaintiff's organization, Judge McAdam has said: "The question, 'What's in a name' has been answered by the courts in many well-considered cases, wherein the exclusive right to a name possessed or owned by a successful business enterprise has been maintained against imitators and wrongdoers who sought, by an unauthorized use, to deceive the public and profit by the wrong. While courts have in some instances refused injunctive relief to protect the use of the title where plays were dissimilar, and the appropriation a mere coincidence (*Frohman v. Miller,* 8 Misc. Rep. 379, 29 N. Y. Supp. 1109), they have uniformly enjoined such use where deception of the public and injury to the plaintiff were likely to follow a refusal to grant equitable aid (*Shook v. Wood,* 32 Leg. Int. 264; *Hier v. Abrahams,* 82 N. Y. 519)."[24] In a later case the Supreme Court of Illinois affirmed a decree of injunction in a case where the plaintiff was the producer of the play "Sherlock Holmes" and the defendant subsequently produced a play entitled "Sherlock Holmes, Detective." In affirming the decree of injunction, the supreme court based the plaintiff's right to equitable relief upon the ground that the names of the respective plays were so similar that the public "would be deceived to believe that the drama of the appellant company was that which the appellee had been producing." The court expressly declined to decide whether or not the plaintiff had a trademark right or property in the words "Sherlock Holmes," basing the relief upon the general rule as to unfair competition, Judge Boggs remarking that "Equity provides a remedy to prevent such unfair and fraudulent competition among business rivals in any and all lines of legitimate trade and business."[25]

Where the play is a dramatization of a book, whose copyright has expired, its title is not an infringement of the title of another (copyrighted) play based upon the book.[26]

§ 88. Infringement of book titles and play titles by motion picture titles.—The manufacturers of motion picture films have

24—Frohman v. Payton, 68 N. Y. Supp. 849.

25—Hopkins Amusement Co. v. Frohman, 202 Ill. 541; 67 N. E. Rep. 391; affirming s. c., 103 Ill. App. 613.

26—Glaser v. St. Elmo Co., 175 Fed. Rep. 276.

used many titles of pre-existing copyrighted books and plays as the titles of their films. In the absence of copyright questions, the similarity of title alone can give no cause of action.

The "Nick Carter" case was based upon the name "Nick Carter" registered "for a weekly periodical devoted to fiction." The defendant made a film entitled "Nick Carter the Great American Detective Solving the $100,000 Jewel Mystery," the plot of the film play not being an infringement of any of the hundreds of "Nick Carter" stories published by the plaintiff. A preliminary injunction was appealed from, the appeal resulting in a dismissal of the bill.[27] The underlying doctrine is that "if literary property could be protected upon the theory that the name by which it is christened is equivalent to a trademark, there would be no necessity for copyright law."[28]

In an English case the suit was brought by the authors and owners of the copyright of a play, "Sealed Orders," to restrain the defendants from using and advertising a film play under that title. The case coming on before Mr. Justice Eve, the court was so clearly against the plaintiffs that the case was settled by a consent decree under which the defendants agreed to change the title of the film to "Orders Under Seal." The learned judge asked two questions during the hearing which are clearly suggestive that British law is in harmony with our decisions. "Could not anyone paint a picture and call it 'Sealed Orders?' A person might write a book now and call it 'Sealed Orders,' and is not what the defendants want to show merely a pictorial book?"[29]

27—Atlas Mfg. Co. v. Street & Smith, 122 C. C. A. 568; 204 Fed. Rep. 398; appeal in supreme court dismissed in Street & Smith v. Atlas Mfg. Co., 231 U. S. 348; 58 L. Ed. 262.

28—Black v. Ehrich, 44 Fed. Rep. 794.

29—Raleigh v. Kinematograph Trading Co., 31 R. P. C. 143, 145.

CHAPTER V.

THE LOSS OF THE RIGHT TO A TRADEMARK'S USE.

§ 89. **Laches.**—There is no laches where a complainant is only waiting to get a sufficient quantity of evidence to secure a successful prosecution of the infringer,[1] and of course none exists where the complainant has no knowledge of the fact of infringement;[2] and it has been distinctly held by the federal supreme court that an injunction will not generally be refused on the ground of delay alone.[3] Following that decision, it was said by Judge Nixon, in the United States Circuit Court in the District of New Jersey: "There has been large discussion of the question how far laches, in stopping the infringement of a trademark, will deprive a complainant of the benefits of a preliminary injunction. But that discussion has been put to rest, so far as this court is concerned, by the recent decision of the supreme court in the case of *McLean v. Fleming*,[4] where it was held that acquiescence of long standing was no bar to an injunction, although it precluded the party acquiescing from any right to an account for past profits."[5]

The rule that laches which will be a bar to an accounting will not be a defense as against a prayer for injunctive relief, obtains in all cases of unfair competition, whether or not a technical trademark is involved.[6]

1—Cave v. Myers, Seton (4th Ed.), 238; Lee v. Haley, 22 L. T. N. S. 251.

2—*In re* Farina, 27 W. R. 456; Seb. 642; Weldon v. Dick, L. R. 10 Ch. D. 247; 39 L. T. N. S. 467; Seb. 638; Taylor v. Carpenter (1), 3 Story, 458; Cox, 14; Seb. 78; Taylor v. Carpenter (2), 2 Wood. & M. 1; Cox, 32; 9 L. T. 514; Gilka v. Mihalovitch, 50 Fed. Rep. 427.

3—McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828.

4—*Supra.*

5—Consolidated Fruit Jar Co. v. Thomas, Cox, 665. And to the same effect see La Republique Francaise v. Schultz, 42 C. C. A. 233; 102 Fed. Rep. 153; Sanders v. Jacob, 20 Mo. App. 96; N. K. Fairbank Co. v. Luckel, King & Cake Soap Co. (1), 116 Fed. Rep. 332; 54 C. C. A. 204.

6—Worchester Brewing Corp. v. Reuter & Co., 84 C. C. A. 665; 157 Fed. Rep. 217, 219.

The rule has always been, however, that laches on the part of the owner of a trademark would be a bar to his application for a preliminary injunction. Judge Wallace stated the rule as follows: "Laches in prosecuting infringers has always been recognized as a sufficient reason for denying a preliminary injunction; sometimes, apparently, by way of discipline to a complainant who has manifested reluctance to burden himself with the expense and vexation of a lawsuit, and delayed legal proceedings until his patience was exhausted. When delay of the owner of a patent or trademark to prosecute infringers has been of a tendency to mislead the public or the defendant sought to be enjoined into a false security, and a sudden injunction would result injuriously, it ought not to be granted summarily, but the complainant should be left to his relief at final hearing." [7]

In cases of unfair competition, where no technical trademark is involved, a preliminary injunction has been denied where the defendant's goods had been sold openly for many years in the package complained of.[8]

But in a later case the court of appeals of the seventh circuit has broadly applied the doctrine of *McLean v. Fleming* to a case of unfair competition;[9] to which holding the contrary has been held.[10] Knowledge by a plaintiff of a few instances of defendant's unfair competition will not be a bar to injunction.[11]

Laches which prevents recovery in one case, will not be a bar to another action of the same complainant against a subsequent infringer. Thus, in the "Hunyadi" cases, the complainant, the vendor of a Hungarian mineral water, was denied relief as to the use of the word "Hunyadi" against the vendor of water from another spring in Hungary, upon the ground of

7—Estes v. Worthington, 22 Fed. Rep. 822. To the same effect, see C. O. Burns Co. v. W. F. Burns Co., 118 Fed. Rep. 944; Havana Commercial Co. v. Nichols, 155 Fed. Rep. 302.

8—Von Mumm v. Steinmetz, 137 Fed. Rep. 168; Virginia Hot Springs Co. v. Hegeman & Co., 138 Fed. Rep. 855, 862.

9—Dr. Peter H. Fahrney & Sons Co. v. Ruminer, 82 C. C. A. 621; 153 Fed. Rep. 735, 737.

10—E. & J. Burke, Ltd. v. Bishop, 75 C. C. A. 666; 144 Fed. Rep. 838.

11—Ford Motor Co. v. Wilson, 223 Fed. Rep. 808.

laches, fourteen different Hungarian mineral waters having been marketed in the United States under the name "Hunyadi," and the complainant being estopped as to dealers in such Hungarian bitter waters by laches.[12] Subsequently an American dealer entered the market with an artificial water to which he applied the mark "Hunyadi." In affirming a decree granting the injunction, Judge Grosscup said "appellant offers a manufactured water of whose contents the public has no knowledge, and at a cost ruinous to the importation of the genuine water. The supreme court never meant, in our judgment, to throw around such a competitor the protection of the estoppel indicated, or expose the public to a device under which they would drink the waters of Lake Michigan, doctored after appellant's recipe, in the belief that they were drinking the natural waters of Hungary."[13]

§ 90. Laches and acquiescence distinguished.—"Laches" and "acquiescence" are terms frequently used synonymously, or at least without due regard to their respective meanings. "Laches" imports a merely passive, while "acquiescence" implies an active assent.[14] The Supreme Court of California has said, "'Laches' would strictly seem to imply neglect to do that which ought to have been done; 'acquiescence' a resting satisfied with or submission to an existing state of things."[15]

"Acquiescence—that is, assent—is tantamount to an agreement."[16] The Supreme Court of the United States, by Mr. Justice Swayne, has said: "Acquiescence and waiver are always questions of fact. There can be neither without knowledge. The terms import this foundation for such action. One can not waive or acquiesce in a wrong while ignorant that it has been committed. Current suspicion and rumor are not enough.

12—Saxlehner v. Nielson, 179 U. S. 43; 45 L. Ed. 77; reversing Saxlehner v. Neilson, 34 C. C. A. 690; 91 Fed. Rep. 1004; the latter reversing Saxlehner v. Neilson, 88 Fed. Rep. 71; Same v. Eisner & Mendelson Co., 179 U. S. 19; 45 L. Ed. 60.

13—Thackeray v. Saxlehner, 60 C. C. A. 562; 125 Fed. Rep. 911, 913.

14—Wood on Limitations, sec. 62.

15—Lux v. Haggin, 69 Cal. 255-269.

16—Matthews v. Murchison, 17 Fed. Rep. 760-766.

There must be knowledge of facts which will enable the party to take effectual action."[17]

§ 91. Acquiescence.—"The consent of a manufacturer to the use or imitation of his trademark by another may, perhaps, be justly inferred from his knowledge and silence; but such a consent, whether expressed or implied, when purely gratuitous, may certainly be withdrawn; and when implied, it lasts no longer than the silence from which it springs. It is, in reality, no more than a revocable license. The existence of the fact may be a proper subject of inquiry in taking an account of profits if such an account shall hereafter be decreed; but even the admission of the fact would furnish no reason for refusing an injunction."[18] This dictum of Judge Duer in *Amoskeag Mfg. Co. v. Spear* is so comprehensive as to warrant its extended quotation above given. While it was held by Vice-Chancellor Wood that a plaintiff's acquiescence in the defendant's use of his mark for two years after the plaintiff had seen it publicly exhibited would disentitle him to relief,[19] an injunction was granted in a case where a dissenting opinion shows that the essential feature of the mark had been used by others than plaintiff with his knowledge for more than twenty years.[20] It has been held in a federal circuit court that acquiescence for a time equal to that prescribed in the statute of limitations must be shown.[21] Acquiescence can not be inferred and it is revocable if it could be.[22]

17—Pence v. Langdon, 99 U. S. 578-581; 25 L. Ed. 420. See also to the same effect, Allen v. McKeen, 1 Sumn. 276-314; Evans v. Smallcombe, L. R., 3 H. L. 249; Ramsden v. Dyson, L. R., 1 H. L. 129; Reed v. West, 47 Tex. 240.

18—Amoskeag Mfg. Co. v. Spear, 2 Sandf. S. C. 599; Cox, 87. The withdrawal of gratuitous permission to use one's name may be made at the pleasure of the party granting such permission. McCardel v. Peck, 28 How. Pr. 120.

19—Beard v. Turner, 13 L. T. R. N. S. 747; Cox, 717.

20—Gillott v. Esterbrook, 47 Barb. 455; Cox, 340. Dissent of Ingraham, J.

21—Taylor v. Carpenter (2), 2 Wood. & M. 1; Cox, 32. But "laches for even less than the statutory period of limitations, aided by other circumstances, will bar a right." Acheson, J., in Prince's Met. Paint Co. v. Prince Mfg. Co., 6 C. C. A. 647; 57 Fed. Rep. 938-944, where the plaintiff was held to be estopped by eight years' acquiescence.

22—Gillott v. Esterbrook, *supra*: Amoskeag Mfg. Co. v. Spear, *supra*:

"In England the rule is stringent in trademark cases that lack of diligence in suing deprives the complainant in equity of the right either to an injunction or an account. Our courts are more liberal in this respect. A long lapse of time will not deprive the owner of a trademark of an injunction against an infringer, but a reasonable diligence is required of a complainant in asserting his rights, if he would hold a wrongdoer to an account for profits and damages. This rule, however, applies only to those cases where there has been an acquiescence after a knowledge of the infringement is brought home to the complainant." [23]

§ 92. Caution notices to infringers as evidence of acquiescence.—In a case of unfair competition, involving the number "303" applied to pens, a caution notice had been applied by the plaintiff for many years, warning the public against imitations of his pens. The court said, "we see, by his notice or 'caution,' that he knew that others, also, had used the same combination of numbers, for the purpose of defrauding him; but it does not appear that he had discovered any individual whom he could attack as an offender. Nor can I believe that a 'caution' to the public against the fraudulent use of his device can be deemed an acquiescence in the use by others of the peculiar arrangement of numbers upon steel pens and packing boxes which the plaintiff had first adopted and used and which had come to be a designation of a particular and popular pen with the public." [24]

§ 93. Abandonment.—The consideration of laches and acquiescence leads us naturally to the subject of abandonment. The first form of abandonment is by disuse of the mark. "That the right to use a trademark may be lost by abandonment or disuse is too clear to need argument or the support of authority." [25] But the length of time during which the mark

Christy v. Murphy, 12 How. Pr. 77; Cox, 164; Seb. 137; Menendez v. Holt, 128 U. S. 514; 32 L. Ed. 526.

23—Nixon, J., in Sawyer v. Kelley, 9 Fed. Rep. 601.

24—Leonard, J., in Gillott v. Esterbrook, 47 Barb. 455; Cox, Amer. Trademark Cases, 340, 363.

25—Hughes, J., in Blackwell v. Dibrell, Fed. Case No. 1475; 3 Hughes, 151; 14 Off. Gaz. 633; Price & Stewart, 39; Seb. 590; to the same effect, Laverne v. Hooper, Ind. L. R. 8 Mad. 149; Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376.

is not used is immaterial except when it is such as, taken in connection with all the circumstances, will show the intention of its owner to abandon it.[26] "A man who has a trademark may properly have regard to the state of the market and the demand for the goods; it would be absurd to suppose he lost his trademark by not putting more goods on the market when it was glutted."[27] Registration was refused in England where the applicant's mark "Emollio" had not been used by him for eleven years, and his application was opposed by one who had, in the meantime, registered the word "Emolline" as a trademark for articles similar to those upon which the applicant intended to affix his mark (perfumery).[28] Before the courts will declare an abandonment by disuse there must be satisfactory proof of intention of abandonment. It has been suggested by Chitty, J., that such intention will be gathered from the owner's acts in breaking up the moulds by which the mark is made, and taking the trademarked article from his price lists.[29]

It must be borne in mind, in this connection, that the defense of abandonment is not favored by the courts. One judge has said, "there is something very abhorrent in allowing such a defense to a wrong."[30] Although as a matter of course a trademark once abandoned may be adopted by another for the same class of merchandise,[31] there must be clear proof of the fact of abandonment,[32] and it ought to be clearly shown that such other person is adopting the same mark fairly and honestly, and not in an attempt to filch from its original owner the reputation he has obtained for it.[33] What act or acts will constitute an abandonment must be determined by the facts in each particular case. One English decision held that a

26—Burt v. Tucker, 178 Mass. 493; 59 N. E. Rep. 1111, 52 L. R. A. 112; Gillett v. Lumsden, 4 Ont. Law Rep. 300.

27—Chitty, J., in Monson v. Boehm, L. R., 26 Ch. D. 398-400; Cartmell, 233.

28—*In re* Grossmith, 6 R. P. C. 180; 60 L. T. N. S. 612; Cartmell, 137.

29—Monson v. Boehm, L. R., 26 Ch. D. 398-405; Cartmell, 233.

30—Woodbury, J., in Taylor v. Carpenter (2), 2 Wood. & M. 1; Cox, 32.

31—Menendez v. Holt, 128 U. S. 514; 32 L. Ed. 526; Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376-382.

32—Sohl v. Geisendorf, 1 Wilson (Ind.), 60; Seb. 367.

33—Royal Baking Powder Co. v. Raymond, 70 Fed. Rep. 376-382.

dismissal of a bill for injunction was an abandonment of the trademark sought to be protected by the bill.[34]

The abandonment of names used in connection with particular premises where selling or manufacturing is conducted has led to some apparent conflicts of opinion among the courts. Careful analysis of the facts will show that there is some semblance of harmony in the rulings. Whether a removal from the premises will constitute an abandonment of the use of the name depends on whether the name indicates the building itself, or merely the business conducted therein. Thus, "Booth's Theatre" designated the theatre and not the actor, and upon its sale by Edwin Booth he could not restrain his vendee from the use of the name, as Messrs. Jarrett & Palmer had fully advertised the fact that they were lessees and managers, and no question of fraud could be raised.[35] As stated by Wallace, J., in *Atlantic Milling Co. v. Robinson:* "The right to the exclusive use of a word or symbol as a trademark is inseparable from the right to make and sell the commodity which it has been appropriated to designate as the production or article of the proprietor. It may be abandoned if the business of the proprietor is abandoned. It may become identified with the place or establishment where the article is manufactured or sold, to which it has been applied, so as to designate and characterize the article as the production of that place or establishment, rather than the proprietor. A trademark of this description is of no value to the original proprietor because he could not use it without deception, and therefore would not be protected in its exclusive enjoyment. Such a trademark would seem to be an incident to the business of the place or establishment to which it owes its origin, and without which it can have no independent existence. It should be deemed to pass with a transfer of the business because such an implication is consistent with the character of the transaction and the presumable intention of the parties."[36]

34—Browne v. Freeman, 12 W. R. 305; 4 N. R. 476.

35—Booth v. Jarrett, 52 How. Pr. 169.

36—Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 218; citing Dixon Crucible Co. v. Guggenheim, 3 Am. L. T. 228; Hudson v. Osborne, 39 L. J. Ch. N. S. 79; Shipwright v. Clements, 19 W. R. 599. See also to the same effect Hall v. Barrows, 4 DeG. J. & S.

So that the use of the name "Stillman" to indicate the cloth product of the Stillman Mills;[37] "Old Oscar Pepper" to indicate the product of the distillery of that name;[38] "Osborne House" to designate a hotel first owned by Osborne;[39] "Tower Palace," designating a building, having a tower, where a clothing business was conducted,[40] are all held to be indicative of the premises and abandoned by the owner of the name who sells the premises or removes therefrom. It follows that a mere arbitrary name not designating the locality or building in which a business is transacted will survive a change in the location of the business.[41]

The length of time during which a trademark is not used is, as we have seen, merely a circumstance to be considered with all the other facts in the case in determining whether there was an intention to abandon its use. Thus, defendants have been restrained from using a mark that has lain in disuse for periods of one year,[42] three years,[43] four years,[44] nine years,[45] ten years,[46] and even twenty years.[47] The vital question is the intention of the owner of the mark, and the burden of establishing abandonment lies upon the party who affirms it.[48]

150; Glen & Hall Mfg. Co. v. Hall, 61 N. Y. 227-234; Kidd v. Johnson, 100 U. S. 617; 25 L. Ed. 769; Leather Cloth Co. v. American Leather Cloth Co., 11 Jur. N. S. 513; Ainsworth v. Walmesley, 44 L. J. 555.

37—Carmichael v. Latimer, 11 R. I. 395.

38—Pepper v. Labrot, 8 Fed. Rep. 29.

39—Hudson v. Osborne, 39 L. J. Ch. N. S. 79.

40—Armstrong v. Kleinhaus, 82 Ky. 303.

41—Dewitt v. Mathey (Ky.), 35 S. W. Rep. 1113 (not officially reported).

42—Lemoine v. Ganton, 2 E. D. Smith, 343; Cox, 142.

43—Julian v. Hoosier Drill Co., 78 Ind. 408.

44—Burt v. Tucker, 178 Mass. 493; 59 N. E. Rep. 1111, 52 L. R. A. 112.

45—Lazenby v. White, 41 L. J. N. S. 354; Saxlehner v. Eisner & Mendelson Co. (3), 179 U. S. 19; 45 L. Ed. 60. An injunction was refused because plaintiff delayed action for nine years in Amoskeag Co. v. Garner, 55 Barb. 151.

46—Wolfe v. Barnett, 24 La. Ann. 97.

47—Gillott v. Esterbrook, 48 N. Y. 374.

48—Julian v. Hoosier Drill Co., 78 Ind. 408. This is analogous to the rule that where one sued for infringing a trademark sets up a prior right to the mark in question, it is incumbent upon him to establish his prior use by satisfactory evidence. Tetlow v. Tappan, 85 Fed. Rep. 774.

There may be an involuntary abandonment of a trademark through the fact that, once distinctive, it has ceased to indicate the merchandise of the owner of the mark and has become *publici juris* because it indicates only a peculiar product or method of manufacture. This again arises from the peculiar circumstances of each case. "What is the test by which a decision is to be arrived at, whether a word which was originally a trademark has become *publici juris?* I think the test must be whether the use of it by other persons is still calculated to deceive the public; whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trademark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, or can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically as the right to a trademark is simply a right to prevent a trader from being cheated by other persons' goods being sold as his goods through the fraudulent use of the trademark, the right to the trademark must be gone." This extract from an opinion of Mellish, L. J.,[49] is probably the clearest explanation of the cases involving this topic. The cases turning upon this point are many.[50]

The adoption of a new label or brand is, of course, an abandonment of all the distinctive features of the old label or brand not preserved in the new one.[51]

49—Ford v. Foster, L. R. 7 Ch. D. 611.

50—Lazenby v. White, 41 L. J. Ch. 354; Lea v. Millar, Seb. 513; Seton (4th Ed.), 242; Lea v. Deakin, Fed. Case No. 8154; 11 Biss. 23; *In re* Arbenz, L. R., 35 Ch. D. 248; Neva Stearine Co. v. Mowling, 9 Viet. L. R. 98; Sherwood v. Andrews, 5 Am. L. R. N. S. 588; *In re* Hall, 13 Off. Gaz. 229; Liebig's Extract Co. v. Hanbury, 17 L. T. N. S. 298; Watkins v. Landon, 52 Minn. 389-393; 54 N. W. Rep. 193; 19 L. R. A. 236; Marshall v. Pinkham, 52 Wis. 572; Price & Stewart, 497. The mere fact that a name used as trademark comes into popular use in a descriptive sense does not invalidate its use as a trademark. Selchow v. Baker, 93 N. Y. 59; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-547; 34 L. Ed. 997; Burton v. Stratton, 12 Fed. Rep. 696.

51—Manhattan Medicine Co. v. Wood, 108 U. S. 218; 27 L. Ed. 706; Lea v. Millar, Seton (4th Ed.), 242; Seb. 513.

The owner of a trademark may by a practice of shipping goods bearing the mark to the same consignee, so that it may be held out to or believed by purchasers to indicate some right to the mark in the consignee, lose the exclusive right to its use.[52]

The fact that a manufacturer uses his name or an additional symbol, such as a coat-of-arms, in connection with the distinctive word, does not deprive him of his trademark right in the distinctive word. Thus the manufacturer of "Eureka" shirts, which he marked "R. Ford's Eureka Shirt, London," was awarded an injunction restraining a defendant from the sale of an article marked "The Eureka Shirt."[53] The manufacturers of "Excelsior White Soft Soap" sought to enjoin the makers of "Bustard & Co.'s Excelsior White Soft Soap," and upon the motion it was held that their right to injunctive relief was not affected by the fact that the defendants had never used the word except in conjunction with their firm name.[54]

A manufacturer who uses his trademark in connection with words indicating that his goods are the product of another maker will lose his right to have the word used as trademark protected. This was held in a case where "Eton" cigarettes were so put up as to suggest that they were of foreign manufacture.[55] But a manufacturer who uses his trademark on goods prepared for the jobbing trade, adding to or using therewith the name of the jobber, does not lose his right to the protection of the trademark, for, as said by Judge Colt: "In

52—Robinson v. Finlay, and Ward v. Robinson, L. R., 9 Ch. D. 487.

53—Ford v. Foster, L. R. 7 Ch. D. 616; L. R. 7 Ch. D. 611; 41 L. J. Ch. 682; 27 L. T. N. S. 219; 20 W. R. 818; Seb. 384. The mere addition of a coat-of-arms to a trademark (as registered in England) is not sufficient to disentitle the person using the mark to sue for an injunction. Melachrino v. Melachrino Cigarette Co., 4 R. P. C. 215; Cartmell, 223; Hammond v. Brunker, 9 R. P. C. 301; Cartmell, 142.

54—Braham v. Bustard, 1 H. & M. 447; 9 L. T. N. S. 199; 11 W. R. 1061; 2 N. R. 572; Seb. 226. The same defense was attempted where "Cottolene" was the trademark and "Cottoleo," with the defendant's name, the alleged infringement. Defendant was enjoined. N. K. Fairbank Co. v. Central Lard Co., 64 Fed. Rep. 133.

55—Wood v. Lambert, L. R. 32 Ch. D. 247.

doing this no real deceit was practiced upon the public, because the purchaser obtained the same goods which he would have purchased if the name of the jobber had not been upon them."[56] In one case it was argued by the defendants that when the plaintiffs furnished their "Excelsior" stoves to the trade and marked the dealers' names upon the stoves, they thereby permitted the dealer to hold himself out to the public as the manufacturer of the stoves. This was not a successful defense, but the court stood upon the fact that there was "nothing in connection with the names of these dealers to indicate that they are the manufacturers, and there is no evidence that any one ever supposed they were the manufacturers."[57]

Advertisements published in the United States by a corporation having the exclusive sale of certain Hungarian mineral waters, to the effect that the name under which the waters were sold had become a general name for all similar waters, and that the corporation would thenceforth distinguish the particular water sold by it by a special trademark, were held not to evidence an abandonment of the original mark which was binding on the owner of the wells; Mr. Justice Brown announcing the following rule: "To establish the defense of abandonment it is necessary to show not only acts indicating a practical abandonment, but an actual intent to abandon. Acts which unexplained would be sufficient to establish an abandonment may be answered by showing that there never was an intention to give up and relinquish the right claimed."[58]

56—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896-898. "One does not lose the goodwill of his trade in an article of his manufacture by placing upon it the names of his customers who are engaged in selling it, nor by the fact that the consumers know only the name and excellence of the article, and neither know nor care who makes it," Sanborn, J., in Shaver v. Heller & Merz Co., 108 Fed. Rep. 821-824; 48 C. C. A. 48; affirming Heller & Merz Co. v. Shaver, 102 Fed. Rep. 882. To the same effect, City Brewery Co. v. Powell, L. R. (1897), App. Cas. 710, 716; Lichtenstein v. Goldsmith, 37 Fed. Rep. 359.

57—Sheppard v. Stuart, 13 Phila. 117; Price & Steuart, 193.

58—Saxlehner v. Eisner & Mendelson Co., 179 U. S. 19-31; 45 L. Ed. 60; citing Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 186; 41 L. Ed. 118, 125; 16 Sup. Ct. Rep. 1002; Moore v. Stevenson, 27 Conn. 14; Livermore v. White, 74 Me. 452; 43 Am. Rep. 600; Judson v. Malloy, 40 Cal. 299; Hickman v. Link, 116 Mo. 123; 22 S. W. Rep. 472.

In the same case, the discontinuance of two suits for infringement, brought by the selling corporation, after preliminary injunctions had been obtained, are held by the supreme court not to be binding upon the complainant in the absence of proof that the discontinuance was made with the complainant's knowledge and acquiescence.[59]

The English Rule. That mere cessation of use does not establish abandonment of the trademark has been thus stated, "to constitute abandonment an intention to abandon must be shown. Mere non-user of a trademark can no more be said to constitute abandonment than the mere non-user of a right to foul a stream belonging to a mill as an easement can be said to constitute an abandonment of the easement."[60]

There may be a constructive abandonment of specific features of a trademark, arising from a failure to enumerate such features in securing registration. If the registration shows a claim to a trademark "more limited in its description than the owner's common-law rights would otherwise be, the owner is bound by such limitation as showing what he really claimed."[61] Thus, in an application for registration of a trademark, the failure to claim the letter "s" as a part or feature thereof was held to be an abandonment of that feature of the mark.[62]

A person who acquires a patent covering a manufactured article known by a trademark, may, during the life of the patent, enjoin an infringer even though he has ceased manufacturing the patented article.[63]

A trademark, once abandoned, may be adopted by another.[64]

59—Saxlehner v. Eisner & Mendelson Co., 179 U. S. 19, 34; 45 L. Ed. 60.

60—Chitty, J., in Mouson & Co. v. Boehm, L. R. 26 Ch. D. 398. As to evidence of abandonment see Louise & Co. Ltd. v. Gainsborough, 20 R. P. C. 61; Blogg v. Anderson, N. S. W. 21 L. R. Eq. 238; *In re* Wright, Crossley & Co.'s Application, 17 R. P. C. 386.

61—Hawley, J., in Hennessy v. Braunschweiger & Co., 89 Fed. Rep. 664-668; citing Kohler Mfg. Co. v. Beeshore, 8 C. C. A. 215; 59 Fed. Rep. 572; Richter v. Reynolds, 8 C. C. A. 220; 59 Fed. Rep. 577.

62—Pittsburgh Crushed Steel Co. v. Diamond Steel Co., 85 Fed. Rep. 637.

63—Janney v. Pan-Coast Ventilator Mfg. Co., 128 Fed. Rep. 121.

64—Deitsch v. Geo. G. Gibson Co., 155 Fed. Rep. 383; W. A. Gaines & Co. v. Kahn, 155 Fed. Rep. 639, 645; Cohen v. Nagle, 190 Mass. 4; 76 N. E. Rep. 276; Daniel v. Whitehouse, 15 R. P. C. 134.

CHAPTER VI.

GOODWILL.

§ 94. **Defined.**—Goodwill, because of the various forms in which it exists, is difficult of definition. It may be personal, in which event it is the result of the labor and efforts of the person to whom it belongs and survives a change of locality. It may be local, in which event the personal efforts of those who have created or assisted in creating it have so identified it with the location that it adheres thereto and does not attach to a business subsequently established elsewhere by the same persons. Or, in the case of local goodwill, the goodwill may have largely had its origin in the natural advantages of the locality before any personal exertions have been expended upon it; as, for example, a location upon a water front peculiarly accessible and desirable as a location for the erection of a grain elevator, ship yard, pier or warehouse, where there exists a natural advantage of site before human enterprise erects the elevator or other structure. The goodwill which then arises consists of three things, the natural advantages of the site, the erection of a suitable building or structure with its proper mechanical equipment, and, finally, the good reputation that results from skillful, enterprising, and honest management of the business. The definitions of goodwill, therefore, must be read in the light of these distinctions.

"Goodwill is a modern but important growth of the law, not mentioned by some of the early writers, but given great prominence at the present time."[1] Mr. Justice Story has defined goodwill as "the advantage or benefit which is acquired by an establishment beyond the mere value of the capital, stock, funds, or property employed therein, in consequence of the general public patronage and encouragement which it receives from constant or habitual customers, on account

1—Vann, J., in People v. Roberts, 159 N. Y. 70-80; 53 N. E. Rep. 685; 45 L. R. A. 126.

of its local position or common celebrity, or reputation for skill or affluence, or punctuality, or from other accidental circumstances or necessities, or even from ancient partialities or prejudices." [2]

It would be very difficult, if indeed possible, to frame a more accurate and comprehensive definition of local goodwill. This one, as given, has been expressly and *in hæc verba* adopted by the Supreme Court of the United States, Mr. Chief Justice Fuller prefacing his use of it by saying "there is difficulty in deciding accurately what is included under the term." [3]

2—Story on Partnership, § 99.

3—Metropolitan Bank v. St. Louis Dispatch Co., 149 U. S. 436-446; 37 L. Ed. 799. "It is the probability that the business will continue in the future as in the past, adding to the profits of the concern and contributing to the means of meeting its engagements as they come in." Sanderson, J., in Bell v. Ellis, 33 Cal. 620-625.

"Goodwill was defined by Lord Eldon in Cruttwell v. Lye, 17 Ves. 335-346, to be 'nothing more than the probability that the old customers will resort to the old place;' but Vice-Chancellor Wood, in Churton v. Douglas, Johnson, 174-188, says it would be taking too narrow a view of what is there laid down by Lord Eldon to confine it to that, but that it must mean every positive advantage that has been acquired by the old firm in the progress of its business, whether connected with the premises in which the business was previously carried on, or with the name of the late firm or with any other matter carrying with it the benefit of the business." Mr. Chief Justice Fuller in Menendez v. Holt, 128 U. S. 514-522; 32 L. Ed. 526.

"The goodwill of an established business, which is a common subject of contract, is nothing but the chance of being able to keep the business which has been established." Wallace, J., in Barber v. Connecticut Mutual Life Ins, Co., 15 Fed. Rep. 312, 313.

"It is property of a very peculiar and exceptional character. It is intangible property which, in the nature of things, can have no existence apart from a business of some sort that has been established and carried on at a particular place." Thayer, J., in Metropolitan Bank v. St. Louis Dispatch Co., 36 Fed. Rep. 722-724.

"The goodwill of a business comprises those advantages which may inure to the purchaser from holding himself out to the public as succeeding to an enterprise which has been identified in the past with the name and repute of his predecessor." Wallace, J., in Knoedler v. Boussod, 47 Fed. Rep. 465, 466. This definition was approved on appeal. Knoedler v. Glaenzer, 55 Fed. Rep. 895-899.

"Goodwill has been defined as 'all that good disposition which customers entertain toward the house or business identified by the particular name or firm, and which may induce them to continue giving their custom to it.'

The goodwill of a partnership "stands on the same footing in the settlement of partnership affairs as the tangible

There is nothing marvelous or mysterious about it. When an individual or a firm or a corporation has gone on for an unbroken series of years conducting a particular business, and has been so scrupulous in fulfilling every obligation, so careful in maintaining the standard of goods dealt in, so absolutely honest and fair in all business dealings that customers of the concern have become convinced that their experience in the future will be as satisfactory as it has been in the past, while such customers' good report of their own experience tends continually to bring new customers to the same concern, there has been produced an element of value quite as important—in some cases, perhaps, far more important—than the plant or machinery with which the business is carried on. That it is property is abundantly settled by authority, and, indeed, is not disputed. That in some cases it may be very valuable property is manifest." Lacombe, J., in Washburn v. National Wall Paper Co., 81 Fed. Rep. 17-20.

"Goodwill has been defined by this court to be 'the favor which the management of a business wins from the public, and the probability that old customers will continue their patronage.'" McGrath, J., in Williams v. Farrand, 88 Mich. 473-477. This is Judge Cooley's definition, which has been approved in White v. Trowbridge, 216 Pa. 11; 64 Atl. Rep. 862.

"There is considerable difficulty in defining accurately what is included under this term *goodwill:* it seems to be that species of connection in trade which induces customers to deal with a particular firm. It varies almost in every case, but it is a matter distinctly appreciable which may be preserved (at least to some extent), if the business be sold as a going concern, but which is wholly lost if the concern is wound up, its liabilities discharged, and its assets got in and distributed." Sir John Romilly, M. R., in Wedderburn v. Wedderburn, 22 Beavan, 84-104.

"Just what 'goodwill' includes is not easy of definition. Nay, it varies with the customs of the general trade and the character or methods of the particular business. An early definition by Lord Eldon is 'the probability that the old customers will resort to the old place.' This involved the ancient idea that goodwill inhered in the premises where the business was conducted, which had some justification when considering an inn, tavern, or theater, as in most of the early cases. This, however, is too limited for modern kinds or methods of business. The habit of people to purchase from a certain dealer or manufacturer, which is the foundation for any expectation that purchases will continue, may depend on many things besides place. Confidence in the quality of the goods, in the facilities of the establishment to fill orders promptly, or in the personal integrity or skill of a dealer or manufacturer, familiarity of the public with a designating name for the product, and

property;"[4] the name and style under which its business has been conducted is a part of the goodwill.[5] Corporations may acquire goodwill, just as natural persons, and an assignee of the corporate goodwill and business may use the old corporate name, either with or without an incorporation.[6]

That goodwill attaches to the capital stock. "There is no goodwill in a share of stock over and above the goodwill which belongs to the corporation, and if the corporation sells and conveys all that it possesses 'capable of private ownership,' it sells and conveys its goodwill, and there is nothing left of goodwill or anything else belonging to the stockholders."[7]

Goodwill which is local, and not personal in nature, will pass to the trustee in bankruptcy.[8]

§ 95. In particular cases.—"As applied to a newspaper, the goodwill usually attaches to its name rather than to the place of publication. The probability of the title continuing to attract custom in the way of circulation and advertising patronage, gives a value which may be protected and disposed of and constitutes property."[9]

probably many other circumstances, might be mentioned as illustrative. The goodwill is a sort of beaten pathway from the seller to the buyer, usually established and made easy of passage by years of effort and expense in advertising, solicitation, and recommendation by traveling agents, exhibition tests or displays of goods, often by acquaintance with local dealers who enjoy confidence of their own neighbors, and the like." Rowell v. Rowell, 122 Wis. 1, 17.

"The peculiar right, or rather expectancy, called 'goodwill,' assumes that certain business has been established and carried on at some specific place. It consists in the probability, based upon the habits of men, that the persons who have been accustomed to deal with that business, at that specific place, as well as others will continue to go to such place and deal in the future." Pomeroy, Eq. Juris. § 1355; adopted by Stewart, J., in Kaufmann v. Kaufmann, 239 Pa. 42; 86 Atl. Rep. 634.

4—Iman v. Inkster, 90 Neb. 704; 134 N. W. Rep. 265.

5—James Van Dyk Co. v. F. V. Reilly Co., 130 N. Y. S. 755; 73 Misc. Rep. 87.

6—United States L. & H. Co. v. United States L. & H. Co., 181 Fed. Rep. 182, 184.

7—Mr. Justice Brewer, in San Francisco Natl. Bank v. Dodge, 197 U. S. 70, 93; 49 L. Ed. 669.

8—Loveland, Bankruptcy, § 390.

9—Metropolitan Bank v. St. Louis Dispatch Co., 149 U. S. 436-446; 37 L. Ed. 799; affirming s. c., 36 Fed. Rep. 722. To the same effect see Porter v. Gorman, 65 Ga. 11; Dayton v. Wilkes, 17 How. Pr. 510.

The goodwill and name of a

Goodwill is an appurtenant of every form of business which relies directly upon public favor. "But the terms goodwill and business are not synonymous. Goodwill, like a trademark, is but an incident to, and can have no existence apart from, the business in which it had its origin."[10] We find in the books cases in which the existence of a valuable goodwill is found as appurtenant to a wide range of mercantile pursuits; as, for example, in the business of flour and grain merchants,[11] the manufacture of patent medicines,[12] and of ferro plates and picture frames,[13] the business of a stage-line,[14] a livery-stable,[15] a milk-route,[16] a drinking saloon,[17] or where the owners of the goodwill were bankers,[18] bakers,[19] glass-stainers,[20] haberdashers,[21] glass-blowers,[22] brewers,[23] hardware dealers,[24] tailors,[25] cheesemongers,[26] provision merchants,[27] manufacturing chemists,[28] real estate and fire insurance agents,[29] commission agents,[30] mercers,[31] paper-makers,[32] pencil-makers,[33] hotel or public-house keepers,[34] whiskey

newspaper may attach to the printing plant, so as to be vested in the lessee of the plant. Lane v. Smythe, 46 N. J. Eq. 443-454.

10—Van Orsdel, J., in Mayer Fertilizer & Junk Co. v. Virginia-Carolina Chem. Co., 35 App. D. C. 425; 156 O. G. 539.

11—Menendez v. Holt, 128 U. S. 514-522; 32 L. Ed. 526.

12—Brown Chemical Co. v. Meyer, 31 Fed. Rep. 453; s. c., 139 U. S. 540; 35 L. Ed. 247.

13—Dean v. Emerson, 102 Mass. 480.

14—Pierce v. Fuller, 8 Mass. 228.

15—Herbert v. Dupaty, 42 La. Ann. 343.

16—Munsey v. Butterfield, 133 Mass. 492.

17—Howard v. Taylor, 90 Ala. 241.

18—Smith v. Everett, 27 Beavan, 446.

19—Costello v. Eddy, 12 N. Y. Supp. 236.

20—Scott v. Rowland, 20 W. R. 208.

21—*In re* Randall's Estate, 8 N. Y. Supp. 652.

22—Featherstonhaugh v. Fenwick, 17 Ves. 298.

23—Hall v. Hall, 20 Beavan, 139.

24—Thompson v. Andrus, 73 Mich. 551.

25—Parsons v. Hayward, 31 L. J. Ch. 666.

26—Hudson v. Osborne, 39 L. J. Ch. 79.

27—Scott v. Mackintosh, 1 V. & B. 503.

28—Turner v. Major, 3 Giff. 442.

29—Armstrong v. Bitner, 71 Md. 118; Thompson v. Winnebago County, 48 Iowa, 155.

30—Macdonald v. Richardson, 1 Giff. 81.

31—Morris v. Moss, 25 L. J. Ch. 194.

32—Potter v. Commissioners of Inland Revenue, 10 Ex. 147.

33—Banks v. Gibson, 34 Beavan, 566.

34—Spratt v. Jeffery, 10 B. & C. 249; Lashus v. Chamberlain, 6 Utah, 385; Elliott's Appeal, 60 Pa.

merchants,[35] dyers,[36] dealers in works of art and artists' materials,[37] dealers in boots and shoes,[38] tobacco brokers,[39] hide dealers,[40] snuff makers,[41] upholsterers,[42] iron masters,[43] dealers in seeds, grain and plants,[44] carriers,[45] milliners;[46] and as we will see elsewhere, physicians, solicitors and attorneys may have a vendible goodwill.

It is patent that a goodwill may be created in connection with any business, enterprise, occupation or profession. The older cases expressly denied the existence of a goodwill which could be the subject of sale, in connection with the learned professions. Thus, Lord Chancellor Chelmsford, as recently as 1858, said: "The term goodwill seems wholly inapplicable to the business of a solicitor, which has no local existence, but is entirely personal, depending upon the trust and confidence which persons may repose in his integrity and ability to conduct their legal affairs."[47]

That there is good reasoning in this dictum can not be denied. In a case of later date, in Scotland, it was said: "There is truly no such thing as goodwill in the case of a business carried on by a professional man, such as a physician, surgeon, or law agent, whose success depends entirely upon his own personal skill. It is quite different in the case of a trade or manufacture, where the employer may have the possession of patents or trade secrets, or may, by long exercise of his trade or manufacture in some particular locality, have drawn

St. 161; Musselman & Clarkson's Appeal, 62 Pa. St. 81.

35—Kidd v. Johnson, 100 U. S. 617; 25 L. Ed. 769.

36—Bryson v. Whitehead, 1 S. & S. 74.

37—Knoedler v. Boussod, 47 Fed. Rep. 465; Knoedler v. Glaenzer, 55 Fed. Rep. 895.

38—Curtis v. Gokey, 68 N. Y. 300.

39—Davies v. Hodgson, 25 Beavan, 177.

40—Goodman v. Henderson, 58 Ga. 567.

41—Hammond v. Douglas, 5 Ves. 539.

42—Chissum v. Dewes, 5 Russ. 29.

43—Hall v. Barrows, 4 DeG. J. & S. 150.

44—Iowa Seed Co. v. Dorr, 70 Ia. 481.

45—Cruttwell v. Lye, 17 Ves. 335.

46—Shackle v. Baker, 14 Ves. 468.

47—Austen v. Boys, 2 DeGex & Jones, 626-636. And to the same effect see Sheldon v. Houghton, 5 Blatchf. 285, 291, Fed. Case No. 12,748; Craver v. Acme Harvester Co., 209 Ill. 483; 70 N. E. Rep. 1047, affirming Acme Harvester Co. v. Craver, 110 Ill. App. 413.

together skilled artisans and attracted the custom of a district to his establishment. In such a case it is not the individual skill of the employer, but the reputation which his establishment has acquired, which creates that incorporeal, but frequently valuable, estate known as the 'goodwill' of a trade. But there is no such thing in the case of a professional man. His business dies with him, and the man who comes after him in the district must depend for success upon his own exertions. It is quite true that such businesses are occasionally sold; but what is thus sold in case of a living professional man retiring from business is truly the personal recommendation which the seller gives to his former clients or patients in favor of his successor, coupled with the predecessor's own retirement from business. But where the physician or law agent is dead, nothing of the kind can take place. He has been removed by death from all possibility of competing with the new doctor or the new solicitor, and his voice being forever silenced, he can not give any recommendation to his clients or patients."[48]

While the courts have, for the reasons stated, looked with disfavor upon executory contracts for the sale of the goodwill of a professional man's practice, and have refused to decree

48—Lord Curriehill in Bain v. Munro, 15 Scot. L. Rep. 260. It has been held that the goodwill of an attorney was not a subject of administration. Spice v. James, Sch. 46; Arundell v. Bell, 52 L. J. Ch. 537.

In an early case, however, it was held that a contract entered into by a practicing attorney to relinquish practice, recommend his clients to his successor, that he would not practice within certain limits, and would permit the use of his name in the first name of his successor for a certain period, was good in law. (1803) Bunn v. Guy, 4 East, 190. And in a similar case, where a solicitor sold his practice and agreed not to practice in Great Britain for twenty years, Lord Langdale held the contract valid and binding on the vendor, and he was enjoined from attempting to resume his practice in Great Britain during the specified time. (1841) Whittaker v. Howe, 3 Beavan, 383.

But the courts have refused to decree specific performance of a contract for the sale of an attorney's practice. Bozon v. Farlow, 1 Mer. 459; Sch. 22; Thornbury v. Bevill, 1 Y. & C. Ch. 554; 6 Jur. 407; Sch. 71.

And where a member of a firm of surgeons died, it was held that the survivor could not be obliged to sell the goodwill of the practice for the joint benefit of himself and his deceased partner's

specific performance under such contracts,[49] still when the sale is complete and the contract partly executed, its terms will be enforced.[50] Thus where a solicitor retired, permitting his partner to continue the use of the firm name, in consideration of an annuity to be paid him, and the continuing partner defaulted in the payment of the annuity, the contract was specifically enforced.[51]

In the United States there have been frequent instances of the sale of the goodwill of a medical practitioner, and contracts for such sales have been uniformly held good.[52]

There may be goodwill attaching to a remedy and a method of treatment in which it is employed.[53]

§ 96. As a subject of sale.—"The goodwill of a trade is a subject of value and price. It may be sold, bequeathed, or

estate, Vice-Chancellor Leach remarking that "such partnerships are very different from commercial partnerships." Farr v. Pearce, 3 Madd. 74.

49—See last note.

50—Hanna v. Andrews, 50 Ia. 462; Smalley v. Greene, 52 Ia. 241.

51—Aubin v. Holt, 2 K. & J. 66.

52—Webster v. Williams, 62 Ark. 101; 34 S. W. Rep. 537; Bradbury v. Barden, 35 Conn. 577; Martin v. Murphy, 129 Ind. 464; Pickett v. Green, 120 Ind. 584; Hoyt v. Holly, 39 Conn. 326; Gilman v. Dwight, 13 Gray, 356; Dwight v. Hamilton, 113 Mass. 175; Warfield v. Booth, 33 Md. 63; Miller v. Keeler, 9 Pa. Co. Ct. R. 274; Butler v. Burleson, 16 Vt. 176; Tichenor v. Newman, 186 Ill. 264; 57 N. E. Rep. 826.

But, to the contrary, see Mandeville v. Harman, 42 N. J. Eq. 185. In this case the covenant was as follows: "In consideration of this contract, made with him by the said Mandeville, the said Harman hereby covenants and agrees not to engage in the practice of medicine or surgery in the city of Newark at any time hereafter." The court held that the law was unsettled as to whether such a contract was or was not void as in restraint of trade, and therefore denied the preliminary injunction sought for.

"In the practice of dentistry, the personal qualities of integrity, professional skill and ability attach to and follow the person, not the place." Braley, J., in Foss v. Roby, 191 Mass. 292, 297; 81 N. E. Rep. 199; 10 L. R. A. (N.S.) 1200. To the same effect see Hutchinson v. Nay, 187 Mass. 262; 72 N. E. Rep. 974; 68 L. R. A. 186; Moore v. Rawson, 199 Mass. 494; 85 N. E. Rep. 586; Wightman v. Wightman (Mass.), 111 N. E. Rep. 881.

As to the sale by a physician of his interest in the goodwill of his firm, see Mills v. Ressler, 87 Kan. 549; 125 Pac. Rep. 58.

53—Pope-Turnbo v. Bedford, 147 Mo. App. 692; 127 S. W. Rep. 426.

become assets in the hands of the personal representative of a trader,"[54] or it may be mortgaged.[55]

It may be of greater value than the stock of goods or plant of machinery with which the business is carried on,[56] or it may attach to the mere name of a publication and have a definite value apart from and in no wise dependent upon any tangible property.[57]

It can not be sold, by a judicial decree or otherwise, apart from the business with which it is connected.[58]

It may be given, together with the business with which it is connected, in payment for stock in a corporation, so that stock issued solely for such goodwill will, to the extent of its value, be issued for "property actually received" within the meaning of section 42 of the stock corporation law of the state of New York.[59] The goodwill of a domestic corporation is property which is taxable as part of its capital stock.[60] That of a foreign corporation is liable to taxation "at the place where it has a market value."[61]

A stockholder (holding less than all of its stock) can not transfer the goodwill of a corporation.[62]

It is clear that the goodwill of a professional man can not be made the subject of involuntary sale. In the language of the Supreme Court of Tennessee, "certainly there can be no forced sale or transfer *in invitum* of such (professional) goodwill so far as it is based upon professional reputation and standing, such as arises from the skill of physicians, dentists,

54—Tindal, C. J., in Hitchcock v. Coker, 6 Ad. & E. 428-454.

55—Metropolitan National Bank v. St. Louis Dispatch Co., 36 Fed. Rep. 722, 724.

56—Washburn v. National Wall Paper Co., 81 Fed. Rep. 17-20.

57—Metropolitan Bank v. St. Louis Dispatch Co., 149 U. S. 436-446; 37 L. Ed. 799; Boon v. Moss, 70 N. Y. 465.

58—Robertson v. Quiddington, 28 Beavan, 529; Metropolitan National Bank v. St. Louis Dispatch Co., 36 Fed. Rep. 722 724; s. c., 149 U. S. 436-446. But the purchaser of the goodwill need not purchase all of the assets of the business. S. F. Myers Co. v. Tuttle, 183 Fed. Rep. 235.

59—Washburn v. National Wall Paper Co., 81 Fed. Rep. 17.

60—Matter of Hondayer, 150 N. Y. 37. That the goodwill of a newspaper is not taxable see Hart v. Smith, 139 Ind. 182; 64 N. E. Rep. 661; 58 L. R. A. 949; 95 Am. St. Rep. 280.

61—People v. Roberts, 159 N. Y. 70; 53 N. E. Rep. 685; People v. Morgan, 96 App. Div. 110.

62—Spring Valley Water Works v. Schottler, 62 Cal. 69, 118.

attorneys, etc., whatever may be done as to such goodwill as arises out of location."[63]

It must be remembered that the trademarks and the goodwill of a business are inseparable. We have seen elsewhere that a trademark can have no existence in gross. It is strictly appurtenant to the goodwill of the business in which it is used.[64] And so it has been said of goodwill that "while it is not necessarily local, it is usually to a great extent, and must of necessity, be incident to a place, an established business, or a name known to the trade."[65]

In a conveyance of goodwill, however, apt words should be employed. Thus it has been held that the goodwill was not covered by a clause in a contract of partnership relating to the partnership "property, credits and effects," or "stock in trade and effects."[66] And a similar holding has been made in regard to the words "premises, stock in trade, etc.,"[67] as well as where the words "estate and effects" were used in partnership articles.[68]

On the other hand, Lord Westbury construed the words, "stock belonging to the partnership," to include the goodwill,[69] and other eminent judges have held goodwill to be included in the words "moneys, stock in trade, debts, effects and things,"[70] and "property and effects,"[71] while Vice-Chancellor Malins said: "The sale of a business is a sale of the goodwill. It is not necessary that the word 'goodwill' should be mentioned. * * * In the sale of a business a trademark passes, whether specially mentioned or not." He

63—Wilkes, J., in Slack v. Suddoth, 102 Tenn. 375.

64—"As an abstract right, apart from the article manufactured, a trademark can not be sold, the reason being that such transfer would be a fraud upon the public." Colt, J., in Morgan v. Rogers, 19 Fed. Rep. 596. And to same effect, Witthaus v. Braun, 44 Md 303; Hoxie v. Chaney, 143 Mass. 592; 10 N. E. Rep. 713; Russia Cement Co. v. Lepage, 147 Mass. 206; 17 N. E. Rep. 304.

65—Vann, J., in People v. Roberts, 159 N. Y. 70-83; 53 N. E. Rep. 685; 45 L. R. A. 126.

66—Hall v. Hall, 20 Beavan, 139.

67—Burfield v. Rouch, 31 Beavan, 241.

68—Steuart v. Gladstone, L. R. 10 Ch. D. 646.

69—Hall v. Barrows, 4 DeG. J. & S. 150.

70—Rolt v. Bulmer, Seb. 614.

71—Reynolds v. Bullock, 47 L. J. Ch. 773.

accordingly held that goodwill was included in an assignment that conveyed all the assignor's interest in the partnership premises and effects, without specifically referring to the goodwill.[72] In a suit for the specific performance of a contract for the purchase of a share in a business, in which the expression "goodwill, etc.," was employed, Lord Romilly was of opinion that "these words are connected together, and unite such other things as are necessarily connected with and belong to the goodwill, many of which are easily pointed out; for instance, the use of trademarks. * * * All these would be included in the words *et cetera*, and would be included in the conveyance."[73]

The words "business connections and patronage" have been held to convey the goodwill.[74]

In this connection it is to be noted that there are two general classes of goodwill—general and local. The distinction is well-drawn in an English case, as follows: "In some classes of business, when the trade has long been carried on in a profitable manner in a particular house, and a new tenant comes in and continues to carry on the same business there, it is found by experience that many, if not all, of the customers resort there as before. This is found so regularly to happen that it has become usual to pay money value for it, which is commonly called 'goodwill.' It may be that there may be a species of goodwill which may be the subject of bargain and sale, although not dependent on the business being carried on in any particular place; for instance, in the case of what are called 'quack-medicines.' But when we come to speak of the goodwill of a public-house, it is obvious that it is a thing

72—Shipwright v. Clements, 19 W. R. 599. But a mortgage of the entire assets of a business does not necessarily include the goodwill. Santa Fe Electric Co. v. Hitchcock 9 New Mex. 156; 50 Pac. Rep. 332.

73—Cooper v. Hood, 26 Beavan, 293.

74—Kellog v. Totten, 16 Abb. Pr. 35. A bill of sale of a "livery outfit" with a covenant not to engage in the livery business in opposition to the vendee, was construed to convey the goodwill; the covenant not to re-engage "would import, necessarily, the sale of the goodwill * * * as effectually as if that term had been incorporated in the writing." McClellan, J., in Smith v. Webb, 176 Ala. 596; 58 So. Rep. 913.

which is attached to a locality."[75] In accordance with this rule, whenever the goodwill is local, in the sense of being attached to a particular house or store, it will pass with a sale of the lease of the trading premises,[76] or the sale of a public house,[77] or even a tailoring establishment.[78]

§ 97. Goodwill subject to proceedings in eminent domain. —Where the goodwill of a business transacted on particular premises has been injured by the invasion of the realty in eminent domain proceedings, the Massachusetts court has said that such goodwill of a lessee or owner "is not property for which damages can be included, and is to be considered only so far as it tends to embrace the market value of the estate that is injured."[79]

§ 98. Goodwill in its relation to firm and other names.— While the unity existing between goodwill and trademarks is clearly defined, the subject of tradenames or firm-names in their relation to goodwill is attended with some difficulty. The general rule has been well stated by Vice-Chancellor Wood, as follows: "The name of a firm is a very important part of the goodwill of the business carried on by the firm. A person says: 'I have always bought good articles at such a house of business; I know it by that name, and I send to the house of business identified by that name for that purpose.' There are cases every day in this court with reference to the use of the name of a particular firm, connected generally, no doubt, with the question of trademark. But the question of trademark is in fact the same question. The firm stamps its name on the articles. It stamps the name of the firm which is carrying on the business on each article, as a proof that they emanate from the firm; and it becomes the known firm to which applications are made, just as much as when a man enters a shop in a particular locality. And when you

75—Llewellyn v. Rutherford, L. R. 10 C. P. 456.

76—Daugherty v. Van Nostrand, 1 Hoff. Ch. (N. Y.) 68; Williams v. Wilson, 4 Sandf. Ch. 379.

77—*Ex parte* Punnett, L. R. 16 Ch. D. 226; Elliott's Appeal, 60 Pa. St. 161.

78—Parsons v. Hayward, 31 Beavan, 199; Chittenden v. Witbeck, 50 Mich. 401-421.

79—Edmonds v. Boston, 108 Mass. 549.

are parting with the goodwill of a business, you mean to part with all that good disposition which customers entertain towards the house of business identified by the particular name or firm, and which may induce them to continue giving their custom to it. You can not put it anything short of that. That the name is an important part of the goodwill of a business is obvious, when we consider that there are at this moment large banking firms, and brewing firms, and others, in this metropolis, which do not contain a single member of the individual name exposed in the firm."[80] This dictum, however, is flatly opposed to the rulings of the American courts, that the sale of the goodwill of a business carries with it no right to the use of the vendor's name as the name of the establishment,[81] although the purchaser may properly advertise himself as being "successor to" his vendor.[82] And the later English cases indicate that the rule has been somewhat modified in England, Justice Stirling saying, "the defendant is entitled to use the plaintiff's name in the business so long and so far as he does not by so doing expose him to any liability, but no further."[83] The American courts have very properly gone to the length of holding that, upon the withdrawal of a partner, the remaining partners will be enjoined from continuing the use of a firm name which indicates that the withdrawing partner is still a member of the firm.[84] Where the name is not a proper name, its subsequent use by the vendor of the goodwill will of course be enjoined.[85]

§ 99. **Rights of vendor.**—The vendor of the goodwill of a business may, in the absence of any agreement to the contrary, re-engage in a competitive business.[86]

80—Churton v. Douglas, Johns. 174.

81—Knoedler v. Glaenzer, 55 Fed. Rep. 895; Reeves v. Denicke, 12 Abb. Pr. N. S. 92.

82—Knoedler v. Glaenzer, 55 Fed. Rep. 895; Weed v. Peterson, 12 Abb. Pr. N. S. 178; Smith v. David H. Brand & Co., 67 N. J. Eq. 529; 58 Atl. Rep. 1029.

83—Thynne v. Shove, L. R. (1890) 45 Ch. D. 577-582.

84—McGowan v. McGowan, 22 Ohio St. 370.

85—Drake v. Dodsworth, 4 Kas. 159.

86—Hoxie v. Chaney, 143 Mass. 592-596; 10 N. E. Rep. 713; 58 Am. Rep. 149; Trego v. Hunt, 65 L. J. Ch. 1.

As said by Chief Justice Bigelow in the Supreme Court of Massachusetts: "Whenever such is the intent of the parties, it is carried into effect by an express stipulation, which, if not in undue restraint of trade, may be valid and binding. But we know of no case where any such agreement has been raised by mere implication, arising from the sale of the goodwill of a person's trade, in connection with a particular place of business where it has been carried on."[87]

In a later case involving the sale of the goodwill of a medical practice, the same court distinguished the facts from those in the case quoted from, and held that a sale of this kind of goodwill contained by implication a covenant not to reengage in the medical practice in the same locality.[88]

An English writer has said: "As the decisions at present stand, the title to this section is to some extent misleading, inasmuch as the legal position of the assignor of a business, after he has parted with it, is in no way different from that of any other member of the public, provided, of course, that he has not bound himself by additional restrictive covenants."[89] Even in the absence of express stipulation, good faith requires of a party who has sold the goodwill of his business that he should do nothing which tends to deprive

87—Bassett v. Percival, 87 Mass. (5 Allen), 345-347; and to the same effect see Porter v. Gorman, 65 Ga. 11; Knoedler v. Bonssod, 47 Fed. Rep. 465; Knoedler v. Glaenzer, 55 Fed. Rep. 895; Bergamini v. Bastien, 35 La. Ann. 60; 48 Am. Rep. 216; White v. Jones, 1 Abb. Pr. N. S. 337; Howe v. Searing, 6 Bosw. 354; Cruttwell v. Lye, 17 Ves. 335; Dayton v. Wilkes, 17 How. Pr. 516; Hanna v. Andrews, 50 Ia. 462; Cottrell v. Babcock Mfg. Co., 54 Conn. 138; Costello v. Eddy, 128 N. Y. 650; Williams v. Farrand, 88 Mich. 473; Jackson v. Byrnes, 103 Tenn. 698; 54 S. W. Rep. 984; Holbrook v. Nesbit, 163 Mass. 120; 39 N. E. Rep. 794; Grimm v. Walker, 45 Iowa, 106; Smith v. Gibbs, 44 N. H. 335; Moody v. Thomas, 1 Disney, 294; Washburn v. Dosch, 68 Wis. 436; 32 N. W. Rep. 551; Bradford v. Peckham, 9 R. I. 250; Rupp v. Over, 3 Brewst. 133; Moreau v. Edwards, 2 Tenn. Ch. 347; Palmer v. Graham, 1 Pars. Eq. Cas. 476; Findlay v. Carson, 97 Iowa, 537; 66 N. W. Rep. 759; Drake v. Dodsworth, 4 Kansas, 135; Ranft v. Reimers, 200 Ill. 386; 60 L. R. A. 291; 65 N. E. Rep. 720; Counts v. Medley, 163 Mo. App. 546; Wessell v. Havens, 91 Neb. 426; 136 N. W. Rep. 70.

88—Dwight v. Hamilton, 113 Mass. 175.

89—Allan on Goodwill, p. 32.

the purchaser of its benefits and advantages. It is clear that he has no right to hold himself out as continuing the business which he sold to the plaintiff, or as carrying on his former business at another place to which he has removed.[90] In other words, in every case of the sale of a goodwill the vendor must not enter into an unfair competition with his purchaser.[91] What will constitute such unfair competition must be determined in the light of all the facts in each particular case.

The Massachusetts court has gone far in holding the vendor liable to his vendee, in the absence of an agreement not to engage in competing business, wherever his conduct is found to be unfair, as directly tending to destroy the value of the goodwill conveyed by him. In the language of that court, "in each case where the goodwill of a business is sold and the vendor sets up a competing business it is a question of fact whether, having regard to the character of the business sold and that set up, the new business does or does not derogate from the grant made by that sale."[92] In this regard, it would seem clear that equity should, even in the absence of breach of contract, hold the vendor to a high degree of care in the installation and conduct of a business closely competitive with that which he has sold.

As to what length he may go in soliciting his former customers, some courts[93] grant him a much greater latitude than others.[94]

90—Hoxie v. Chaney, 143 Mass. 592-597; 10 N. E. Rep. 713; Hall's Appeal, 60 Pa. 458; 100 Am. Dec. 584; Knoedler v. Glaenzer, 5 C. C. A. 305; 55 Fed. Rep. 895.

91—S. F. Myers Co. v. Tuttle, 188 Fed. Rep. 532.

92—Loring, J., in Old Corner Book Store v. Upham, 194 Mass. 101, 105; 80 N. E. Rep. 228. For other illustrative Massachusetts cases, see Gordon v. Knott, 199 Mass. 173; Marshall Engine Co. v. New Marshall Engine Co., 203 Mass. 410, 422; Fairfield v. Lowry, 207 Mass. 352; Bachelder & Co. v. Bachelder, 220 Mass. 173.

93—Cottrell v. Babcock Printing Press Co., 54 Conn. 122; Williams v. Farrand, 88 Mich. 473; Fish Bros. Wagon Co. v. LaBelle Wagon Works, 82 Wis. 546.

94—Snyder Pasteurized Milk Co. v. Burton, 82 N. J. Eq. 185; Von Bremen v. MacMonnies, 200 N. Y. 41; Ranft v. Reimers, 200 Ill. 386; Wentzel v. Barbin, 189 Pa. 502; Brown v. Benzinger, 118 Md. 29; Zanturjian v. Boornazian, 25 R. I. 151. "As the continued patronage of the customers of such a business is what makes the goodwill of

§ 100. Right of vendee to re-assign.—While, as a general rule, the vendee is clothed with all of the rights of his vendor as to the subject-matter conveyed, an exception has been insisted upon in the case of the assignment of the right to use the vendor's name, in which event the right of the vendee to assign that right to a third party is denied. "Where the contract is for the sale of the right to use a fictitious name or a tradename or a trademark, or a corporate name though composed of individual names, or where the good will of a business includes the right to use names of that character, then such right is assignable by the purchaser and follows the business. But where the contract merely gives to one person the right to use the name of another, such right is personal, and in the absence of an express stipulation can not be assigned or transferred by the purchase to a third party."[95]

§ 101. Covenants not to re-engage in business.—As we have seen, the mere sale of a goodwill does not carry with it by implication a covenant that the vendor will not re-engage in the same business. Consequently, such covenants must be expressed in terms, and the construction of such covenants is a matter of law. While, as we have seen, the goodwill itself will be passed by the conveyance of the business, without special mention, the agreement of the vendor not to re-engage in the same business should be as explicit, both as to time and as to the territory, as the circumstances of the case will permit. A frequent defense to an action, based upon covenants not to re-engage in business, is that the contract is void at common law as being an unreasonable restraint of competition in trade. The general rule of the common

value, and as it is utterly repugnant to the contract by which it was assigned that the vendor should be allowed to seek to regain it by soliciting the customers to come back to him, and as the damages thus inflicted is irreparable and is difficult, if not impossible, in such a business as this to compute, I think a court of equity should not hesitate to grant a remedy by injunction." Morris, J., in Acker, Merrall & Condit Co. v. McGaw, 144 Fed. Rep. 864.

95—Bagby & Rivers Co. v. Rivers, 87 Md. 400; 40 Atl. Rep. 171; 40 L. R. A. 632; followed in Marcus v. McFarland, 119 Md. 269; 86 Atl. Rep. 337.

law is stated by Mr. Bishop to be as follows: "An agreement, without limitation, not to carry on a particular trade, which is lawful and beneficial to the community and to the individual, is void as against public policy."[96]

A covenant not to re-engage in business will not be implied from the vendor's covenant in the bill of sale "to warrant and defend the sale of the said property and interest, as herein stated."[97]

A verbal agreement not to engage in a rival business does not come within the statute of frauds. It may be valid when made as collateral to and distinct from a lease of premises, provided the parol agreement is made in consideration of the execution of the written lease.[98] But in an action at law upon a contract of sale, such collateral parol agreement can not be shown or recovered on.[99]

A contract not to re-engage in business must, like any other contract, be founded on a sufficient consideration or it will not be enforced.[1] And the plaintiff in an action upon such a contract must not be guilty of any breach on his part, or he will be denied relief in equity.[2]

A covenant not to re-engage in business may not specify the territory in which the vendor is precluded from doing business. If from all the circumstances of the case it appears that it was the intention of the parties to limit the territory to a town, county or state, the contract will be so construed,

96—Bishop on Contracts, § 515.

97—Costello v. Eddy, 12 N. Y. Supp. 236. Agreements upon dissolution are construed by the same rules as other contracts, with a view of ascertaining the actual intent in the minds of the parties. Thus in a covenant which read "the said Rivers covenants that he will not engage in the manufacture of furniture so long as said Bagby continue such business," it was held that Bagby's conveyance of the business to a corporation was a discontinuance of the business by him, and Rivers was entitled to resume the furniture business if he saw fit. Bagby & Rivers Co. v. Rivers, 87 Md. 400; 40 L. R. A. 632.

98—Welz v. Rhodius, 87 Ind. 1; Spier v. Lambdin, 45 Ga. 319.

99—Costello v. Eddy, 12 N. Y. Supp. 236; Herbert v. Dupaty, 42 La. Ann. 343.

1—Onondaga Co. Milk Association v. Wall, 17 Hun, 494.

2—Cassidy v. Metcalf, 1 Mo. App. 593-601; s. c. 66 Mo. 519; Hollis v. Shaffer, 38 Kas. 492; Johnson v. Moss, 45 Cal. 515.

and the vendor will be enjoined from continuing or re-entering business in the territory so fixed.[3]

The courts of late years have relaxed the old rules so that the restrictive covenant may be unlimited as to area. "It can not be said that the early doctrine that contracts in general restraint of trade are void, without regard to circumstances, has been abrogated. But it is manifest that it has been much weakened, and that the foundation upon which it was originally placed has, to a considerable extent at least, by the change of circumstances, been removed."[4]

The subject of contracts in restraint of trade is outside of the scope of this book, but the following extract from an opinion of Mr. Justice Bradley concisely covers the principles which govern the construction of all covenants of the kind under consideration: "There are two principal grounds on which the doctrine is founded, that a contract in restraint of trade is void as against public policy. One is, the injury to the public by being deprived of the restricted party's industry; the other is, the injury to the party himself by being precluded from pursuing his occupation and thus being prevented from supporting himself and his family. It is evident both these evils occur when the contract is general, not to pursue one's trade at all, or not to pursue it in the entire realm or country. The country suffers the loss in both cases; and the party is deprived of his occupation, or is obliged to expatriate himself in order to follow it. A contract that is open to such grave objection is clearly against public policy. But if neither of these evils ensue, and if the contract is founded on a valid consideration and a reasonable ground of benefit to the other party, it is free from objection and may be enforced.

"In accordance with these principles it is well settled that a stipulation by a vendee of any trade, business or establishment, that the vendor shall not exercise the same trade or business, or erect a similar establishment within a reason-

3—Hubbard v. Miller, 27 Mich. 15.

4—Andrews, J., in Diamond Match Co. v. Roeber, 106 N. Y. 473-484. The cases are reviewed at length in this opinion, and also in Hall Mfg. Co. v. Western Steel & Iron Works, 227 Fed. Rep. 588, 592 (C. C. A. 7).

able distance, so as not to interfere with the value of the trade, business or thing purchased, is reasonable and valid. In like manner a stipulation by the vendor of an article to be used in a business or trade, in which he is himself engaged, that it shall not be used within a reasonable region or distance, so as not to interfere with his said business or trade, is also valid and binding. The point of difficulty in these cases is to determine what is a reasonable distance within which the prohibitory stipulation may lawfully have effect. And it is obvious, at first glance, that this must depend upon the circumstances of the particular case; although, from the uncertain character of the subject, much latitude must be allowed to the judgment and discretion of the parties. It is clear that a stipulation that another shall not pursue his trade or employment at such a distance from the business of the person to be protected, as that it could not possibly affect or injure him, would be unreasonable and absurd. On the other hand, a stipulation is unobjectionable and binding which imposes the restraint to only such an extent of territory as may be necessary for the protection of the party making the stipulation, provided it does not violate the two indispensable conditions, that the other party be not prevented from pursuing his calling, and that the country be not deprived of the benefit of his exertions."[5]

The covenant not to re-engage in business may be entered into by the stockholders of the corporation, whose capital stock and goodwill is being conveyed to a purchaser. The sale of the stock alone does not carry with it by implication a covenant not to re-engage; indeed, the California court has held in a case where the covenant not to re-engage was supported only by the sale of stock in a corporation, that as the sale of the stock could not carry with it the goodwill of the corporation, the element of goodwill did not enter into the transaction, and the covenant was void as being in restraint of trade.[6]

The following agreement of stockholders made collaterally with the sale of the business and goodwill of their corpora-

5—Oregon Steam Nav. Co. v. Winsor, 20 Wall. 64-72; 22 L. Ed. 315.

6—Merchants' Ad-Sign Co. v. Sterling, 124 Cal. 429.

tion contains a typical covenant of the kind under consideration: "This instrument witnesseth, that William Vernon Booth has purchased the plant, business and goodwill of the business of the Davis Fresh & Salt Fish Co., and has paid therefor the sum of $17,473.14; that in making said transfer, and as an inducement to said William Vernon Booth to purchase said plant, business and goodwill and pay the sum aforesaid for the same, we each have agreed that we would not, and we now do agree, each for himself, jointly and severally with him, the said William Vernon Booth, his heirs and assigns, forever, that we will not during the next ten years, in the territory or the immediate vicinity of the territory dealt in by our company, engage or in any manner be interested in, either directly or indirectly, for ourselves or for others, the same or like kind or character of business as that heretofore conducted and now being carried on by said company, its officers, agents, employes and assigns, and that we will not, during the said period of ten (10) years, either directly or indirectly, be guilty of any act interfering with the business, its goodwill, its trade or its customers, or come in competition with the same; and we will not, jointly or severally either in firms or corporations, or as individuals or in any other way, directly or indirectly interfere with the said trade or business, or do any act prejudicial to the same or any part thereof, or interfere with the persons employed therein; the meaning hereof being that the said William Vernon Booth is buying and paying for the goodwill of the business in the largest and fullest scope of the term; and that we will not, and each agrees that he will not, do anything to interfere with or injure the said business, but will during said period, lend his aid and best influence to the promotion and advancement of the same."

It was urged in defense of a bill filed by the purchaser to restrain the shareholders from the violation of this agreement, that it was void because in violation of the Anti-Trust Act of July 21, 1890. This defense did not prevail because the contract did not have, upon its face, a direct relation to interstate commerce. It was further urged that the covenant was void at common law because it was an unreason-

able restraint of competition in trade. This defense also failed, inasmuch as the covenant was merely ancillary to the conveyance of the goodwill of the corporation. The general rule was announced by the court "that such stipulation is valid if it goes no farther than to support and protect the interests transferred by the contract of sale." [7]

§ 102. The valuation of goodwill.—It is manifestly a matter of great difficulty to secure an accurate valuation of goodwill. Like a trademark it has no value except as an integral portion of the business with which it is connected, and of which it is a part. We have considered some of the things that enter into goodwill, and it is obvious that its value is a thing entirely independent of the cash value of the physical assets of the business of which it is a part. In fact, goodwill is frequently sold at a valuation far in excess of the total value of all of the physical properties of the business. On the other hand, the value of a goodwill is liable to sudden and violent fluctuation as is the value of a trademark.

A single shipment of inferior goods may render the trademark under which they are packed, a thing of no value, and personal goodwill depends for its value upon the continued activity and integrity of the person or persons to whom it belongs.

Concerning the valuation of the goodwill of a partnership, the Massachusetts court has said: "While no rule can be laid down by which the goodwill of a trading partnership in all cases can be ascertained and its value fixed with mathematical precision and accuracy, yet if it be assumed that a firm has been in existence for a time long enough to establish a business sufficiently permanent in character to include not only its customers, but the incidents of locality, and a distinctive name, these advantages constitute a going business enterprise; and it may then be said that the name and what is done under it go together, and a goodwill exists which forms an asset of commercial value in a winding up between partners. The fact that such an asset may be difficult of appraisement is

7—Severens, J., in Davis v. A. Booth & Co., 65 C. C. A. 269; 131 Fed. Rep. 31, 38.

no legal reason for denying to the retiring partner an appraisal, if it be proved that he is entitled to it."[8]

An English text writer says: "The usual basis of valuation is the average net profits made during the few years preceding the sale,"[9] and in accordance with this rule, an English court has assessed the value of the goodwill of a banking business at one year's average net profits.[10]

The value of the goodwill of a professional practice has been based upon two years' net profits.[11]

It is evident that all the facts relating to the character of the goodwill, the probability of the continuance of its value, and any other matters which render its duration a matter of doubt or uncertainty, must be considered in an attempt to place a value upon it. Thus, where the goodwill was being conveyed in administration, the fact that the brother of the testator had been interested in the business, and could not be prevented from carrying it on in competition with a purchaser, rendered the goodwill valueless as a subject of sale by the executor.[12] In estimating the value of the interest of a deceased partner in the goodwill of the business, the rights of the surviving partner must be taken into account.[13]

§ 103. Competition between vendor and vendee.—The vendor is at liberty to lease or sell other property he may own in the neighborhood, to another person who may carry on the same business, provided there is no collusion, and the lessor has no interest in the business.[14]

In the absence of a covenant or statute to the contrary, the vendor may employ any fair method of soliciting trade which does not involve a false or fraudulent representation.[15]

8—Moore v. Rawson, 185 Mass. 264; 70 N. E. Rep. 64, citing McMurtrie v. Guiler, 183 Mass. 451, 454; 67 N. E. Rep. 358.

9—Allan on Goodwill, p. 82.

10—Mellersh v. Keen, 28 Beav. 453.

11—Featherstonhaugh v. Turner, 25 Beav. 382.

12—Davies v. Hodgson, 25 Beav. 177.

13—Smith v. Everett, 27 Beav. 446.

14—Bradford v. Peckham, 9 R. I. 250-253; Herbert v. Dupaty, 42 La. Ann. 343.

15—Holbrook v. Nesbitt, 163 Mass. 120; 39 N. E. Rep. 794; Cottrell v. Babcock, 54 Conn. 138; Vonderbank v. Schmitt, 44 La. Ann. 264; Marcus Ward & Co. v. Ward, 40 N. Y. State Rep. 792; Knoedler

But the English rule and that in Rhode Island is that he can not directly solicit from former customers.[16] No form of soliciting trade will be permitted however, which tends directly to deprive the vendee of the benefit of the reputation of the business purchased by him, to take away from him the patronage which appertained to it, or to draw away the business of its habitual customers.[17]

The goodwill of the business of a decedent does not carry with it the right to use the decedent's name.[18] Such goodwill is an asset to be accounted for by the personal representative, and if that representative takes charge of the business and conducts it as his own he is chargeable with the value of the goodwill.[19]

Equity looks with disfavor upon any method of diverting from the purchaser of a goodwill the benefits which ought to come to him by reason of his purchase. Thus, where partners sold out their interest in the goodwill of a partnership known as the Kalamazoo Wagon Company, and then organized a corporation under the name of Kalamazoo Buggy Company, they were enjoined, at the suit of their vendee, from the use of that name; and the court held that the writ of injunction properly ran against all persons connected with the corporation.[20]

A statute of California provides that, "One who sells the goodwill of a business thereby warrants that he will not endeavor to draw off any of the customers."[21]

In a federal case one Thomson was a partner of his brother, in Europe, and a partner of other persons in a separate

v. Boussod, 47 Fed. Rep. 465; Close v. Flesner, 59 N. Y. State Rep. 283; Knoedler v. Glaenzer, 55 Fed. Rep. 895; 5 C. C. A. 305. See *ante*, § 99.

16—Trego v. Hunt, 65 L. J. Ch. 1; L. R. (1896) A. C. 7; 12 Eng. Ruling Cases, 442; Labouchere v. Dawson, L. R. 13 Eq. 322; Zanturjian v. Boornazian, 25 R. I. 151; 55 Atl. Rep. 199.

17—Munsay v. Butterfield, 133 Mass. 492-495, citing Angier v. Webber, 14 Allen, 211.

18—Morgan v. Schuyler, 79 N. Y. 490; *In re* Randall's Estate, 8 N. Y. Supp. 652-654.

19—*In re* Randall's Estate, 8 N. Y. Supp. 652.

20—Myers v. Kalamazoo Buggy Co., 54 Mich. 215; Brass & Iron Works Co. v. Payne, 50 Ohio St. 115; 19 L. R. A. 82.

21—Cal. Civ. Code, § 1776; Snow v. Holmes, 71 Cal. 142.

establishment in New York. Both houses were dealing in "Thomson's Glove-fitting" corsets. Thomson sold out his interest in the New York house and afterward attempted to sell the corsets made by him in Europe, in the United States. He was enjoined from so doing, the court holding that, when he assigned his interest in the goodwill of the New York partnership, the goodwill carried with it all his right to use the trademark "Thomson's Glove-fitting" in the United States.[22]

In a sale of a physician's practice, where the vendor, after three months, returned to the same city and opened an office fifteen rods away from, in the nearest house but one to, his former office, the Supreme Court of Massachusetts held his conduct to be a breach of the implied covenant "that the vendor will not himself do anything to disturb or injure the vendee in the enjoyment of that which he has purchased."[23]

When an article of manufacture has had the manufacturer's name applied to it, and he sells his business and goodwill and "confers the authority to use his name," so applied, to his vendee, he will be enjoined from again engaging in a similar business under his own name.[24]

A covenant by the vendor not to re-engage in business may not specify the territory in which he is precluded from doing business. If from all the circumstances of the case it appears that it was the intention of the parties to limit that territory to a town, county or state, the contract will be so construed, and the vendor will be enjoined from continuing

22—Batchellor v. Thomson, 86 Fed. Rep. 630.

23—Endicott, J., in Dwight v. Hamilton, 113 Mass. 175-177. Where the vendor re-engaged in the same (a mercantile) business in the same vicinity, a bill in equity brought by him to reform the contract of sale was dismissed on the ground that he had not done equity. Cassidy v. Metcalf, 1 Mo. App. 593-601. This decision was reversed by the Supreme Court of Missouri, but that court agreed with the St. Louis Court of Appeals in holding that "the plaintiff's conduct was not characterized by that good faith with which a party should always approach a court of equity when asking its assistance." Cassidy v. Metcalf, 65 Mo. 519.

24—Frazer v. Frazer Lubricator Co., 121 Ill. 147; 13 N. E. Rep. 639; Ayer v. Hall, 3 Brewst. 509; Filkins v. Blackman, Fed. Case No. 4,786, 13 Blatch. 440; Probasco v. Bouyon, 1 Mo. App. 241.

or re-entering business in the territory so fixed.[25] A single act or sale in the line of the business sold is not a breach of a covenant not to re-engage in a particular "business," as business is carried on by an aggregation of acts.[26]

A vendor of a goodwill may not do indirectly what he is forbidden, by the terms of his contract, from doing directly. So if he forms a corporation to carry on his business, and the other incorporators have knowledge of his contract, the corporation will be enjoined from conducting business with or for the vendor.[27] And he is not at liberty to take stock in or to help to organize or manage a corporation formed to compete with his vendee,[28] nor may he deliver goods within the prohibited territory, although maintaining his store and making the sales without that territory.[29]

If he re-engages in business under the pretense of acting as a broker or commission agent only, the same rule applies and he will be enjoined.[30] And again, the rule applies where the defendant re-engages in the prohibited business as the salaried employe of a third person, and he will be enjoined.[31] In a case where the vendor covenanted to make the goodwill as valuable as he could, Lord Eldon held that the vendee was not bound to take the actual profit made, but that he would "have an action of covenant, if he can establish his title to more through the default of the vendor."[32]

Where a limit of time is fixed in the covenant against re-engaging in business, the vendor may re-engage in the busi-

25—Hubbard v. Miller, 27 Mich. 15.

26—Parkhurst v. Brock, Vt., 47 Atl. Rep. 1068; citing Hoagland v. Segur, 38 N. J. Law, 237; Turner v. Evans, 2 El. & El. 512; *In re* Horton, 45 Law T. (N.S.) 541.

27—Beal v. Chase, 31 Mich. 490.

28—Kramer v. Old, 119 No. Car. 1; 56 Am. St. Rep. 650.

29—Love v. Stidham, 18 App. D. C. 306.

30—Richardson v. Peacock, 33 N. J. Eq. 597.

31—Finger v. Hahn, 42 N. J. Eq. 606; Emery v. Bradley, 88 Me. 357; 34 Atl. Rep. 167; Meyer v. Labau, 51 La. Ann. 1726; Boutelle v. Smith, 116 Mass. 111; Jefferson v. Markert, 112 Ga. 498; 37 S. E. Rep. 758. Opposed to these cases see Battershell v. Bauer, 91 Ill. App. 181.

32—Scott v. Mackintosh, 1 V. & B. 503. As a matter of course such a covenant will not be created by implication. Where the vendor conveyed the goodwill of a school, it was held that the sale did not bind him by implication to exert his efforts thereafter to secure the attendance of pupils. McCord v. Williams, 96 Pa. St. 78.

ness upon the expiration of the time. But where the covenant was made jointly with a conveyance of the vendor's goodwill, he was restrained after he re-engaged in business from making personal solicitation of his former customers and using extracts from their books in relation to the business.[33]

The sale of a business and its goodwill do not, in the absence of an express agreement, entitle the purchaser to use the vendor's name, even where he covenants not to re-engage in the business for a term of years.[34]

§ 104. Partnership goodwill.—Disputes as to goodwill arise most frequently between partners. The various text-writers who have treated the law of partnership have dwelt at length upon the principles of the law of goodwill which are applicable in this connection, so that for the purpose of this book a brief glance at the leading principles will suffice.

As we have seen elsewhere, every man has the right to use his own name in business, so long as he does not use it in such a way as to establish an unfair competition.

The use of the name of a withdrawing partner, as part of the firm name, in such a way as to expose him to liability or to the possibility of being sued, will be enjoined at his suit.[35] The better rule would seem to be that in the absence of express agreement the firm name will not pass to one who purchases the assets of a partnership.[36]

33—Armstrong v. Bitner, 71 Md. 118-127.

34—Scheer v. American Ice Co., 66 N. Y. Supp. 3.

35—McGowan v. McGowan, 22 Ohio St. 370; Peterson v. Humphrey, 4 Abb. Pr. 394.

36—Williams v. Farrand, 88 Mich. 473; 50 N. W. Rep. 446; Horton Mfg. Co. v. Horton Mfg. Co., 18 Fed. Rep. 816. This rule is not yet clearly established. Thus the Supreme Court of Ohio says: "Upon the dissolution of a trading co-partnership its assets, including the goodwill of the business, may be sold as a whole, either by the partners directly, or through a receiver under an order made by a court in a case to which they are parties; and that a purchaser thereof, under either method of sale, is entitled to continue the business as the successor of the firm, and make use of the firm name for that purpose. And further, that when the purchaser transfers the property so acquired by him to a corporation of which he is a member, organized to succeed to the business, it may

When one partner has been expelled from the partnership because of his violation of its articles, he will not, in the absence of contract binding him not to re-engage in the business, be enjoined from doing similar business in his own name, and soliciting patronage from customers of the old firm.[37] A surviving partner who has the right to use the firm name may enjoin his deceased partner's executor from using the firm name for his own benefit.[38]

Upon the appointment of a receiver for the firm assets, either member of the firm will be enjoined from so using his own name as to mislead the public into the belief that he has acquired the goodwill, since such injunction is necessary to the preservation of the goodwill as part of the firm assets.[39]

A retiring partner who has sold the other the firm property, without making mention of the goodwill, will be granted an injunction against any use of the firm name by the continuing partner which would give the public reason to believe he was still a member of the firm, to the injury of his new business.[40]

Upon the dissolution of a partnership the partner who retains the use of the old premises may lawfully advertise the premises as being "formerly occupied by" the old firm, and either partner may advertise himself as being "formerly of" or "late of" the firm, using words that convey only the facts and have no tendency to deceive or mislead the firm's customers or the public generally.[41]

carry on the business in the same manner under a corporate name, including the name which has been used by the firm." Williams, J., in Snyder Mfg. Co. v. Snyder, 54 Ohio St. 86-96; 43 N. E. Rep. 325, citing Brass & Iron Works v. Payne, 50 Ohio St. 115.

37—Dawson v. Beeson, L. R. 24 Ch. D. 504.

38—Lewis v. Langdon, 7 Sim. 422.

39—Bininger v. Clark, 60 Barb. 113. Where a retiring partner stipulated that the continuing partner might continue the use of his name in the style of the firm, it has been held that the assignment of the right to use the name is personal and can not be transferred by the continuing partner to another. Horton Mfg. Co. v. Horton Mfg Co., 18 Fed. Rep. 816; Bagby & Rivers Co. v. Rivers, 87 Md. 400; 40 L. R. A. 632.

40—McGowan v. McGowan, 22 Ohio St. 370.

41—Morgan v. Schuyler, 79 N. Y. 490; Holbrook v. Nesbit, 163 Mass. 120; 39 N. E. Rep. 794.

Where the retiring partner permits the old firm name (of which his name is a part) to be used, and makes no publication of the fact of his retirement, he is estopped from denying the copartnership, as against a creditor of the continuing partner, who has extended credit in the belief that he is still a member of the firm.[42]

Upon administration of a partnership estate, the goodwill should be included in the appraisement of the partnership assets, and if the surviving partner appropriates it to his own use by continuing the partnership business, he may be compelled to account for its value to the estate of the deceased partner.[43]

Where a partner came into a partnership for a fixed period, agreeing, "to carry on business with the defendants for one year, and then to leave it in their hands," he was held to have acquired thereby no interest in the goodwill of the business.[44]

Upon the retirement of a partner, if he permits the other partners to retain the old premises and continue the use of the firm name, the goodwill remains with the continuing partners.[45]

A retiring partner who re-engages in business will be enjoined from using the expressions "our firm," "our new store," and like matter holding out his new concern as continuing the business of the old firm.[46]

§ 105. Remedies.—The purchaser of a goodwill whose enjoyment of it is interfered with may have his remedy either at law or in equity. These remedies are administered on the same general principles which apply to other cases

42—Backus v. Taylor, 84 Ind. 503; Richards v. Hunt, 65 Ga. 342.

43—Rammelsberg v. Mitchell, 29 Ohio St. 22.

44—Van Dyke v. Jackson, 1 E. D. Smith (N.Y.), 419; Duden v. Maloy, 63 Fed. Rep. 183; 11 C. C. A. 119. In the latter case the partnership articles provided that the incoming partner's interest should be ascertained annually, and further provided for the sale of his interest to his partner on dissolution at the price ascertained in determining his share. The court held that this disposed of his property in the goodwill.

45—Menendez v. Holt, 128 U. S. 514; 32 L. Ed. 526.

46—Fite v. Dorman (Tenn.), 57 S. W. Rep. 129.

of unfair competition, and which are discussed elsewhere in this book.

The jurisdiction of equity in this class of cases is predicated upon the fact that the injury is continuing, that its further operation can only be restrained by the exercise of the injunctive power of the chancellor, and that damages at law afford no adequate compensation for the injury.

If, however, the plaintiff resorts to an action at law, the measure of his damages is well defined by the Supreme Court of Missouri: "If plaintiffs lost less than the defendant made, they can not recover the whole of defendant's profits; if plaintiffs lost more than the defendant made, they would not be limited to defendant's profits. What the plaintiffs have lost by the defendant's breach of covenant, and not what the defendant has gained thereby, is the legal measure of damages in this case." [47]

The parties to a contract for the sale of a goodwill may provide in the contract for a fixed amount of damages. In the absence of fraud, the sum so fixed will be adopted as the measure of damages by the court.[48]

Where the parties have so agreed upon the amount of damages, the vendee, in case of a breach of covenant, has an adequate remedy at law, and injunction will not lie.[49]

47—Hough, J., in Peltz v. Eichele, 62 Mo. 171-180. And to the same effect see Burckhardt v. Burckhardt, 36 Ohio St. 261.

48—Tode v. Gross, 127 N. Y. 480-487; 13 L. R. A. 652; 28 N. E. Rep. 469; 40 N. Y. S. R. 300; Dakin v. Williams, 17 Wendell, 447; Bagley v. Peddie, 16 N. Y. 469; Wooster v. Kisch, 26 Hun, 61.

49—Martin v. Murphy, 129 Ind. 464-467. Unless the defendant is insolvent, which fact will make a case for injunctive relief. Pickett v. Green, 126 Ind. 584.

The general doctrine that equity will not interfere to restrain a person from doing an act which he has agreed not to do, when liquidated damages has been provided in case he does the act, is subject to this qualification: "The question in every case is, what is the real meaning of the contract? And if the substance of the agreement is that the party shall not do a particular act, and that is the evident object and purpose of the agreement, and it is provided that, if there is a breach of this agreement, the party shall pay a stated sum, which does not clearly appear to be an alternative which he has the right to adopt instead of performing his contract, there would seem to be no reason why a court of equity should not restrain him from doing the act, and thus carry out

The remedy is for the recovery of the sum so fixed.[50]

§ 106. Breach of covenant not to re-engage.—It is no defense to such an action that there was no separate consideration for the covenant, if it was a part of a transaction involving the sale of a stock of merchandise, without mention of goodwill.[51] The sale of the stock of merchandise is of itself a good consideration for the covenant not to re-engage.[52] This rule is based upon the right of the vendor to have "the freest opportunity to obtain the largest consideration for the sale of that which is his own."[53] A valuable consideration must exist to support the covenant, but where such a consideration is shown, the question of the adequacy of that consideration is foreclosed, because of the peculiar nature of the subject-matter of the contract.[54]

the intention of the parties. * * * In other words, naming a sum to be paid as liquidated damages does not in itself conclusively establish that the parties contemplated the right to do the act upon payment of the compensation, and make an alternative agreement for the benefit of the party who has done what he had agreed not to do." Endicott, J., in Ropes v. Upton, 125 Mass. 258-261. It has been held in Canada that in event of a breach of such a contract the vendee has his election to enjoin the vendor or recover the amount named as liquidated damages. Snider v. McKelvey, 27 Ont. App. 339.

50—Martin v. Murphy, 129 Ind. 464.

51—Boggs v. Friend (W. Va.), 87 S. E. Rep. 873.

52—Fleischman v. Rahmstorf, 226 Fed. Rep. 443 (C. C. A. 9); Nelson v. Brassington, 64 Wash. 180; 116 Pac. Rep. 629; Beard v. Dennis, 6 Ind. 200; 63 Am. Dec. 380.

53—Mr. Justice Peckham in United States v. Freight Assn., 166 U. S. 290, 329; 41 L. Ed. 1007, quoted and followed in Fleischman v. Rahmstorf, *supra*.

54—"It is contended in behalf of defendant that the covenant to refrain from practice is not supported by an adequate consideration. All authorities appear to agree that a valuable consideration must be established to support a covenant of this nature, even though the covenant be under seal; but the weight of authority is clearly to the effect that if a valuable consideration is found to exist, the adequacy of that consideration will not be inquired into. The authorities to that effect are collected by Mr. Freeman in his note to Angier v. Webber, 92 Am. Dec. at page 754. The adjudicated cases involving covenants of this nature have almost uniformly arisen in connection with the sale of a business, and it has been found impracticable to inquire as to the extent to which the purchase price entered into the covenant of the vendor not to engage in an opposition business. In the present case no sale occurred. The evidence discloses

The act of a vendor in accepting employment as a clerk, agent or manager for a rival of his vendee is a breach of his covenant not to re-engage in the trade.[55]

In actions for the breach of such covenants, a provision in the contract of sale for liquidated damages will be enforced according to its terms, unless the amount so stipulated to be paid as damages is so unjust, oppressive or disproportionate to the actual damages sustained as to be abhorrent to a court of equity.[56]

The reason for this rule is that this is "a class of cases where it is next to impossible to prove the full extent of the damages."[57]

In the absence of such a stipulation, the valuation of the goodwill will be determined on a basis of the average profits, less interest on the capital invested.[58]

that when the partnership agreement here in question was made defendant was already a partner of complainant. The present agreement continued their partnership relation under new terms and also admitted to the partnership an additional partner. So far as the evidence discloses, it is indeed difficult to discern wherein the new partnership agreement can be said to have been beneficial to defendant; but, considered as an engagement involving the partnership relation of the three partners for a future period of time, it is, I think, impossible to here determine that the benefits and disadvantages flowing from its mutual covenants were inadequate to support the engagement of defendant to refrain from practice at the place and during the time specified at the termination of the partnership." Leaming, V. C., in Marvel v. Jonah, 81 N. J. Eq. 369; 86 Atl. Rep. 968.

55—Fleischman v. Rahmstorf, *supra*; Smith v. Webb, 176 Ala. 596; 58 So. Rep. 913; 40 L. R. A. (N.S.) 1191; Knowles v. Jones, 182 Ala. 187; 62 So. Rep. 514; Meyers v. Merillion, 118 Cal. 352; 50 Pac. Rep. 662; McAuliffe v. Vaughan, 135 Ga. 852; 70 S. E. Rep. 322; 33 L. R. A. (N.S.) 255; Wilson v. Delaney, 137 Ia. 636; 113 N. W. Rep. 842; Finger v. Hahn, 42 N. J. Eq. 606; 8 Atl. Rep. 654; Kramer v. Old, 119 N. C. 1; 25 S. E. Rep. 813; 34 L. R. A. 389; Gropp v. Perkins, 148 Ky. 183; 146 S. W. Rep. 389.

56—Fleischman v. Rahmstorf, *supra*.

57—*Per Curiam*, Kelso v. Reid, 145 Pa. 606; 23 Atl. Rep. 323; 27 Am. St. Rep. 716. To the same effect are McCurry v. Gibson, 108 Ala. 451; 18 So. Rep. 806; Streeter v. Rush, 25 Cal. 67; Potter v. Ahrens, 110 Cal. 681; 43 Pac. Rep. 388; Newman v. Wolfson, 69 Ga. 764; Holbrook v. Tobey, 66 Me. 410; Cushing v. Drew, 97 Mass. 445; Geiger v. Cawley, 146 Mich. 550; 109 N. W. Rep. 1064; Cannady v. Knox, 43 Wash. 567; 86 Pac. Rep. 930; Martin v. Murphy, 129 Ind. 464; 28 N. E. Rep. 1118.

58—Seaich v. Mason-Seaman Transp. Co., 156 N. Y. S. 579. As to

In a suit upon a note given in payment for a business with its real and personal property and goodwill the defendant will not be permitted to offer testimony as to the value of the separate items of personalty and realty;[59] this for the reason that "the vendor who sells the goodwill of a business guarantees nothing; for, in the nature of things, he can give no assurance that the patronage of the place will continue."[60] Of course fraudulent representation as to earning capacity of the goodwill may be shown in defense of such a suit.[61]

In a suit for damages for breach of the covenant not to re-engage, it is a defense that the plaintiff failed to pay the purchase price in full, but the defense can not be set up without a showing that, before re-engaging, the vendor put the plaintiff in default by tendering back that part of the purchase money he had received.[62]

Where there are no damages stipulated, and no substantial injury is proven, the plaintiff is entitled only to nominal damages.[63] "The loss of profits, if there are data from which the amount may be ascertained with reasonable certainty, the diminution in value of the property sold, all may be regarded as elements of the damages which go to make up the measure of recovery."[64]

Where the defendant has re-engaged in business in violation of a covenant against his so doing, the case is one where "the law will not nicely attempt to limit the amount of reparation, but will extend the line of relief so as to embrace all the consequences of the wrongdoer's act, although quite re-

the method of valuation of goodwill of a corporation for the purpose of assessing a transfer tax, see *In re* McMullen's Estate, 157 N. Y. S. 655. That a year of abnormal profits should be disregarded, see *In re* Welch, 137 N. Y. S. 941.

59—Harschbarger v. Eby (Idaho), 156 Pac. Rep. 619.

60—Johnson v. Friedhoff, 27 N. Y. Supp. 982.

61—Butler v. Alter, 139 N. Y. S. 882.

62—Moorman & Givens v. Parkerson, 131 La. 204; 50 So. Rep. 122.

63—Taylor v. Howard, 110 Ala. 468; 18 So. Rep. 311; Breeding v. Tandy, 148 Ky. 345; 146 S. W. Rep. 742.

64—Howard v. Taylor, 90 Ala. 241-244; and to the same effect see Burckhardt v. Burckhardt, 42 Ohio St. 474; Mitchell v. Read, 84 N. Y. 556; Mellersch v. Keen, 28 Beavan, 453; Rawson v. Pratt, 91 Ind. 9; Lashus v. Chamberlain, 6 Utah, 385; Gregory v. Spicker, 110 Cal. 150; 42 Pac. Rep. 576.

mote from the original transaction."[65] The measure of the vendee's damages will be the amount of profits lost during the term by reason of defendant's unlawful competition, and if, in addition, the goodwill of the business at the end of the term is worth less than it would have been but for defendant's unlawful act, the vendee is entitled to recover that amount.[66] The vendee can not recover the profits realized by the vendor through his breach of the contract.[67]

For the greater part the remedies open to the owner of a goodwill whose rights are invaded are administered by courts of equity. But injury to a goodwill may be effected in many various ways, for each of which an appropriate remedy will be found either at law or in equity. Thus where a defendant's goodwill has been destroyed by a wrongful attachment, he will be allowed compensation therefor in an action for damages against the attaching creditor.[68]

In an action at law a petition which alleges that plaintiff has purchased defendant's business and goodwill, and that the defendant agreed not to re-engage in the same line of business for two years, and that in violation of his agreement, he has re-engaged in the same line of business during such period, and thereby damaged plaintiff, has been held good on demurrer.[69]

The action for damages for breach of contract involving goodwill is governed by the general principles involved in similar actions in trademark cases, which are considered elsewhere in this book.

A contract for the sale of a business and goodwill will be rescinded if the vendor has falsely stated facts in regard to the value of the goodwill; as where he has represented that his receipts or profits from the business were greater than they actually had been,[70] or that the premises sold have

65—Dow v. Electric Co., 69 N. H. 312; 41 Atl. Rep. 288; 42 L. R. A. 569.

66—Salinger v. Salinger, 69 N. H. 589; 45 Atl. Rep. 558; Buckhardt v. Buckhardt, 36 Ohio St. 261; Verges v. Forshee, 9 La. Ann. 294; Stewart v. Challacombe, 11 Ill. App. 379; Moorehead v. Hyde, 38 Iowa, 382.

67—Gregory v. Spieker, 110 Cal. 150; 42 Pac. Rep. 576.

68—Miller v. Beck (Iowa), 72 N. W. Rep. 553.

69—Erwin v. Hayden (Texas), 43 S. W. Rep. 610.

70—Dobell v. Stevens, 3 B. & C. 623; Cruess v. Fessler, 39 Cal. 336.

brought a higher rental than they actually did.[71] And the misrepresentation has been held to rescind the contract where the misstatement was not made directly to the vendee, but to a third party who communicated it, with the vendor's knowledge, to the vendee.[72] On the other hand, the duty is imposed upon the vendee to act at once upon learning the facts which justify a rescission. Where he fails to do so he will be bound by his contract, and his remedy lies in an action for damages,[73] as he may recover damages without rescinding the contract.[74]

Whenever the false representations amount to a warranty, an action for damages will lie even in the absence of proof of fraud. Otherwise the burden is upon the vendee to show that the representation was fraudulently made.[75]

The measure of damages in such case is the difference between the actual value of its property at the time of the purchase, and its value if the property had been what it was represented or warranted to be.[76]

Covenants against re-engaging in business may be specifically enforced, as we have seen, or the vendor may be enjoined from their violation. It has been held in England that with an action for specific performance a claim for damages may be made as an alternative.[77]

It has been held that a debtor's goodwill can not be reached by a creditor's bill, because it is not subject to levy, in satisfaction of their debts.[78]

The application for injunctive relief is governed by the rules concerning similar applications in trademark cases.

A plaintiff need not allege or prove damage as a prerequisite to an injunction to restrain a defendant from re-engaging in business, in breach of a covenant between the parties.[79] When a vendee in applying for an injunction also

71—Lysney v. Selby, 2 Ld. Raym. 1118.

72—Pilmore v. Hood, 5 Bing. N. C. 97.

73—Dobell v. Stevens, 3 B. & C. 623.

74—Snow v. Holmes, 71 Cal. 142-148.

75—Redgrave v. Hurd, L. R. 20 Ch. D. 1.

76—Morse v. Hutchins, 102 Mass. 439; Rawson v. Pratt, 91 Ind. 9.

77—Hipgrave v. Case, L. R. 28 Ch. D. 356.

78—Lilienthal v. Drucklieb, 84 Fed. Rep. 918.

79—Anderson v. Rowland, 18 Tex. Civ. App. 460; 44 S. W. Rep. 911.

asked judgment for the possession of the books and papers used by the vendor in the business in which it had engaged in violation of its covenant the order was refused because there was a remedy at law for their recovery.[80]

In cases where the vendor of a goodwill is sought to be restrained from re-engaging in business in violation of his covenant, the amount in controversy is the value of the goodwill, and the federal courts can not acquire jurisdiction unless the value of the goodwill exceeds $3,000.[81]

A violation of a covenant not to re-engage in business is a defense to a suit by the vendor upon notes given by the vendee for the purchase money.[82]

Where the covenant not to re-engage is incorporated in the bill of sale, the consideration paid has been held to be not only for the stock of goods, but for the agreement not to re-engage.[83]

§ 107. Remedy as to infringement of tradenames identified with goodwill.—Many of the actions for breach of contract in relation to the sale of goodwill have had for their object the restraint of the vendor in the use of the tradename under which the business had been conducted. Where the goodwill and tradename have been sold, the subsequent use of the name by the vendor will be enjoined, even where the vendor has reserved the right to resume business under any other than the old name.[84]

The relief will be granted where there has been a contract to convey the tradename and goodwill, and the consideration has been paid, though the vendor has not made a formal assignment of the goodwill and name.[85]

The relief will be granted where the vendee does not continue the use of the old name, but conducts the business under his own name.[86]

80—Lawrence v. Times Printing Co., 90 Fed. Rep. 24-26.

81—Lawrence v. Times Printing Co., 90 Fed. Rep. 24-26.

82—Townsend v. Hurst, 37 Miss. 679.

83—Eisel v. Hays, 141 Ind. 41; 40 N. E. Rep. 119.

84—Burckhardt v. Burckhardt, 42 Ohio St. 474; 51 Am. Rep. 842.

85—United States Cordage Co. v. Wm. Wall's Sons Rope Co., 35 N. Y. Supp. 978; 90 Hun, 429.

86—Grow v. Seligman, 47 Mich. 607; 41 Am. Rep. 737; 11 N. W. Rep. 404.

CHAPTER VII.

TRADE SECRETS; RIGHT OF PRIVACY.

§ 108. Trade secrets—Introductory.—"A secret in trade is fully recognized as property in equity, the disclosure of which will be restrained by injunction."[1] A contract in reference to such a secret can not be in restraint of trade, "because the public has no rights in the secret."[2]

When the name applied to a secret preparation is a trademark, no one but the owner of the mark can apply it to the preparation. But if it be not a valid trademark, then the manufacture of the secret preparation, and the placing of it upon the market under the same name, is open to any one who can lawfully discover the secret process.[3] But "it

1—Smith, P. J., in Champlin v. Stoddart, 30 Hun, 300-302.

2—Morse Machine Co. v. Morse, 103 Mass. 73-75; Fowle v. Park, 131 U. S. 88; 33 L. Ed. 67; Vickery v. Welsh, 19 Pick. 523-527. "Upon the sale of a secret process, a covenant, express or implied, that the seller will not use the process himself or communicate it to any other person is lawful, because the process must be kept secret to be of any value, and the public has no interest in the question by whom it is used."

Gray, J., in Central Transportation Co. v. Pullman's Palace Car Co., 139 U. S. 24; 35 L. Ed. 69; citing Fowle v. Park, 131 U. S. 88, 97; Vickery v. Welsh, 19 Pick. 523-527; Peabody v. Norfolk, 98 Mass. 452-460.

3—Watkins v. Landon, 52 Minn. 389; 54 N. W. Rep. 193; 19 L. R. A. 236; Davis v. Kendall, 2 R. I. 566; Siegert v. Findlater, L. R. 7 Ch. D. 801; Comstock v. White, 18 How. Pr. 421; Condy v. Mitchell, 37 L. T. N. S. 268; James v. James, L. R. 13 Eq. 421; Canham v. Jones, 2 V. & B. 218; J. R. Watkins Medical Co. v. Sands, 83 Minn. 326; 86 N. W. Rep. 340.

"It may also be observed, in this connection, that the word 'property,' as applied to trade secrets and inventions, has its limitations; for it is undoubtedly true that when an article manufactured by some secret process, which is not the subject of a patent, is thrown upon the market, the whole world is at liberty to discover, if it can by any fair means, what the process is, and, when discovery is thus made, to employ it in the manufacture of similar articles. In such a case, the inventor's or manufacturer's property in his process is gone; but the authorities all hold that, while

is settled that a secret art is a legal subject of property,"[4] and its owner has a vested right to the secrecy of all those who occupy a fiduciary relationship to his business. So that no one who obtains knowledge of the secret by fraud or unfair means will be permitted to avail himself of the fruits of his fraud, by disclosing the secret or manufacturing under it.[5]

The assignability of secret processes has been established in a number of cases.[6]

Where equity will not interfere.—"Courts of equity will not interfere by injunction in disputes between the owners of quack medicines, meaning thereby remedies or specifics whose composition is kept secret, and which are sold to be used by the purchasers without the advice of regular or licensed physicians."[7] And in 1817 Lord Eldon said: "I do not think that the court ought to struggle to protect this sort of secrets in medicine."[8]

Broadly stated, equity will not interfere to prevent the disclosure of secrets by means of which frauds have been committed.[9]

Then there are limits to the extent of the injunction, which will be suggested by the facts in each particular case. For example, in one case which has been frequently cited, the

knowledge obtained in this manner is perfectly legitimate, that which is obtained by any breach of confidence can not be sanctioned." Adams, J., in Eastman Co. v. Reichenbach, 20 N. Y. Supp. 110-116; affirmed, 29 N. Y. Supp. 1143; 79 Hun, 188.

4—Gray, J., in Peabody v. Norfolk, 98 Mass. 452. To the same effect, see Stewart v. Hook, 118 Ga. 415; 45 S. E. Rep. 369; 63 L. R. A. 255; Dobson v. Graham, 49 Fed. Rep. 17.

5—Salomon v. Hertz, 40 N. J. Eq. 400; Little v. Gallus, 38 N. Y. Supp. 48.

6—Simmons Medicine Co. v. Simmons, 81 Fed. Rep. 163; Fowle v. Park, 131 U. S. 88; 33 L. Ed. 67; Thum Co. v. Tloczynski, 114 Mich. 149; 72 N. W. Rep. 140; 38 L. R. A. 200; 68 Am. St. Rep. 469; Tode v. Gross, 127 N. Y. 480, 485; 28 N. E. Rep. 469; 13 L. R. A. 652; 24 Am. St. Rep. 475; Vulcan Detinning Co. v. American Can Co., 67 N. J. Eq. 243; 58 Atl. Rep. 290.

7—Shiras, Circuit Justice, in Kohler Mfg. Co. v. Beeshore (24, 59 Fed. Rep. 572-574; 8 C. C. A. 215.

8—Williams v. Williams, 3 Mer. 157; Seb. 26.

9—Follet v. Jeffreyes, 1 Sim. N. S. 1; Cartside v. Outram, 3 Jur. N. S. 39.

plaintiff was a tanner and manufacturer of leather, owning secret processes relating to the treatment of leather. Two of his former employes were enjoined, on his application, from disclosing any of his secret processes, but, in the absence of any proof of an express agreement of secrecy, the court refused that portion of his prayer for relief which asked that the defendants be enjoined from disclosing "where or from whom the complainant buys his materials, and to whom he sells his goods, or the prices at which he buys or sells;" the chancellor remarking that an agreement in reference to such matters "may well be regarded, in the absence of anything to the contrary in its terms, as limited in its obligation to the time of employment. * * * He (the employe), notwithstanding such agreement, might himself, after leaving the employment, use the knowledge he had obtained. He might sell to the customers of his late employer, and buy of those from whom the latter purchased, and do both in competition with him."[10]

§ 109. Protection in equity.—Equity will always act to protect trade-secrets, and this protection may be either affirmative or negative in character. In its affirmative form, relief is granted by injunction to restrain the unlawful use of such secrets. In its negative form, equity protects parties and witnesses against the compulsory disclosure of trade secrets.[11]

The plaintiff's witness who testifies merely to the uses and effects of a secret process is privileged from answering questions on cross-examination disclosing the ingredients of such secret process.[12]

Accordingly where the defense to an action for trademark infringement is that plaintiff's goods are injurious, the defendant was not permitted to examine him as to the ingredients of which his goods were composed, the court saying, "if these questions must be answered, every manufacturer will be at the mercy of any one who desires to extort from him an

10—Runyon, C., in Salomon v. Hertz, 40 N. J. Eq. 400.

11—Taylor Iron & Steel Co. v. Nichols, 70 N. J. Eq. 541; 65 Atl. Rep. 695; Stokes Bros. Mfg. Co. v. Heller, 56 Fed. Rep. 297; Moxie Nerve-Food Co. v. Beach, 35 Fed. Rep. 465, 466.

12—Moxie Nerve-Food Co. v Beach, 35 Fed. Rep. 465.

account of his process, for an attempt to restrain an infringer would result in the disclosing of all that makes the invention valuable."[13]

It is not material, in a suit to enjoin disclosure of a secret process, whether that process is "a proper subject for a patent or not."[14]

In one of the early cases in which a property right in trade secrets was recognized, the proceeding was one brought to enforce the specific performance of a contract for the sale of the goodwill of a dyer's business, with the exclusive use of a secret mode of dyeing. Vice-Chancellor Leach sustained the contract and directed its specific performance. In the course of his opinion he said: "Although the policy of the law will not permit a general restraint of trade, yet a trader may sell a secret of business and restrain himself generally from using that secret. Let the master, in settling the deed which is to give effect to this agreement, introduce a general covenant to restrain the use of the secret for twenty years, and a covenant, limited in point of locality, as to carrying on the ordinary business of a dyer, both parties being willing that the agreement should be so modified."[15]

As against employes who attempt to profit by secrets of which they have obtained knowledge by reason of their employment, the right to relief in equity has always been recognized. In one of the early cases Lord Cranworth said: "There is no doubt whatever that where a party who has a secret in trade employs persons under contract, express or implied, or under duty, express or implied, those persons can not gain the knowledge of that secret and then set it up against their employer."[16]

13—Tetlow v. Savournin, 15 Phila. 170.

14—Monks, J., in Westervelt v. National Paper Co., 154 Ind. 673; 57 N. E. Rep. 552.

15—Bryson v. Whitehead, 1 S. & S. 74.

16—Morison v. Moat, 21 L. J. Ch. 248; and to the same effect, see Ansell v. Chubert, Seton (4th Ed.), 235; Peabody v. Norfolk, 98 Mass. 452; Weston v. Hemmons, 2 Vict. L. R. Eq. 121; Hagg v. Darley, 47 L. J. Ch. 567; Thum Co. v. Tloczynski, 114 Mich. 149; 72 N. W. Rep. 140; Salomon v. Hertz, 40 N. J. Eq. 400; Eastman Co. v. Reichenbach, 20 N. Y. Supp. 110; 29 N. Y. Supp. 1143; 79 Hun, 188; Little v. Gallus, 38 N. Y. Supp. 487; Fralich v. Despar, 165 Pa. St. 24; Merryweather v. Moore, L. R. (1892) 2

In order to obtain this relief it is not necessary that the employe should have been bound to secrecy by contract. In an opinion dealing with a case of this character, Judge Williams said: "Having entered the service of complainants, and having had imparted to him their secrets, defendant was, in equity and good conscience, obliged to preserve them as sacredly as his own, and this as well without a contract as

Ch. 518; Simmons Med. Co. v. Simmons, 81 Fed. Rep. 163; Stewart v. Hook, 118 Ga. 445; 45 S. E. Rep. 369; 63 L. R. A. 255; Sanitas Nut Food Co. v. Cemer, 134 Mich. 370; 96 N. W. Rep. 454; Stone v. Goss, 65 N. J. Eq. 756; 55 Atl. Rep. 736; 63 L. R. A. 344; Vulcan Detinning Co. v. American Can Co., 72 N. J. Eq. 387; 67 Atl. Rep. 339; reversing Vulcan Detinning Co. v. American Can Co., 70 N. J. Eq. 588; 62 Atl. Rep. 881 (the same case, upon application for preliminary injunction, 67 N. J. Eq. 243; 58 Atl. Rep. 290); Sterling Varnish Co v. Macon, 217 Pa. 7; 66 Atl. Rep. 78; Taylor Iron & Steel Co. v. Nichols, 70 N. J. Eq. 541; 65 Atl. Rep. 695; Tabor v. Hoffmann, 118 N. Y. 30; 23 N. E. Rep. 12; 16 Am. St. Rep. 740; Westervelt v. National Paper Co., 154 Ind. 673; 57 N. E. Rep. 552; Philadelphia Extracting Co. v. Keystone Extracting Co., 176 Fed. Rep. 830; McCall v. Wright, 198 N. Y. 143; Sooy v. State, 41 N. J. Law, 394; Macbeth-Evans Glass Co. v. Schnelbach, 239 Pa. 76; 86 Atl. Rep. 688; Applebee v. Skiwanek, 140 N. Y. S. 450; 27 N. Y. Cr. R. 78 (under N. Y. Penal Law, § 439); American Stay Co. v. Delaney, 211 Mass. 229; 97 N. E. Rep. 911; Pomeroy Ink Co. v. Pomeroy, 77 N. J. Eq. 293; 78 Atl. Rep. 698; H. B. Wiggins Sons' Co. v. Cott-A-Lap Co., 169 Fed. Rep. 150; Union Switch & Signal Co. v. Sperry, 169 Fed. Rep. 926; Witkop & Holmes Co. v. Boyce, 112 N. Y. S. 874; 61 Misc. Rep. 126; Eastern Extracting Co. v. Greater New York Extracting Co., 110 N. Y. S. 738; 126 App. Div. 928; Elaterite Paint & Mfg. Co. v. S. E. Frost Co., 105 Minn. 239; 117 N. W. Rep. 388; O'Bear-Nester Glass Co. v. Antiexplo Co., 101 Tex. 431; 108 S. W. Rep. 967; Stevens & Co. v. Stiles, 29 R. I. 399; 71 Atl. Rep. 802.

The following contract was held valid and binding upon the defendant in Fralich v. Despar, *supra:*

"I, Andrew Despar, of the city of Pittsburg, state of Pennsylvania, in the employ of E. C. Fralich, a manufacturer of oils, etc., also of the said city of Pittsburg, do solemnly swear that if the said E. C. F. makes known to me the ways and secrets of manufacturing and stilling of different kinds of oils, and of the different kinds of grease manufactured by him, that I will not use such knowledge or secrets for my own gain, nor will I ever, so long as I may live, divulge or make known in any way the knowledge I may receive while in his employ, or any part of said secret, either of mix in oils or otherwise."

with it."[17] And another court has stated the rule as follows: "By a careful reading of the various decisions upon this subject, it will be seen that some are made to depend upon a breach of an express contract between the parties, while others proceed upon the theory that where a confidential relation exists between two or more parties engaged in a business venture, the law raises an implied contract between them that the employe will not divulge any trade secrets imparted to him, or discovered by him in the course of his employment, and that a disclosure of such secrets, thus acquired, is a breach of trust and a violation of good morals, to prevent which a court of equity should intervene."[18]

Where there is such a contract between employer and employe, it is not objectionable as being in restraint of trade.[19]

The obligation of secrecy extends to every character of employment. Thus, canvassers who have accumulated materials in the course of soliciting advertisements for their employer may be enjoined from using such material for a rival publication;[20] and an engine maker's clerk who had made a table of dimensions of his employer's engines was enjoined from disclosing the data so obtained.[21]

"If a person employs another to work for him in a business in which he makes use of a secret process, or of machinery invented by himself, or by others for him, but the nature and particulars of which he desires to keep a secret, and of which desire on the part of the employer the employe has notice at the time of his employment, even if there is no express contract on the part of the employe not to divulge said secret process or machinery, the law will imply a promise to keep the employer's secret thus intrusted to him."[22]

Where it affirmatively appears that the trade secret exists, that it has been imparted in confidence to the defendant, and

17—Simmons Med. Co. v. Simmons, 81 Fed. Rep. 163-166.

18—Adams, J., in Eastman Co. v. Reichenbach 20 N. Y. Super. 110-116.

19—Simmons Med. Co. v. Simmons, 81 Fed. 163; Peabody v. Norfolk, 98 Mass. 452.

20—Lamb v. Evans, L. R. (1892) 3 Ch. 462.

21—Merryweather v. Moore, L. R. (1892) 2 Ch. 522.

22—Monks, J., in Westervelt v. National Paper Co., 154 Ind. 673, 678; 57 N. E. 552; followed in Hamilton Mfg. Co. v. Tubbs Mfg. Co., 216 Fed. Rep. 401, 407.

that the plaintiff will be injured by the disclosure, if one is made, the defense that defendants do not intend to use or divulge the secret will not be given much weight, for the reason that under the circumstances an injunction can not harm the defendant, and if the injunction was withheld, and the secret disclosed, the injury to the plaintiff would be one which the law is practically powerless to remedy.[23]

Where a designer, employed for his special skill by a manufacturer, makes the entries of formulas invented by him in the course of his employment in books of his own instead of books furnished by his employer for the purpose, the employer is entitled to the knowledge of the formulas.[24]

The principles under consideration extend beyond the relationship of master and servant. In fact, throughout all of this book that relates to equitable remedies we are but dealing with the application of those remedies which has been made upon specific forms of fraud. The cases analogous to trade secrets are many, and the language of Vice-Chancellor Turner in the leading case of *Morrison v. Moat* is applicable to all of them: "Different grounds have been assigned for the exercise of the jurisdiction. In some cases it has been referred to property, in others to contract, and in others, again, it has been treated as founded upon trust or confidence, meaning, as I conceive, that the court fastens the obligation on the conscience of the party, and enforces it against him in the same manner as it enforces, against a party to whom a benefit is given, the obligation of performing a promise, on the faith of which the benefit has been conferred."[25]

So a photographer has been restrained from making prints from a negative bearing the plaintiff's portrait;[26] a lithographer, from making copies of the plaintiffs' pictures in

23—Russell v. Lundeen, 72 Off. Gaz. 420.

24—Dempsey v. Dobson, 174 Pa. 122; 34 Atl. Rep. 459; 32 L. R. A. 761.

25—Morison v. Moat, 20 L. J. Ch. 248.

26—Pollard v. Photographic Co., 40 C. D. (Eng.) 345; Moore v. Rugg, 44 Minn. 28; 9 L. R. A. 58; 46 N. W. Rep. 141. The negative may belong to the photographer, but he has no right of reproduction without the purchaser's consent. Corliss v. E. W. Walker Co., 64 Fed. Rep. 280; Press Pub. Co. v. Falk, 59 Fed. Rep. 324.

excess of the number ordered by the plaintiffs;[27] and the exhibition of etchings obtained by the defendant through a breach of trust, has been restrained,[28] as has the publication of lectures, not published or authorized to be published by the lecturer[29] and the publication of private letters,[30] and the use of a card index.[31]

The ground for enjoining the publication of private letters has sometimes been based upon a property right in them,[32] and sometimes upon the ground that their publication would be painful to the writer.[33]

A peculiar state of facts developed in a recent case is worthy of notice. The plaintiff, a hardware dealer, had published and distributed to the trade catalogues in which the prices were marked in figures, letters and characters, according to a secret code devised by plaintiff. The defendant, who owned a copy of the catalogue, so marked with prices in secret characters, obtained a copy of the key to the code from one of the plaintiff's employes, and incorporated the secret code from the key into the catalogue. Upon this state of facts the defendant was enjoined from disclosing the information thus obtained, and a receiver was appointed to take charge of the defendant's copy of the catalogue.[34] This case appears to be in conflict with the English case of *Reuter's Telegram Co. v. Byron*, where the plaintiffs devised a cypher code containing cypher words indicating the names of their customers. This cypher was communicated to the defendant while he was in the employment of the plaintiffs. After he left the plaintiffs and started a rival business, he sent advertisements to their customers stating that he had their cyphers, and soliciting their custom.

27—Tuck & Sons v. Priester, 19 Q. B. D. 629; Levyeau v. Clements, 175 Mass. 376; 50 L. R. A. 397.

28—Albert v. Strange, 2 DeG. & Sm. 652.

29—Abernethy v. Hutchinson, 3 L. J. Ch. 214.

30—Earl of Lytton v. Devey, 54 L. J. Ch. 293; Perceval v. Phipps, 2 Ves. & B. 19.

31—Oxypathor Co. v. De Cordero, 149 N. Y. S. 513; Peerless Pattern Co. v. Pictorial Review Co., 132 N. Y. S. 37.

32—Pope v. Curl, 2 Atk. 342; Woolsey v. Judd, 4 Duer. 379.

33—Gee v. Pritchard, 2 Swanst. 402; Wetmore v. Scovell, 3 Edw. Ch. 515.

34—Simmons Hardware Co. v. Waibel, 1 So. Dak. 488; 47 N. W. Rep. 814, 11 L. R. A. 267.

The court held that the defendant was guilty of no breach of trust because the cyphers were known to the customers, and the defendant could have obtained the cyphers from any of them who might choose to do business with him.[35] The decision of the American court seems to be correct in principle.

A wide range has been allowed the defendants in unfair competition cases in the appropriation and use of the uncopyrighted catalogue matter, pictorial as well as text, of the plaintiff, as will appear in the illustrative cases cited in the foot note.[36] Nor does injunction lie against a defendant whose salesmen use plaintiff's catalogue in soliciting orders, in the absence of any evidence that such use was fraudulent.[37]

In every case where the plaintiff seeks protection for a trade secret, it must appear that it really is a secret.[38] If a so-called secret process is lawfully known to others in the trade, no one will be enjoined from disclosing or using it.[39] But the fact that the secret has been the subject of a patent, since expired, which remained a mere paper patent, and dormant, does not negative the fact that it is or may be still a secret. "Many an invention and many an idea of value are doubtless to be found in the records of the Patent Office, but so far as public actual knowledge thereof is concerned, they might as well be non-existent."[40]

Contracts relating to trade secrets are, of course, subject to the same rules of construction as other contracts. So in a case where the defendant sold a formula for making certain soap and "agreed to file and surrender his right and

35—Reuter's Telegram Co. v. Byron, 43 L. J. Ch. 661.

36—Van Kannel Revolving Door Co v. American Revolving Door Co., 135 C. C. A. 439; 215 Fed. Rep. 582; Hamilton Mfg. Co. v. Tubbs Mfg. Co., 216 Fed. Rep. 401, 411; Jewelers' Mercantile Agency v. Jewelers' Pub. Co., 155 N. Y. 241; 49 N. E. Rep. 872; 41 L. R. A. 846; 63 Am. St. Rep. 666.

37—Lamb v. Evans, L. R. (1892) 3 Ch. 462, 469, 470; Hamilton Mfg. Co. v. Tubbs Mfg. Co., 216 Fed. Rep. 401, 411.

38—Macbeth-Evans Glass Co. v. Schnelbach, 239 Pa. 76; 86 Atl. Rep. 688.

39—Bell & Bogart Soap Co. v. Petrolia Mfg. Co., 54 N. Y. Supp. 663-666; Bristol v. Equitable Life Assurance Society, 132 N. Y. 264; 30 N. E. Rep. 506; Hamilton Mfg. Co. v. Tubbs Mfg. Co., 216 Fed. Rep. 401, 407.

40—Shiras, J., in Benton v. Ward, 59 Fed. Rep. 411-413.

claims in the process and formulæ and making of said soap," and that he "would not sell any plants in the United States for the manufacture of that particular kind of soap, during the term of twenty years," it was very properly decided that the contract did not preclude him from selling or putting up any other kind of a soap plant to or for anybody else; and where he put up a soap plant for making soaps in general, and the owner of the plant then began the manufacture of the particular soap in question, there was no cause of action either as against him or the owners of the plant.[41]

Employes may be enjoined from disclosing trade secrets even in the absence of an express agreement of secrecy, as we have seen, and it is no defense that the employe was a minor at the time he entered the employment.[42]

A defendant had agreed upon entering the employment of the plaintiff as a workman, on a salary, to disclose certain secret processes known only to him. He failed to make the disclosure and left the plaintiff's employment. In defense to an application for an injunction restraining him from imparting the secret processes to others, he urged that his employment had been for no definite term. This defense did not avail in view of the fact that the plaintiff had invested in material it expected to use in connection with the secret processes. The court observed that "although the processes were not patented, yet, as they were secret, and as their secrecy was protected by the contract between the defendant and the plaintiff, the plaintiff is in a situation to insist that the defendant, who agreed to protect the secrecy of these processes, and thus preserve their value, should not be permitted to disclose them, and thus deprive the plaintiff of the valuable property which he had induced it to purchase." [43]

Where an employe of a partnership invents a secret process for the use of the firm, either member of the firm may after dissolution use the secret process, and either member will, on the complaint of another member, be enjoined from

41—Bell & Bogart Soap Co. v. Petrolia Mfg. Co., 54 N. Y. Supp. 663.

42—Little v. Gallus, 38 N. Y. Supp. 487.

43—Ramsey, J., in National Gum & Mica Co. v. Braendly, 51 N. Y. Supp. 93-97.

representing himself as being the sole owner of such secret process.[44]

Trade secrets or processes, if reduced to writing, are subject to levy and sale under a common law writ of execution.[45] Where one not a party to the suit had machinery of his own, used in connection with a secret process belonging to him, on premises belonging to a corporation for which a receiver was appointed, on the facts being presented to the court the order appointing the receiver was so modified as to permit the third party to remove his machinery from the premises, and without the receiver being given the opportunity to inspect the machinery, as such inspection would lead to the discovery of the process.[46] Trade secrets, such as recipes or processes, are proper subjects of taxation.[47] A false representation as to the efficiency of a secret process is ground for rescinding a contract for its sale.[48]

It would seem clear, on principle, that a witness not a party to a suit would be fully protected against any attempt to compel him to disclose his trade secrets, yet we find a case holding that a *subpœna duces tecum* calling for the production of drawings by such a witness was enforced, notwithstanding his objection that the drawings related to a secret process used by him.[49] This decision is unsupported by any authority. On the other hand, a defendant in an action for infringement of a process patent will not be compelled to submit to an inspection of his factory where his answer avers that his process is not that of the patent, and is his own secret, unpatented process, used from a period antedating the patent in suit.[50] Sec. 4908, United States Revised Statutes, a provision relating to the taking of testimony in interference cases pending in the Patent Office, provides that no witness shall be guilty

44—Baldwin v. Von Micheroux, 25 N. Y. Supp. 867; affirmed, 83 Hun, 43; 31 N. Y. Supp. 857.

45—Hanley v. Fidelity Ins. T. & S. Co., 8 Pa. Dist. R. 207.

46—Witt v. Reed Electric Co., 187 Pa. 424; 41 Atl. Rep. 317.

47—*In re* Brandreth, 59 N. Y. Supp. 1092; 28 Misc. Rep. 468.

48—Finley Rubber-Varnish & Enamel Co. v. Finley, N. J. Ch., 32 Atl. Rep. 740, (not officially reported).

49—Johnson Steel Street Rail Co. v. North Branch Steel Co., 48 Fed. Rep. 191.

50—Stokes Bros. Mfg. Co. v. Heller, 56 Fed. Rep. 297.

of contempt for disobeying a subpoena issued by the clerk of any court of the United States, as provided for by sec. 4906, "for refusing to disclose any secret invention or discovery made or owned by himself." In an interference proceeding, one of the parties to the interference refused to answer an interrogatory propounded to him, placing his refusal upon the ground that the question sought to disclose a secret discovery or invention, such as is protected by sec. 4908. It was held that the witness was not entitled to the protection of the section for the reason that the alleged secret possessed so intimate a connection with the subject-matter of the patent, that he had no right to withhold it from the public. The court said: "In applying for the patent it was his duty to disclose the most available method known to him of carrying the discovery into effect—in other words, of manufacturing his new fabric. This information, which may be used by others after his patent has expired, is an important part of the compensation which the public obtains for the temporary monopoly granted him. If he could withhold it, disclosing an inferior method simply, which he does not employ, the discovery would never become available public property, as the patent laws contemplate it shall. He would have a monopoly after his patent had expired, which would continue as long as he could conceal this material part of his discovery. I do not say that such disclosure was essential to the validity of his patent, (that question is not before me,) but the information withheld does not constitute such a secret as the section, or equity, protects."[51]

It is no defense to an action for royalties on the manufacture of articles invented by the plaintiff and made under his direction and from dies furnished by him, that the article was not patented; "so long as the inventor holds the secret

51—Dorman v. Keefer, 49 Fed. Rep. 462; 58 Off. Gaz. 1093. That a witness may not, in a prosecution under an anti-trust law, refuse to disclose names of dealers, outside the alleged combination, from whom he has bought goods, on the ground of trade secret, see Jones v. Goode, 28 Ohio Cir. Ct. Rep. 475. That the proprietor of a secret preparation who has made public representations as to his preparation must disclose his formula, upon an issue raised as to the truth of his representations, see Moxie Nerve Food Co. v. Modox Co., 152 Fed. Rep. 493.

in his own possession, it is property, or a thing of value, for the transfer of which he may demand a price; and, if he passes it over to a purchaser on an agreement to pay, it is no defense to the latter to say that there is no patent."[52] One who has become bound as an employe not to divulge a trade secret, can not defend on the ground that the secret was dishonestly procured by complainant's assignee.[53] The general rule, however, is well settled, that "if the giving of the testimony sought, or the production of the documents called for will disclose what are characterized as 'trade-secrets,' the witness has a legal privilege to withhold it."[54] In a bill to enjoin the disclosure of a secret process, it is not necessary to state what the process is,[55] nor need it be set out in the decree.[56]

It has been held, under secs. 888 and 894 of the New York Code of Civil Procedure, that a commission to take testimony on written interrogatories will issue, although the interrogatories apparently call for the disclosure of a secret process; Defendorf, J., holding that "the fact that the defendants say or show that the evidence sought from these witnesses is privileged should not prevent the granting of a commission."[57]

§ 110. Trademarks on products of secret processes.—In 1874, Sir George Jessel, then Master of the Rolls, announced the very fundamental rule that a party would not be permitted to apply to an article of his own invention the name of an article made by a secret recipe.[58] In a later English case Lord Herschell disposed of the defense made in a similar case, that the purchaser did not know the name of the manufacture of the original product by saying "one man may quite well pass off his goods as the goods of another if he

52—Mitchell, J., in Kroegher v. McConway & Forley Co., 149 Pa. St. 444-457; 23 Atl. Rep. 341.

53—Vulcan Detinning Co. v. American Can Co., 67 N. J. Eq. 243; 58 Atl. Rep. 290; Vulcan Detinning Co. v. American Can Co., 72 N. J. Eq. 387; 67 Atl. Rep. 339; 12 L. R. A. (N.S.) 102.

54—Cochran, J., in Crocker-Wheeler Co. v. Bullock, 134 Fed. Rep. 241, 245.

55—S. Jarvis Adams Co. v. Knapp, 58 C. C. A. 1; 121 Fed. Rep. 34, 40.

56—Pomeroy Ink Co. v. Pomeroy, 77 N. J. Eq. 293; 78 Atl. Rep. 698.

57—Cullinan v. Dwight, 100 N. Y. Supp. 896.

58—Cotton v. Gillard, 44 L. J. Ch. 90.

passes them off to people who will accept them as the manufacture of another, although they do not know that other by name at all."[59]

The origination of a secret process by an employe, followed by the adoption by the employer of a trademark for the product of that process, leaves in the employe no personal right to the use of that trademark when he leaves the employment of its owner.[60] But circumstances may arise where an abandoned formula which has not lost its secret character, may be lawfully adopted with the trademark identifying its product.[61]

§ 111. Actions and defenses.—A controlling element in denying relief in cases of alleged trade secret may be the fact that the ideas communicated to the employe were not known to him to be secret; and the existence of the alleged secret may be negatived by evidence that visitors were freely admitted to the premises where the alleged trade secret was practiced.[62] Where the defendant denies all intention to make the use of a secret alleged to be threatened by the bill, the preliminary injunction may be denied without prejudice to the right to renew the application.[63]

At law, an action of tort in the nature of trespass on the case lies against a defendant for the betrayal of a trade secret, but if actual damage is not proven the recovery will be nominal.[64]

A bill is not multifarious which couples a charge of misuse of trade secret with a charge of unfair competition.[65]

It is no defense to an action to enjoin the use of a trade secret by a former employe that the manufacture of goods by that process by the corporation plaintiff was *ultra vires*.[66]

59—Birmingham Vinegar Brewery Co. v. Powell, L. R. (1897) A. C. 710.

60—Jacoway v. Young, 228 Fed. Rep. 630.

61—W. A. Gaines & Co. v. Rock Spring Distilling Co., 226 Fed. Rep. 531, 536; 141 C. C. A. 287 (C. C. A., 6th Circuit).

62—Hamilton Mfg. Co. v. Tubbs Mfg. Co., 216 Fed. Rep. 401, 404.

63—Du Pont-De Nemours Powder Co. v. Masland, 216 Fed. Rep. 271.

64—Roystone v. Woodbury Dermatological Institute, 122 N. Y. S. 444; 67 Misc. Rep. 265.

65—James B. Sipe Co. v. Columbia Refining Co., 171 Fed. Rep. 295.

66—S. S. White Dental Mfg. Co. v. Mitchell, 188 Fed. Rep. 1017.

Where a plaintiff sues for royalties for the use of the product of a secret process under contract, it is no defense that the defendant has, by independent experiment, discovered the process, theretofore only partially communicated to it by the plaintiff.[67]

Laches is not a defense to the prayer for an injunction against misuse of a trade secret. The plaintiff, even when laches is present, "should not be estopped from enjoining the use of its secret process in the future."[68]

As to the decree, in cases of trade secret, it has been held in some cases that it should specify definitely the information or secrets the defendant is to be restrained from using;[69] in others, that it may be general in terms—"to insert the formult * * * would destroy its secrecy."[70]

Upon accounting the defendant ordered to account for profits is treated as a *quasi* trustee, the measure of recovery is his net profit, and he is to be credited with all the expenditures made in carrying on the business and for the benefit of the business, including repairs to plant and machinery, depreciation (no matter what causes it), insurance and taxes; but charged with interest on the net profits from the time they were realized.[71]

§ 112. The right of privacy.—Judge Cooley said, "the right of one's person may be said to be a right of complete immunity; to be let alone."[72] This "right to be let alone," if extended to the unauthorized publication of the portrait of an individual, would constitute the right of privacy concerning which there has been considerable discussion of late years. To say whether that right will ever be generally recognized, would be merely a guess in the present state of the adjudications, and the guess would be much more hazard-

67—Stuckes v. National Candy Co., 158 Mo. App. 342; 138 S. W. Rep. 352.

68—McPherson, J., in Philadelphia Extracting Co. v. Keystone Extracting Co., 176 Fed. Rep. 830.

69—Oxypathor Co. v. De Cordero, 149 N. Y. S. 513. For an illustrative decree, set out in the opinion, see Macbeth-Evans Glass Co. v. Schnelbach, 239 Pa. 76; 86 Atl. Rep. 688.

70—Pomeroy Ink Co. v. Pomeroy, 77 N. J. Eq. 293; 78 Atl. Rep. 698.

71—Vulcan Detinning Co. v. American Can Co., 80 N. J. Eq. 443; 85 Atl. Rep. 318.

72—Cooley on Torts, 139.

ous, if one were to say whether or not the right of privacy could ever be extended to the protection of anything more than the reproduction of the portrait of an individual. As yet, there are but few decisions upon the subject, although it has been considerably discussed in legal and other periodicals.[73]

The difficulty attendant upon the assertion of this right appears to reside principally in the apparent impossibility of extending the protection of equity to this "right to be let alone," to anything beyond the mere unauthorized reproduction of the likeness of an individual, without creating a species of *lese majeste*, and establishing a judicial censorship of all critical matter relating to an individual, which happens to displease him.

Thus, Judge Parker has stated, in his recent opinion denying the existence of the right of privacy, that "the so-called 'right of privacy' is, as the phrase suggests, founded upon the claim that a man has a right to pass through this world, if he wills, without having his picture published, his business enterprises discussed, his successful experiments written up for the benefit of others, or his eccentricities commented upon, either in hand-bills, circulars, catalogues, periodicals, or newspapers; and necessarily, that the things which may not be written and published of him must not be spoken of him by his neighbors, whether the comment be favorable or otherwise."[74] This dictum calls attention to the *reductio ad absurdum* which would result if the "right to be let alone" were to be literally asserted. And at the threshold of the inquiry, it is obvious that this "right to be let alone" must be so limited as not to interfere with freedom of speech. The right of the individual to be protected against publication of false and defamatory matter is fully established, and adequately protected by the law. In going beyond the law of slander and libel, in recognition of the individual's right not to be even criticised, or commented upon, a task is being undertaken which is both delicate and difficult, if it is not, indeed impos-

73—"The Right of Privacy," 4 Harv. Law Rev. 193. Other articles, 32 Cent. L. J. 69; 40 Cent. L. J. 53; 49 Cent. L. J. 379; 55 Cent. L. J. 123; 57 Cent. L. J. 361; 36 Am. Law Rev. 614; 12 Yale L. J. 35; 24 Nat. Corp. Rep. 709; 25 Nat. Corp. Rep. 183, 415.

74—Roberson v. Rochester Folding Box Co., 171 N. Y. 540.

sible. That any such right existed in the common law has been asserted, but scarcely proven. Again quoting from Judge Parker, "mention of such a right is not to be found in Blackstone, Kent, or any other of the great commentators upon the law, nor * * * does its existence seem to have been asserted prior to about the year 1890."[75]

Of course, the absence of precedent does not negative the existence of a right and its corresponding remedy, but the right, about which so much has been written with the result that the only definition of it which has been formulated is contained in the words "the right to be let alone," a definition which, on its face, can not be literally construed, and whose necessary limitation seems to be incapable of definition, must be closely scrutinized, and carefully weighed before it can secure a place in our jurisprudence.

In 1892 this right was distinctly affirmed by the Supreme Court of New York in a case[76] in which an injunction issued against the execution and display at the Chicago World's Fair of a statue of Mrs. Schuyler, which statue was to be designated "The Typical Philanthropist." The proceeding was brought by a relative of Mrs. Schuyler, and the injunction issued against the members of an unincorporated association under whose auspices the display was to be made. The motion for injunction *pendente lite* was granted upon the ground that Mrs. Schuyler was not a public character because she had not placed herself before the public, either in accepting public office or in becoming a candidate for office, or as an *artiste* or *literateure*. This order being appealed from, Van Brunt, P. J., said: "While concurring with the conclusion arrived at by the learned justice below, I can not subscribe to the doctrine which seems to pervade the opinion rendered upon the decision of the motion, that if Mrs. Schuyler had been a public character, as defined by him, this motion should have been denied. The claim that a person who voluntarily places himself before the public, either by accepting public office or becoming a candidate for office, or as an artist or literary man, thereby surrenders his personality while living

75—Roberson v. Rochester Folding Box Co. 171 N. Y. 540.

76—Schuyler v. Curtis, 19 N. Y. Supp. 264.

and his memory when dead to the public, to be used or abused, as any one of that irresponsible body may see fit, can not for a moment be entertained. * * * It is urged upon the part of the appellants that even if Mrs. Schuyler were alive, and had the same objection to the defendants' proposed action that the plaintiff now has, she would be remediless and powerless. If such were the fact, it would certainly be a blot upon our boasted system of jurisprudence that the courts were powerless to prevent the unwarranted doing of things by persons who are mere volunteers, which would wound in the most cruel manner the feelings of many a sensitive nature. It is further urged that the plaintiff has no standing in court and that the fancied injury to the plaintiff complained of, if any such injury can be in any way discovered, is certainly not such an injury as the court will grant an injunction to prevent, because it is not an injury to his person, to his estate, or to his good name, and is not a violation of his privacy or seclusion, and because the plaintiff stands in the same relation to the defendants and to their project as does all the rest of the world, and in no other relation. The result of this claim is that when a person is dead there is no power in any court to protect his memory, no matter how outrageously it may be insulted. The feelings of relatives and friends may be outraged, and the memory of the deceased degraded with impunity, by any person who may desire thus to affect the living. It seems to us that such a proposition carries its own refutation with its statement. It can not be that by death all protection to the reputation of the dead and the feelings of the living, in connection with the dead, has absolutely been lost. The memory of the deceased belongs to the surviving relatives and friends, and such relatives have a right to see that that which would not have been permitted in respect to the deceased when living shall not be done with impunity when the subject has become incapable of protecting himself. It is undoubtedly true that cases of the character now before the court are not to be found in the books. But it is probably the first time in the history of the world that the audacious claim which is here presented has ever been advanced. If it had, we have no doubt the books would have contained a

record in connection with the same. The fact that the plaintiff has suffered no pecuniary damage, redress for which is sought in this action, is no answer to the application, because one of the most important departments in the jurisprudence of courts of equity is the prevention of wrongs which would be otherwise irreparable because courts of law can not afford any remedy in damages."[77]

Upon entering judgment in the same case, Ingraham, J., calls attention to the fact that the action of the defendants was not a libel nor within the provisions of the New York constitution securing to each citizen the right to freely speak, write and publish his sentiments on all subjects.[78]

In a subsequent case (1893) the Superior Court of New York City reaffirmed the doctrine of *Schuyler v. Curtis* in the case of an actor whose portrait was to be published in connection with that of another member of his profession as the subjects of a voting contest to ascertain which was the more popular, and such publication was enjoined; the court remarking that "the courts will in such cases secure to the individual what has been aptly termed the right to be let alone."[79]

In 1895, *Schuyler v. Curtis* reached the New York Court of Appeals, and in an elaborate opinion delivered by Judge Peckham the judgment of the lower court was reversed. In the course of his opinion, however, he says: "For the purpose we have in view it is unnecessary to wholly deny the existence of the right of privacy to which the plaintiff appeals as the foundation of his cause of action. It may be admitted that courts have power in some cases to enjoin the doing of an act where the nature or character of the act itself is well calculated to wound the sensibilities of an individual, and where the doing of the act is wholly unjustifiable, and is, in legal contemplation, a wrong, even though the existence of no 'property,' as that term is generally used, is involved in the subject.

"If the defendant had projected such a work in the lifetime of Mrs. Schuyler, it would perhaps have been a viola-

77—Schuyler v. Curtis, 64 Hun, 594.

78—Schuyler v. Curtis, 24 N. Y. Supp. 509-511.

79—Marks v. Jaffa, 26 N. Y. Supp. 908; 6 Misc. Rep. 290.

tion of her individual right of privacy, because it might be contended that she had never occupied such a position towards the public as would have authorized such action by any one as long as it was in opposition to her wishes." Judge Gray in a dissenting opinion, stated, "I can not see why the right of privacy is not a form of property, as much as the right of complete immunity of one's person."[80] Concerning this case, the Supreme Court of Georgia has stated that it "settles nothing as to the existence of a right of privacy, but merely rules that if it exists at all, it is a personal right, and dies with the person."[81]

Judge Parker has said of this decision that "It is not authority for the existence of a right to privacy which entitles a party to restrain another from doing an act which, though not actionable at law, occasions the plaintiff mental distress."[82]

Pending this appeal another New York court had held that "a parent can not maintain an action to enjoin the unauthorized publication of the portrait of an infant child, and for damages for injury to his sensibilities caused by the invasion of his child's privacy, for the law takes no cognizance of a sentimental injury, independent of a wrong to person or property."[83]

In 1902 the New York Court of Appeals finally held that there was no right of privacy at law or enforceable in equity.[84]

The Supreme Court of Michigan in 1899 held that it had no jurisdiction to enjoin the use of the name and likeness of a deceased person used upon a label applied to a cigar named after him, so long as such publication did not amount to a libel. At the conclusion of an exhaustive review of the cases, Hooker, J., said: "This 'law of privacy' seems to have obtained a foothold at one time in the history of our

80—Schuyler v. Curtis, 42 N. E. Rep. 22-24; 147 N. Y. 434; 49 Am. St. Rep. 671; 31 L. R. A. 286.

81—Pavesich v. New England Life Ins. Co., 50 S. E. Rep. 68; 122 Ga. 190; 69 L. R. A. 101; 106 Am. St. Rep. 104.

82—Roberson v. Rochester Folding Box Co., 171 N. Y. 540.

83—Murray v. Engraving Co., 28 N. Y. Supp. 271.

84—Roberson v. Rochester Folding Box Co 171 N. Y. 538; 64 N. E. Rep. 442; reversing s. c. 71 N. Y. Supp. 876.

jurisprudence, not by that name, it is true, but in effect. It is evidenced by the old maxim, the greater the truth the greater the libel; and the result has been the emphatic expression of public disapproval, by the emancipation of the press and the establishment of freedom of speech, and the abolition in most of our states of the maxim quoted, by constitutional provisions."

"The limitation upon the exercise of these rights being the law of slander and libel, whereby the publication of an untruth that can be presumed or shown to the satisfaction, not of the plaintiff, but of others (*i. e.*, an impartial jury), to be injurious, not alone to the feelings but to the reputation, is actionable. Should it be thought that it is a hard rule that is applied in this case, it is only necessary to call attention to the fact that a ready remedy is to be found in legislation. We are not satisfied, however, that the rule is a hard one, and think that the consensus of opinion must be that the complainants contend for a much harder one."[85]

The only case in which the question of the existence of the right of privacy has been brought before the federal courts is one which the widow and children of George H. Corliss, an inventor, brought to enjoin the publication of a biographical sketch and portrait of Mr. Corliss. The plaintiffs put their case squarely upon the proposition that the proposed publication would be an invasion of the right of privacy which a court of equity should protect. There was some discussion upon the question whether Mr. Corliss was a public or a private character. The court distinctly denied the existence of any right of privacy which it could recognize, saying that under the law "one can speak and publish what he desires, provided he commits no offense against public morals or private reputation."[86] The opinion proceeds flatly on the theory that a court of equity has no power to restrain a libelous publication.[87] At the same time the publication of the portrait was enjoined because the original had been obtained by the

85—Atkinson v. John E. Doherty & Co., 121 Mich. 372; 80 N. W. Rep. 285-289.

86—Corliss v. E. W. Walker Co., 57 Fed. Rep 434.

87—Boston Diatite Co. v. Florence Mfg. Co., 114 Mass. 69; Brandreth v. Lance, 8 Paige, 24; Kidd v. Horry, 28 Fed. Rep. 773.

defendant from the plaintiffs on certain conditions which it had not complied with.

Upon the motion to dissolve the injunction certain additional evidence had been adduced, and the court in its opinion finds the fact to be that the defendant had obtained the portrait from a photograph; and that Mr. Corliss was in fact a public character. The court says: "The distinction in the case of a picture or photograph lies, it seems to me, between public and private character. A private individual should be protected against the publication of any portraiture of himself, but where an individual becomes a public character the case is different. A statesman, author, artist, or inventor, who asks for and desires public recognition, may be said to have surrendered this right to the public."[88]

The right of privacy has been recognized by the Patent Office, and, as to portraits of living individuals, the Act of 1905 prohibits their registration without the consent of the person.[89]

In a recent opinion, the Supreme Court of Georgia, per Cobb, J., has sustained the right of privacy as of common law origin, in the following language:

"The right of privacy has its foundation in the instincts of nature. It is recognized intuitively, consciousness being the witness that can be called to establish its existence. Any person whose intellect is in a normal condition recognizes at once that, as to each individual member of society, there are matters private, and there are matters public, so far as the individual is concerned. Each individual as instinctively re-

88—Corliss v. E. W. Walker Co., 64 Fed. Rep. 280-282.

89—Thus in a case presented to the Patent Office, where the applicant sought to register the mark "Dewey's Chewies," for confectionery, the commissioner said, in response to the applicant's suggestion that "Dewey's" is not an ordinary surname: "I can not refrain from expressing the opinion that even if it be registrable, no one has the right, without the consent of Dewey, to appropriate it as a trademark. A living celebrity is entitled to protection from the ordinary trader." Duell, Commissioner, in *ex parte* McInnerney, 85 Off. Gaz. 149. The Act of 1905 in § 5 contains the provision "that no portrait of a living individual may be registered as a trademark, except by the consent of such individual, evidenced by an instrument in writing."

sents any encroachment by the public upon his rights which are of a private nature as he does the withdrawal of those of his rights which are of a public nature. A right of privacy in matters purely private is therefore derived from natural law."

"The *injuria* of the Roman law, sometimes translated 'injury' and at other times 'outrage,' and which," says the court, "is generally understood at this time to convey the idea of legal wrong, was committed, not only by striking with the fists or with the club or lash, but also by shouting until a crowd gathered around one, and it was an outrage or legal wrong to merely follow an honest woman or young boy or girl; and it was declared in unequivocal terms that these illustrations were not exhaustive, but that an injury or legal wrong was committed 'by numberless other acts.' Sandar, Just. Hammond's ed. 499; Poste, Inst. of Gaius, 3d ed. 449. The punishment of one who had not committed any assault upon another, or impeded in any way his right of locomotion, but who merely attracted public attention to the other as he was passing along a public highway or standing upon his private grounds, evidences the fact that the ancient law recognized that a person had a legal right 'to be let alone,' so long as he was not interfering with the rights of other individuals or of the public."[90]

The decision of the Georgia court was unanimous. Judge Parker's opinion in the case of *Roberson v. Rochester Folding-Box Co.* was concurred in by three, and dissented from by the three other judges. A comparison of the opinions of Judge Parker and Judge Cobb discloses the best arguments for and against the existence of the right of privacy; that of Judge Cobb is well reasoned, and admirably stated; that of Judge Parker is more concisely expressed, and certainly as well grounded in reason. The conservative views of Judge Parker are summed up in the following words: "The legislative body could very well interfere and arbitrarily provide that no one should be permitted for his own selfish purpose to use the picture or the name of another for advertising purposes

90—Pavesich v. New England Life Ins. Co., 122 Ga. 190; 50 S. E. Rep. 68; 69 L. R. A. 101; 106 Am. St. Rep. 104.

without his consent. In such event no embarrassment would result to the general body of the law, for the rule would be applicable only to cases provided for by the statute. The courts, however, being without authority to legislate, are required to decide cases upon principle, and so are necessarily embarrassed by precedents created by an extreme, and therefore unjustifiable, application of an old principle."[91]

Since the foregoing was written, the New Jersey Court of Appeals has disapproved the doctrine of *Roberson v. Rochester Folding Box Co.*,[92] and Stevens, V. C., following the latter decision, has said of the Roberson case, "This case can not be sustained on principle;"[93] while the American Law Review has said editorially: "From first to last there is a decisive majority of the judges who have dealt with the case against the final conclusion announced by the court of appeals. It can not therefore be regarded as settling anything except for the guidance of inferior judicatories within the State of New York. It should not be followed as authority in other jurisdictions."[94]

The same right is invaded when the plaintiff's portrait is published in connection with defamatory matter concerning a third person; although in these cases the right of recovery has been grounded solely upon the theory of libel.[95]

The Supreme Court of Washington has declined to protect the right of privacy, "not so much because a primary right may not exist, but because in the absence of a statute, no fixed line between public and private character can be drawn."[96] In Missouri, the right of an infant five years of age to recover damages for "disturbing his privacy by publishing his picture without his consent" has been sustained.[97]

91—Roberson v. Rochester Folding Box Co., 171 N. Y. 540. For the opinions of the courts below, see s. c. 65 N. Y. Supp. 1109; 71 N. Y. Supp. 876.

92—Vanderbilt v. Mitchell, 72 N. J. Eq. 910; 67 Atl. Rep. 97.

93—Edison v. Edison Polyform Mfg. Co., 67 Atl. Rep. 392; 73 N. J. Eq. 136.

94—36 Am. Law Review, p. 634.

95—Farley v. Evening Chronicle Pub. Co., 113 Mo. App. 216; 87 S. W. Rep. 565; De Sands v. N. Y. Herald, 88 N. Y. App. Div. 492; 85 N. Y. Supp. 111; Wandt v. Hearst's Chicago American, 129 Wis. 419; 9 Am. & Eng. Ann. Cas. 864.

96—Hillman v. Star Pub. Co., 64 Wash. 691; 117 Pac. Rep. 594.

97—Munden v. Harris, 153 Mo. App. 652; 134 S. W. Rep. 1076.

In elaborately arguing the non-existence of the right of privacy the Rhode Island court has said: "it is obvious that a right can not be one of person and of property at the same time. The conclusion would seem to be that, if the right of privacy exists and has been recognized by the law, it must be as a personal tort right. It can not be a right of property. The *gravamen* of the offense in a violation of the right of privacy is the interference with the seclusion of the individual, and not of the publication."[98] The Kentucky court has broadly held that the publication of a person's portrait without his consent as an advertisement, "is a violation of the right of privacy and entitles him to recover without proof of special damages."[99] In a later case the Kentucky court affirmed a judgment for damages against a photographer, for circulating, without the plaintiff parents' permission, a photograph of the corpse of a child, the court observing "the most tender affections of the human heart cluster about the body of one's dead child. A man may recover for any injury or indignity done the body, and it would be a reproach to the law if physical injuries might be recovered for, and not those incorporeal injuries which would cause much greater suffering and humiliation."[1]

An action by a consul of Austria-Hungary to enjoin the fraudulent commercial use of the name or portrait of the Emperor of Austria-Hungary was sustained under our treaty of June 27, 1871, giving the right to consuls of that country to sue "for the purpose of protecting the rights of their countrymen."[2]

The federal supreme court has expressly refused to decide whether the unauthorized publication of a person's portrait is a tort *per se*.[3]

That the demarcation between the law of libel and the law of privacy is very shadowy, and that equity is not, in general,

98—Dubois, C. J., in Henry v. Cherry & Webb, 30 R. I. 13; 73 Atl. Rep. 97, 102.

99—Foster-Milburn Co. v. Chinn, 134 Ky. 824; 120 S. W. Rep. 364.

1—Hobson, C. J., in Douglas v. Stokes, 149 Ky. 506; 149 S. W. Rep. 849.

2—Von Thodorovich v. Beneficial Assn., 154 Fed. Rep. 911.

3—Peck v. Tribune Co., 214 U. S. 185, 190; 53 L. Ed. 960; 29 Sup. Ct. 554.

disposed to create a right where none exists at law, are reflections that must occur to the student of this topic.[4]

4—See the very able opinion of Judge Van Valkenburgh, in Vassar College v. Loose-Wiles Biscuit Co., 197 Fed. Rep. 982. Following Robertson v. Rochester Folding Box Co., New York has enacted an act to prevent the unauthorized use of the name or picture of any person for the purpose of trade.

"Section 1. A person, firm or corporation that uses, for advertising purposes or for purposes of trade, the name, portrait or picture of any living person without having first obtained the written consent of such person, or, if a minor, of his or her parent or guardian, is guilty of a misdemeanor.

"Sec. 2. Any person whose name, portrait or picture is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided, may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name or portrait or picture, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use, and if the defendant shall have knowingly used such person's name, portrait or picture in such manner as is forbidden or declared to be unlawful by this act, the jury, in its discretion, may award exemplary damages." This act has been held constitutional in Rhodes v. Sperry & Hutchinson Co., 85 N. E. Rep. 1097; 193 N. Y. 223. For an illustrative statement of facts supporting a judgment in a suit under the act, see Binns v. Vitagraph Co., 132 N. Y. S. 237.

CHAPTER VIII.

INFRINGEMENT.

§ 113. Of infringement generally.—The word "infringement" is difficult of exact definition. For the purposes of the present discussion, its broadest meaning, that of the infraction or invasion of another's trade rights, by passing off, or attempting to pass off, upon the public one's own goods as his, may suffice. As to technical trademark infringement, it should be more narrowly defined as the infraction or invasion of any portion of the mark, symbol or device in which one has acquired a right of property, either by way of reproduction in fac-simile, or imitation. An English text-writer has thus defined it: "Infringement is the use by the defendant, for trading purposes, in connection with goods of the kind for which the plaintiff's right to exclusive use exists, not being the goods of the plaintiff, of a mark identical with the plaintiff's mark, or either comprising some of its essential features or colourably resembling it, so as to be calculated to cause the goods to be taken by ordinary purchasers for the goods of the plaintiff."[1] Vice-Chancellor Shadwell stated the rule to be that, if a mark contains twenty-five parts and but one is taken (*i. e.*, imitated or copied), liability has been created thereby, and there has been a technical infringement.[2]

The same rule applies to cases of unfair competition, in which no technical trademark is involved. In such a case, the Supreme Court of Wisconsin has said "whether there is an imitation in fact * * * must be determined by inspection of the rival symbols or devices. It is not to be expected,

1—Kerly on Trademarks (2d Ed., London, 1901), p. 363.

2—Guinness v. Ullmer, 10 L. T. 127; Seb. 89. "The imitation need not be exact or perfect. It may be limited or partial; nor is it requisite that the whole should be pirated." Filley v. Fassett, 44 Mo. 173; Cox, 530; Seb. 313. And to the same effect, Braham v. Bustard, 9 L. T. N. S. 199; 1 Hem. & M. 447; 11 W. R. 1061; 2 N. R. 572; Seb. 226.

of course, that there will ever be an exact copy. The imitator will always seek to introduce enough differences to justify a claim that there has been no imitation, while incorporating enough similarities to carry the general effect of the original design to the mind of the unwary purchaser."[3]

In a similar case Judge Lacombe has said: "On the papers and exhibits now before the court, there is apparently an effort still to simulate complainant's distinguishing packages, and at the same time present a number of points of difference to argue upon when charged with infringement. It is apparently so easy for one who honestly seeks to sell his own goods as his own to dress them up in such a way that they may be recognized as his own, that, when he offers them to the public in a dress sufficiently like his neighbor's to deceive the average consumer, courts naturally suspect his motives to be such as his actions indicate."[4]

§ 114. No trademark in form, size, material or color.—It is a well settled rule that there can be no trademark right in the mere form, size or color[5] of an article used commercially, or the form, size or color of the package containing it.[6] It is

3—Winslow, J., in Manitowoc Malting Co. v. Milwaukee Malting Co., 119 Wis. 543; 97 N. W. Rep. 389.

4—Cuervo v. Owl Cigar Co., 68 Fed. Rep. 511, 512.

5—Victor Talking Machine Co. v. Armstrong, 132 Fed. Rep. 711.

6—Moorman v. Hoge, 2 Sawyer, 78; Harrington v. Libby, 14 Blatchf. 128; Ball v. Siegel, 116 Ill. 143; Enoch Morgan's Sons Co. v. Troxell, 89 N. Y. 292; Sawyer v. Horn, 4 Hughes, 239; 1 Fed. Rep. 24; Manhattan Medicine Co. v. Wood, 108 U. S. 218; *In re* Kane & Co., 9 Off. Gaz. 105; Liggett & Myer Tob. Co. v. Hynes, 20 Fed. Rep. 883; Fairbanks v. Jacobus, 14 Blatchf. 335; Fed. Case No. 4,608; Wilcox & Gibbs Sewing Machine Co. v. Gibbons, 21 Blatchf. 431; Brill v. Singer Mfg. Co., 41 Ohio St. 127; *In re* Whitaker, Newton's Dig. 130; Adams v. Heisel, 31 Fed. Rep. 279; Lorillard v. Pride, 28 Fed. Rep. 434; Davis v. Davis, 27 Fed. Rep. 490; Nuthall v. Vining, 28 W. R. 330; Van Camp Packing Co. v. Cruikshanks Bros. Co., 90 Fed. Rep. 814; Von Mumm v. Witteman, 85 Fed. Rep. 966; Von Mumm v. Witteman (2), 33 C. C. A. 404; 91 Fed. Rep. 126; Fleischmann v. Starkey, 25 Fed. Rep. 127; Brown v. Doscher, 147 N. Y. 647-651; Charles E. Hires Co. v. Consumers' Co., 41 C. C. A. 71; 100 Fed. Rep. 809-811; Flagg Mfg. Co. v. Holway, 178 Mass. 83; 59 N. E. Rep. 667; E. Regensburg & Sons v. Juan F. Portuondo Cigar Mfg. Co., 136 Fed. Rep. 866, 869; E. Regensburg & Sons v. Juan F. Portuondo Cigar Mfg. Co., 73 C. C. A. 378; 142 Fed. Rep. 160.

also an established principle that there can be no trademark right in the directions, notices or usual advertising matter used upon or in description of merchandise.[7] There has never been a deviation from this rule in the adjudication of the courts of this country. Whenever relief has been granted against an imitator or counterfeiter of either the form, size, color, method of packing, advertising, or directions used by a legitimate dealer, it has been granted upon the broad theory of regulating fraud, and not upon the narrower ground of technical trademark infringement.

There can be no technical trademark in a well known material substance, such as a tin tag impressed upon plug tobacco;[8] nor in a method of packing merchandise;[9] or a display card, with horizontal lettering, for hooks and eyes;[10] but a fraudulent imitation of another's tin tag has been restrained;[11] and injunctions against the fraudulent use of another's style of package and method of packing[12] are frequent, in the absence of any claim to a technical trademark right in the complainant.

The courts have been averse to recognizing a trademark right in anything calculated to be useful, aside from indicating origin or ownership. So, in holding that there was no trademark right in a series of indentations in plug tobacco, so arranged as to serve as guides in cutting the plug into pieces of one ounce each, Judge Blodgett said: "One of the principles running through the law of trademarks is that there need be no utility attached to the trademark itself—that is, it shall have no useful purpose in connection with the goods further than to show the origin or manufacture."[13]

There may be combinations of form and color with other things, which will entitle the owner to relief against one dupli-

7—Candee v. Deere, 54 Ill. 462; Ball v. Siegel, 116 Ill. 143.

8—Lorillard v. Pride, 28 Fed. Rep. 434.

9—Davis v. Davis, 27 Fed. Rep. 490.

10—De Long Hook & Eye Co. v. Francis Hook & Eye Co., 118 Fed. Rep. 938.

11—Lorillard v. Wright, 15 Fed. Rep. 383.

12—Washington Medallion Pen Co. v. Easterbrook, Fed. Case No. 17,246a.

13—Dausman & Drummond Tobacco Co. v. Ruffner, Fed. Case No. 3,585; 15 Off. Gaz. 559.

cating his article. Thus in a case where the defendant duplicated the plaintiff's talking machine records, injunction issued against the "manufacture and sale of disk records, black or nearly black in color, with a red seal center inscribed with decoration and letters in gilt, when such records contain the shop numbers or catalogue numbers of complainant's disk records, or when the sound recording grooves thereon are copies of the grooves on complainant's disk records."[14]

Judge J. B. McPherson has well said "the superficial details of construction certainly need not be identical in nearly every particular;" and hence enjoined the defendant from imitating the plaintiff's miner's lamp.[15]

Finally, it is obvious, that where the resemblance resides in particulars of packages which have become common to the trade, no relief can be granted.[16] A mark, consisting of a brown-colored-paper cigar-band of peculiar shape, has been held to be invalid, Judge McPherson saying: "Certainly the color alone could not be appropriated by the complainant as a trademark, nor the shape alone, nor the material alone; and even the combination of these three elements could not make a valid trademark, because neither singly nor in combination do they point to the complainant as the source from which the goods are derived."[17]

In a later case, the doctrine of color as trademark was thus aptly expressed by Judge (later Mr. Justice) Lurton: "Color except in connection with some definite, arbitrary design, such as when impressed upon a circle, star, cross, or other figure, or employed in definite association with some characteristics which serve to distinguish the article as made or sold by a particular person, is not the subject of monopoly as a trademark."[18]

14—Victor Talking Machine Co. v. Armstrong, 132 Fed. Rep. 711.

15—Grier Bros. Co. v. Baldwin, 135 C. C. A. 433; 219 Fed. Rep. 735, 740.

16—Schenker v. Awerbach, 85 N. Y. Supp. 129.

17—E. Regensburg & Sons v. Juan F. Portuondo Cigar Mfg. Co., 136 Fed. Rep. 866, 869; affirmed, 73 C. C. A. 378; 142 Fed. Rep. 160.

18—Newcomer & Lewis v. J. A. Scriven Co., 168 Fed. Rep. 621; 94 C. C. A. 77; citing Diamond Match Co. v. Saginaw Match Co., 142 Fed. Rep. 727; 74 C. C. A. 59; A. Leschen & Sons Rope Co. v. Broderick & Buscom Rope Co., 201 U. S. 166; 50 L. Ed. 710.

So a metal tag applied to the shell of an oyster as an identification of plaintiff's oysters in the trade, gave the plaintiff no monopoly in the use of such tags.[19]

§ 115. The early adjudications.—The endeavor of the dishonest merchant to prey upon and profit by the reputation of his honest competitor is always hampered by fear of detection. If a trademark is counterfeited the counterfeit product is placed upon the market stealthily; where the offender lacks the courage to counterfeit he resorts to colorable imitations, not of his competitor's trademark, but of his methods of packing and preparing goods for sale, thus simulating a resemblance, in the words of Judge Lacombe, "sufficiently strong to mislead the consumer, although containing variations sufficient to argue about, should the designer be brought into court."[20]

The earliest leading case involving this form of fraudulent competition arose between rival soap manufacturers. The plaintiffs made and sold an article styled "Genuine Yankee Soap." The defendant put up a soap under the same style, imitating the size and shape of the cake, the color and material of the wrapper, and a hand-bill, as used by the plaintiffs. There was disinclination on the part of the court to decide whether the words "Genuine Yankee" were a valid trademark, and its decision was put solely upon the ground of unfair trade, the court saying: "The defendant is engaged in a gross and palpable endeavor, by imitating the marks and labels used by plaintiffs, to deceive the public and obtain patronage which would in all probability be attracted to the plaintiffs. * * * They have adopted, in reference to their manufacture (of an article which any and every one may manufacture and sell, if he please), a form and size of cake, a particular mode of covering and packing, a combination of three labels on each cake, an exterior hand-bill upon the box, and have so arranged the whole as to suggest to any one desiring to purchase their soap, upon an inspection, that the article is theirs, and made by them, like that heretofore made, sold and known as their

19—Armstrong Seatag Co. v. Smith's Island Oyster Co., 139 C. C. A. 656; 224 Fed. Rep. 100.

20—Collinsplatt v. Finlayson, 88 Fed. Rep. 693.

manufacture. All this the defendant has copied, with an exactness which is calculated to deceive even the wary, much more to entrap those who are not in the exercise of a rigid scrutiny. * * * Without deciding whether the defendant may or may not use either of the words 'Genuine' or 'Yankee,' in any possible combination, we think it sufficient to say that he may not use the labels, or devices, or hand-bills which he is using, nor any other like labels, hand-bills, or devices, in imitation of, or simulating the labels, devices, or hand-bills used by the plaintiffs, as set forth in the bill of complaint, or any other similar labels, devices, or hand-bills calculated to deceive the public, or create the belief that the soap he sells is the soap made or sold by the plaintiffs under the name of Genuine Yankee Soap."[21]

Mr. Rowland Cox has said,[22] however, that the rule "that where the appearance of a peculiar and original package has acquired through use an understood reference to the goods of a manufacturer, and a competing manufacturer knowingly imitates the peculiar characteristics of the package, with intent to deceive the public, such imitations will be held to be an infringement of the rights of the person first using the package," can hardly be said to have found distinct expression prior to 1878, where it occurs in the opinion of Judge Wheeler in *Frese v. Bachof*.[23] And, indeed, that decision, if not the earliest, is still one of the clearest in its enunciation of the rule.

§ 116. Infringement of color.—The cases in which an unfair competition is effected by means of infringement of color alone are naturally very few in number. Where the color involved is common to the trade, it will be disregarded in determining the issue of infringement.[24] Indeed, the case nearest approximating such an infringement is one in which the complainant and defendant manufactured stoves of similar external appear-

21—Williams v. Johnson (1857), 2 Bos. 1; Cox, 214.

22—Cox, Manual, p. 86; note to Williams v. Johnson, *supra*.

23—Seb. 603; 13 Off. Gaz. 635; Fed. Case No. 5,110.

24—Postum Cereal Co. v. American Health Food Co., 56 C. C. A. 360; 119 Fed. Rep. 848, 852; Continental Tobacco Co. v. Larus & Bro. Co., 66 C. C. A. 557; 133 Fed. Rep. 727.

ance, enameling the inside faces of their stoves with white enamel. On demurrer to the bill Judge Baker said: "If the question for decision were simply whether the plaintiff could acquire the sole right to use white enamel for the lining of the doors of its stoves and ranges, it would present a question whose solution would prove embarrassing. But the case made upon the bill and admitted by the demurrer is that the defendants are manufacturing stoves and ranges having white enamel doors in the similitude of those manufactured by complainant, and with the fraudulent purpose of palming them off upon the trade and the public as the stoves and ranges manufactured by the complainant. It is not necessary to determine whether the white enamel lining, which has been long and exclusively used by the complainant for the inner lining of the doors of its stoves and ranges, constitutes a trademark, or whether it does not. It is sufficient to justify the interposition of a court of equity if the stoves and ranges manufactured by the defendants are purposely constructed in the similitude of those manufactured by the complainant, with the intention and result of deceiving the trade and public, and inducing them to purchase the stoves and ranges of the defendants in the belief that they are purchasing the stoves and ranges of the complainant's manufacture. The imitative devices used upon the stoves and ranges manufactured by the defendants are alleged to be employed by them for the purpose and with the result of deceiving the public, and thereby diverting the trade of the complainant to the defendants. This they have neither the moral nor the legal right to do."[25]

The question of its collocation must always be considered in connection with the question of infringement by the use of color. Announcing the opinion of the Federal Circuit Court of Appeals of the Second Circuit, Judge Lacombe has said: "Color, undoubtedly, is a most important element in all package combinations; but there are other elements as well, which go to make up the entire combination. Because a total change of color would so change the general appearance as to destroy resemblance to another package, it by no means follows that color alone would be sufficient to produce a general appear-

25—Buck's Stove & Range Co. v. Kiechle, 76 Fed. Rep. 758

ance, resembling another package. It would not be giving the complainant a monopoly of yellow to restrain the sale of a particular yellow package, where, in addition to the color, a number of other elements, each differing more or less from its analogue in complainant's package, had been so collated together as to produce a general appearance calculated to delude the unwary purchaser."[26]

So that we find many cases in which the imitation of color has been a material element in determining the question of infringement.[27] In a proper case the court will enjoin the defendant from using the color used by the plaintiff, upon the theory that the defendant must be allowed no advantage out of the trade thus obtained wrongfully, but must establish the reputation of his goods upon merit, and without benefit of the imitation.[28]

26—N. K. Fairbank Co. v. R. W. Bell Mfg. Co., 77 Fed. Rep. 869; 23 C. C. A. 554; reversing s. c. 71 Fed. Rep. 295. To the same effect see Allen B. Wrisley Co. v. Geo. E. Rouse Soap Co., 87 Fed. Rep. 589.

27—Kerry v. Toupin, 60 Fed. Rep. 272; Burt v. Smith, 71 Fed. Rep. 161; Carbolic Soap Co. v. Thompson, 25 Fed. Rep. 625; Cleveland Stone Co. v. Wallace, 52 Fed. Rep. 431-438; Anheuser-Busch Brewing Co. v. Clarke, 26 Fed. Rep. 410; Landreth v. Landreth, 22 Fed. Rep. 41; Lorillard v. Wright, 15 Fed. Rep. 383; Hostetter v. Adams, 10 Fed. Rep. 838; Von Mumm v. Frash, 56 Fed. Rep. 830; Wellman & Dwire Tobacco Co. v. Ware Tobacco Works, 46 Fed. Rep. 289; Gail v. Wackerbarth, 28 Fed. Rep. 286; Hires v. Hires, 6 Pa. Dis. R. 285; Myers v. Theller, 38 Fed. Rep. 607; American Brewing Co. v. St. Louis Brewing Co., 47 Mo. App. 14; Sperry v. Percival Milling Co., 81 Cal. 252; Royal Baking Powder Co. v. Davis, 26 Fed. Rep. 293; Fleischmann v. Starkey, 25 Fed. Rep. 127; C. F. Simmons Med. Co. v. Simmons, 81 Fed. Rep. 163; Johnson & Johnson v. Bauer & Black, 27 C. C. A. 374; 82 Fed. Rep. 662; reversing s. c., 79 Fed. Rep. 954; Fischer v. Blank, 138 N. Y. 251; Cox, Manual, 731; McCann v. Anthony, 21 Mo. App. 83; 38 Off. Gaz. 333; Von Mumm v. Kirk, 40 Fed. Rep. 589; Coats v. Merrick Thread Co., 36 Fed. Rep. 324; Philadelphia Nov. Co. v. Blakesley Nov. Co., 40 Fed. Rep. 588; Procter & Gamble Co. v. Globe Refining Co., 34 C. C. A. 405; 92 Fed. Rep. 357; Johnson v. Brunor, 107 Fed. Rep. 466; Lalance & Grosjean Mfg. Co. v. National Enameling & Stamping Co., 109 Fed. Rep. 317; National Biscuit Co. v. Swick, 121 Fed. Rep. 1007; Rains v. White, 21 Ky. L. R. 742; 52 S. W. Rep. 970; Kassel v. Jenda, 70 N. Y. Supp. 480.

Illustration: The use of a strip of blue paper in imitation of a Canadian excise stamp. Hiram Walker & Sons v. Hockstaeder, 85 Fed. Rep. 776.

28—Franck v. Franck Chicory Co., 95 Fed. Rep. 818-821.

It may be said that in issues of technical trademark infringement the color of the respective marks is frequently of controlling importance. Any system of registration, to be effective, ought to provide for the registration of marks in the exact coloring which it is intended to apply to the mark in use. After the English Court of Appeal had discussed this question,[29] it was enacted by Parliament that registration might be in color.[30]

In the consideration of cases of alleged unfair competition involving the color of a product, the fact that the color is decorative and fanciful, and "non-functional," may be a weighty element in restraining alleged imitation.[31]

§ 117. Infringement of size and form—Distinctive dress.—The decision of the leading case, *Cook & Bernheimer Co. v. Ross*,[32] by Judge Lacombe in the Circuit Court of the United States for the Southern District of New York, marked a distinct advance in the scientific development of the law of unfair competition. The complainant was a corporation which had acquired the sole right to bottle, at the distillery, the "Mount Vernon Rye" whisky distilled by the Hannis Distilling Company, in which bottling the complainant used a bottle of distinctive form. The facts more fully appear in the opinion, a portion of which is as follows:

"Complainant, of course, has no exclusive right to the name 'Mount Vernon,' and the labels of defendant are in no sense

29—*In re* Worthington & Co.'s Trademark, L. R. 14 Ch. D. 8-18. See also Nuthall v. Vining, 28 W. R. 330; Cartmell, 248.

30—The Patents, Designs and Trademarks Act, 1883, § 67. It has been held, under this section, that the mark registered in color must be distinctive apart from its color; and as said by Kay, J.: "You may register a mark, which is otherwise distinctive in color, and that gives you the right to use it in any color you like; but you can not register a mark of which the only distinction is the use of a color, because, practically, under the terms of the act, that would give you a monopoly of all the colors of the rainbow." *In re* Hanson's Trademark, 5 R. P. C. 130; L. R. 37 Ch. D. 112; 57 L. J. Ch. 173; 57 L. T. N. S. 859; 36 W. R. 134; Cartmell, 146.

31—Coca-Cola Co. v. Gay-Ola Co., 200 Fed. Rep. 720; 119 C. C. A. 164; Same v. Same, 211 Fed. Rep. 942; 128 C. C. A. 440; Hiram Walker & Sons v. Grubman, 222 Fed. Rep. 478, 479.

32—73 Fed. Rep. 203.

an imitation of the labels of the complainant. Complainant's case rests solely on the form of package, which it claims has been so imitated as to make out a case of unfair competition.

"Undoubtedly, a large part of the consumption of whisky is in public drinking places, where it is dispensed to the consumer from the opened bottle. It is always desirable, therefore, for a dealer who wishes to push the sale of his own goods on their own merits to devise, if he can, some earmark more permanent than a pasted label to distinguish them. Complainant's predecessors accordingly, in March, 1890, adopted a brown glass bottle of a peculiar square shape, unlike any that had theretofore been used for bottling whisky, or, indeed, so far as the evidence shows, for any other purpose. It is a form of package well calculated by its novelty to catch the eye, and be retained in the remembrance of any one who has once seen it. In order to develop and extend the business they expected to control under their agreement with the Hannis Distilling Company, complainant and its predecessors have expended more than $50,000 in advertising its said bottling. In all these advertisements the peculiar square-shaped bottle is the chief and most prominent feature. It is not surprising, therefore, to find it stated in the moving affidavits that the shape and general appearance of the bottle has become to be principally, if not exclusively, relied on by ordinary purchasers as the means of identifying this bottling of Mount Vernon whisky from all other bottlings, the purity of which is not guaranteed by the distillers, but only by the bottler. Complainant's bottling seems to have acquired a high reputation, large and increasing quantities of it being yearly sold, at a price in excess of that obtained by other bottlers of Mount Vernon whisky.

"About December, 1895, defendants, who had been dealing in Mount Vernon whisky for many years, began first to put it up in bottles, which are Chinese copies of the peculiar square-shaped, bulging-necked bottles of the complainant. Of course they aver that this was without any intention 'to deceive the public, or to palm off defendants' goods for complainant's.' They account for the sudden appearance of their output of Mount Vernon whisky in this form as follows: 'There was a

demand for Mount Vernon whisky along in November last, and defendants sought a convenient and useful package in which to place their product upon the market, and purchased a stock of bottles of the square form for that purpose, without making a special design therefor, and in the open market;' and allege that 'such bottles can be purchased of reputable bottle manufacturers from molds used for some time last past.' This last averment may well be true. The industry of defendants' counsel has marshaled here an array of square-shaped bottles filled with whisky, which shows that for some time imitations of complainant's bottle have been on the market. But there is not a word of proof to trace back any one of these bottles to a period anterior to the adoption of the square shape by complainant's predecessor as a distinctive form of package. Despite defendants' denials,—and they only deny intent to deceive the public, not intent to use a form of package just like complainant's,—the court can not escape the conviction that they found the square-shaped bottle 'convenient and useful,' because it was calculated to increase the sale of their goods; and that such increase, if increase there be, is due to the circumstances that the purchasers from defendants have a reasonable expectation that the ultimate consumer, deceived by the shape, will mistake the bottle for one of complainant's. This is unfair competition within the authorities, and should be restrained. Injunction *pendente lite* is granted against the further use of the square-shaped, bulging-necked bottle as a package for Mount Vernon whisky."

There never existed a valid reason why a manufacturer should not be protected in the use of a package so peculiar and distinctive in size and shape as not to interfere with the packing methods of the trade generally. In this respect the law of trademarks fell short in the recognition it should have extended to tradesmen, who, like the Cook & Bernheimer Company in the case last mentioned, chose to distinguish their wares by distinctive packing. On account of this deficiency in the law, occasional hardships were inflicted upon honest tradesmen and the dishonest competitor went unwhipped of justice.[33] But the amount of fraudulent trading effected by

33—Enoch Morgan's Sons Co. v. Troxell, 89 N. Y. Supp. 292.

means of this form of imitation was sure to evoke the ruling of the leading case in time, and there are numbers of other cases in which an imitation of size and form has been a moving ground of injunction.[34] The remedy has in some cases been held to be dependent upon proof that the public has actually been deceived by the defendant's package.[35] It has been expressly held, indeed, that "there is no unfair competition, apart from the infringement of a patent or trademark, unless the competing person so makes or marks his goods or conducts his business that purchasers of ordinary caution and prudence, and not those who are exceptionally dull, are likely to be misled into the belief that his goods are the goods of somebody else."[36] But it is the probability of deception, and not proof that customers have actually been deceived, that controls or should control in all cases of unfair competition as well as in cases of technical trademark infringement. A learned English judge has asked: "Why should we be astute to say that (the defendant) can not succeed in doing what he is straining every nerve to do?"[37] Where the form and size of a package have become common to a trade, resemblance in either or both of these particulars is not actionable.[38]

In all of this class of cases the general rule of trademark law applies, that it is immaterial whether the goods sold by

34—Charles E. Hires Co. v. Consumers' Co., 100 Fed. Rep. 809; Apollinaris Co. v. Brumler, Cox, Manual, 429; Hostetter v. Adams, 10 Fed. Rep. 838; Sawyer v. Kellogg, 7 Fed. Rep. 720; Sperry & Co. v. Percival Milling Co., 81 Cal. 252; Norra v. Williams Mfg. Co., 158 Mass. 110; Moxie Nerve Food Co. v. Baumbach, 32 Fed. Rep. 205; Kerry v. Toupin, 60 Fed. Rep. 272; Burt v. Smith, 71 Fed. Rep. 161; Hildreth v. McDonald, 161 Mass. 16; 49 Am. St. Rep. 440; Royal Baking Powder Co. v. Davis, 26 Fed. Rep. 293.

35—Hildreth v. D. S. McDonald Co., 161 Mass. 16; 41 N. E. Rep. 56; 49 Am. St. Rep. 440.

36—Allen, J., in Dover Stamping Co. v. Fellows, 163 Mass. 191; 40 N. E. Rep. 105; 28 L. R. A. 448; 47 Am. St. Rep. 448; citing Gilman v. Hunnewell, 122 Mass. 139; Singer Mfg. Co. v. Wilson, 2 Ch. D. 434-447; Brill v. Singer Mfg. Co., 41 Ohio St. 127; 52 Am. Rep. 74; Robertson v. Berry, 50 Md. 591; 33 Am. Rep. 328. To the same effect, Van Camp Packing Co. v. Cruikshanks Bros. Co., 90 Fed. Rep. 814; Von Mumm v. Wittoman, 85 Fed. Rep. 966; affirmed, 91 Fed. Rep. 126; 33 C. C. A. 404.

37—Lindley, L. J., in Shazenger v. Feltham, 6 R. P. C. 538.

38—Allen B. Wrisley Co. v. Geo. E. Ronse Soap Co., 87 Fed. Rep. 589.

the defendant are inferior or superior to those of the plaintiff. Thus in an early case Judge Morris said: "What we decide is that whether the complainant has a trademark or not, as he was the first to put up bluing for sale in the peculiarly shaped and labeled boxes adopted by him, and as his goods have become known to purchasers, and are bought as the goods of the complainant by reason of their peculiar shape, color and label, no person has the right to use the complainant's form of package, color or label, or any imitation thereof, in such manner as to mislead purchasers into buying his goods for those of the complainant, whether they be better or worse in quality."[39]

The registration of such trademarks as "a green line or stripe" arbitrarily applied to one edge of a canvas belt, although the Patent Office persists in granting such registrations, can not be sustained.[40]

Where a plaintiff produced toy animals, copied by defendant, the court observed "both parties have an equal right to copy nature," but expressed a belief that a different question would have been presented had the defendant copied "grotesque, comical dolls, or singular variants from normal animals."[41]

In connection with this branch of our subject, it should be noted that, in the absence of a patent, every one is at liberty to reproduce merchandise or machinery made by another. In the language of the Massachusetts court, "in the absence of a patent, the freedom of manufacture can not be cut down under the name of preventing unfair competition."[42] In an earlier case, it was said that "apart from these (*i. e.*, patents for inventions or designs) any one may make anything in any form, and may copy with exactness that which another has produced, without inflicting any legal injury, unless he

39—Sawyer v. Horn, 1 Fed. Rep. 24-38.

40—Gandy Belting Co. v. Victor-Balata Co., 215 Fed. Rep. 795.

41—Hough, J., in Margarete Steiff v. Bing, 215 Fed. Rep. 204, 208; see also Steiff v. Gimbel Bros., 131 C. C. A. 21; 214 Fed. Rep. 569; Margarete Steiff v. Bing, 124 C. C. A. 560; 206 Fed. Rep. 900, dealing with the same facts.

42—Holmes, C. J., in Flagg Mfg. Co. v. Holway, 178 Mass. 83; 59 N. E. Rep. 667. To the same effect see Piaget v. Headley, 68 N. Y. Supp. 351.

attributes to that which he has made a false origin, by claiming it to be the manufacture of another person."[43] In a later case, Judge Severens has thus stated the rule: "Without doubt, a party may adopt distinguishing marks to denote the origin or production as being his own, or he may adopt some other peculiar method of distinguishing his own goods, and thus retain the benefit of the good reputation which he has acquired for them. But the very idea of distinguishing them implies that it can not be done by such universal characteristics as belong to other goods of the kind and which the general public have the undoubted right to use."[44] But in making an article whose structure may be made by anyone, it is nevertheless unlawful to imitate its ensemble as made by another, with the purpose and effect of misleading the public.[45]

43—Johnson, J., in Fairbanks v. Jacobus, 14 Blatchf. 337, 339; Fed. Case No. 4,608, and to the same effect, see Dover Stamping Co. v. Fellows, 163 Mass. 191; 40 N. E. Rep. 105; 28 L. R. A. 448; 47 Am. St. Rep. 448; Marvel Co. v. Tullar Co., 125 Fed. Rep. 829.

44—Globe-Wernicke Co. v. Fred Macey Co., 56 C. C. A. 304; 119 Fed. Rep. 696, 704; followed in Burrowes v. Carrom-Archarena Co., 190 Fed. Rep. 204.

45—Globe-Wernicke Co. v. Brown & Besly, 57 C. C. A. 344; 121 Fed. Rep. 90; Marvel Co. v. Pearl, 66 C. C. A. 226; 122 Fed. Rep. 160, distinguishes between the cases : which the resemblance between manufactured articles is due to the physical requirements essential to commercial success, and those in which the resemblance of form and color are unnecessary and manifestly designed to misrepresent the origin of the articles. This decision, by the Court of Appeals for the Second Circuit, denying injunctive relief on the peculiar facts of the case, was preceded by Enterprise Mfg. Co. v. Landers, Frary & Clark, 65 C. C. A. 587; 131 Fed. Rep. 240, and followed by Yale & Towne Mfg. Co. v. Alder, 83 C. C. A. 149; 154 Fed. Rep. 37 (reversing s. c., 149 Fed. Rep. 783), in both of which cases injunctive relief was granted. On an application for preliminary injunction, Judge Lacombe has said, "whether the shape of ventilators and location of parts have been selected because of some necessity or because of a desire to imitate complainant's structure is a matter which it would be very difficult to decide upon affidavits." Rushmore v. Saxon, 154 Fed. Rep. 213. Thus, it was held that check-marks produced on the head of a horseshoe nail as an incident in the course of manufacture, do not constitute a trademark, and their use by another will not, in the absence of proof of fraudulent intent or actual deception, be enjoined as unfair competition. Capewell Horse Nail Co. v. Putnam Nail Co., 140 Fed. Rep. 670. But the contrary was held in further litigation on the same mark.

§ 118. Intent and scienter.—It was at first held that equity could only administer relief ancillary to that offered by the courts of law. It is, indeed, difficult to apprehend on what ground this reluctance to interfere in trademark cases arose. The only explanation vouchsafed is, that when chancery undertook to act it was "exercising a jurisdiction over legal rights."[46] But whether at law or in equity, the doctrine of the common law prevailed, that the defendant must be shown to have guilty knowledge or fraudulent intent.[47]

In 1838 the rule was distinctly announced that courts of equity "will act on the principle of protecting property alone, and it is not necessary for the injunction to prove fraud in the defendant."[48] This rule is now universally recognized in technical trademark cases.[49] It is unnecessary to show

Capewell Horse Nail Co. v. Mooney, 167 Fed. 575; affirmed, Capewell Horse Nail Co. v. Mooney, 172 Fed. 826; 97 C. C. A. 248.

Similarity of manufactures in details not essential to the performance of the mechanical function will always be enjoined where it is so extensive as to satisfy the mind of the court that defendant was wilfully simulating the non-essentials of the complainant's wares, and that the result is confusion in the minds of the purchasing public. H. Mueller Mfg. Co. v. A. Y. McDonally & Morrison Mfg. Co., 164 Fed. Rep. 1001, 1005; Rushmore v. Manhattan Screw & Stamping Works, 163 Fed. Rep. 939; 90 C. C. A. 299. Important issues are, is the similarity necessary, or is it inherent in the nature of the article. Baldwin v. Grier Bros. Co., 215 Fed. Rep. 735, 737. For interesting cases of distinctive dress, see Pacific Coast Condensed Milk Co. v. Frye & Co., 85 Wash. 133; 147 Pac. Rep. 865; Safe-Cabinet Co. v. Globe-Wernicke Co., 3 Ohio App. 24; 34 Ohio C. C. 528.

46—Motley v. Downman, 3 Mylne & Cr. 1-14.

47—Singleton v. Bolton, 3 Doug. 293; Morrison v. Salmon, 2 Man. & G. 385; Crawshay v. Thompson, 4 Man. & G. 357; Taylor v. Ashton, 11 M. & W. 402; Rodgers v. Nowill, 5 C. B. 109; Myers v. Baker, 3 H. & N. 802; Sykes v. Sykes, 3 B. & C. 541; 5 D. & R. 292.

48—Millington v. Fox, 3 Mylne & Cr. 338.

49—Glenny v. Smith, 2 Drew. & Sm. 476; 11 Jur. N. S. 964; 13 L. T. N. S. 11; 13 W. R. 1032; 6 N. R. 363; Seb. 247; Filley v. Fassett, 44 Mo. 173; Cox, 530; Seb. 313; Amoskeag Mfg. Co. v. Garner (1), 55 Barb. 151; 6 Abb. Pr. N. S. 265; Cox, 541; Seb. 314; Holmes, Booth & Haydens v. Holmes, Booth & Atwood Mfg. Co., 37 Conn. 278; 9 Am. Rep. 324; Seb. 340; Singer Mfg. Co. v. Wilson, 3 App. Cas. 376-391; Colman v. Crump, 70 N. Y. 573; 16 Alb. L. J. 352; Seb. 579; Shaw v. Pilling, 175 Pa. St. 78-87; Wotherspoon v. Currie, L. R. 5 H. L. 508-517; McLean v. Fleming, 96 U. S. 245-253; 24 L. Ed. 828; Liggett

that the defendant knew that his trademark resembled any other trademark,[50] and it follows that it need not be shown that he knew whose mark his resembled;[51] and, the intent of the defendant being immaterial, the fact that he intended to infringe plaintiff's rights will not entitle the plaintiff to relief if the defendant's acts do not amount to trademark infringement or unfair competition.[52]

There is a line of demarcation, to be noted in this regard, between the class of unfair trade cases which involves a technical trademark and that which does not. Where a plaintiff establishes by competent proof his title to the specific trademark, infringement is shown by comparison with the defendant's mark. The resemblance of the defendant's mark creates a presumption of fraud.[53] But where the plaintiff has no trademark there is no basis of comparison such as existed in the former case, because there is no technical property right in the plaintiff. Mere resemblance between the goods of the parties may or may not be sufficient to establish the right to

& Myer Tob. Co. v. Hynes, 20 Fed. Rep. 883; C. F. Simmons Med. Co. v. Mansfield Drug Co., 93 Tenn. 84; Elgin Nat. Watch Co. v. Illinois Watch Case Co. (2), 179 U. S. 665-674; 45 L. Ed. 365; Cravenette Co. v. Benjamin, 105 Fed. Rep. 621; American Grocer Pub. Co. v. Grocer Pub. Co., 25 Hun, 398.

50—Kinahan v. Kinahan, 15 Ir. Ch. 75; Orr-Ewing & Co. v. Grant, 2 Hyde, 185; Singer Mfg. Co. v. Loog, 18 Ch. D. 412; Harrison v. Taylor, 11 Jur. N. S. 408; Edelsten v. Edelsten, 1 DeG. J. & S. 185; Burgess v. Hills, 26 Beavan, 244; Regis v. J. A. Jaynes & Co., 185 Mass. 458; 70 N. E. Rep. 480.

51—Cartier v. Carlile, 31 Beavan, 292.

52—Kann v. Diamond Steel Co., 89 Fed. Rep. 706-712. "An intention to injure, if no injury be done, constitutes no ground for relief." Jenkins, J., in G. W. Cole Co. v. American Cement & Oil Co., 65 C. C. A. 105; 130 Fed. Rep. 703, 711; citing § 76 of the first edition of this book, and Centaur Co. v. Marshall, 38 C. C. A. 413; 97 Fed. Rep. 785; Postum Cereal Co. v. American Health Food Co., 56 C. C. A. 360; 119 Fed. Rep. 848, 852.

53—"A trademark, clearly such, is in itself evidence, when used by a third party, of an illegal act. It is of itself evidence that the party intended to defraud and to palm off his goods as another's." Mr. Justice Bradley, in Putnam Nail Co. v. Bennett, 43 Fed. Rep. 800. And to the same effect, Boston Diatite Co. v. Florence Mfg. Co., 114 Mass. 69; McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828; Menendez v. Holt, 128 U. S. 514; 32 L. Ed. 526; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537; 34 L. Ed. 997; Galena Signal Oil Co. v. W. P. Fuller & Co., 142 Fed. Rep. 1002, 1007.

injunction. It must be established that the defendant is unfairly competing with the plaintiff; his fraud must be proven directly or by inference. In a recent opinion Judge Baker says: "While the idea of fraud or imposition lies at the foundation of the law of technical trademarks as well as the law of unfair competition, it must be borne in mind that fraud may rest in actual intent shown by the evidence, or may be inferred from the circumstances, or may be conclusively presumed from the act itself. In the case of unfair competition the fraudulent intent must be shown by the evidence, or be inferable from the circumstances, while in the case of the use by one trader of the trademark or trade-symbol of a rival trader, fraud will be presumed from its wrongful use."[54]

And the United States Supreme Court states the rule to be that "the deceitful representation must be made out or be clearly inferable from the circumstances."[55]

"An inference to this effect is justified where, on the party's attention being called to the subject, he unreasonably persists in holding to the imitative dress which he has given to his goods, however innocently intended, at the outstart."[56]

§ 119. What persons liable.—With the establishment of the rule that *mala mens* need not be shown,[57] it followed that liability for infringement was extended to many persons who, in the absence of that doctrine, could not be reached by the owner of the pirated mark. "All persons in any way connected with the infringement of a trademark are responsible to the owner for the injury done to his rights."[58]

54—Church & Dwight Co. v. Russ, 99 Fed. Rep. 276-279. To the same effect, see Lamont, Corliss & Co. v. Hershey, 140 Fed. Rep. 763; American Clay Mfg. Co. v. American Clay Mfg. Co., 198 Pa. 189; 47 Atl. Rep. 936. "This is not a case of unfair competition, but it involves only a pure common law trademark. In such case defendant's good faith is immaterial as respects the right to injunction." Knappen, J., in DeVoe Snuff Co. v. Wolff, 124 C. C. A. 302; 206 Fed. Rep. 420, 424.

55—Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537-551; 34 L. Ed. 997; followed in Gorham Mfg. Co. v. Emery-Bird-Thayer Co., 43 C. C. A. 511; 104 Fed. Rep. 243, 244.

56—Archbald, J., in Lamont, Corliss & Co. v. Hershey, 140 Fed. Rep. 763, 764.

57—Wotherspoon v. Currie, L. R. 5 H. L. 508-517; Saxlehner v. Siegel-Cooper Co., 179 U. S. 42; 45 L. Ed. 77.

58—Hawley, J., in Hennessy v. Herrmann, 89 Fed. Rep. 669-670.

§ 120. Of labels, generally.—The dress of a commercial article usually embodies a label. The consequence is that the cases refer to labels, frequently, as though they were a distinct factor in the law of unfair competition, to be treated as an entity, regardless of the presence or absence of trademark material upon them. Thus Vice-Chancellor Van Fleet, in the Court of Chancery of New Jersey, has said: "If we speak with accuracy, these labels can not be called 'trademarks,' but they serve substantially the same purpose. They are the marks by which the complainant's goods are distinguished in the markets from all like goods put upon the market by other persons, and are, for that reason, according to many decisions, just as much under the protection of the law as trademarks are. The law protects them for the same reasons, and in exactly the same way, that it does trademarks. The leading principle of the law on this subject is that no man should be permitted to sell his goods on the reputation which another dealer has established in the market for his goods, and this principle applies with equal force to the case where the goods of such other dealer are known in the market by a label, as it does to the case where they are known by a mark which is strictly a trademark. No dealer can lawfully adopt the label of another dealer, or one so near like it as to lead the public to suppose that the article to which it is affixed was put upon the market by such other dealer."[59]

The duty is incumbent upon one entering into competition with an established business to make "an honest effort to accentuate differences in labels and wrappers."[60] A label

59—Wirtz v. Eagle Bottling Co., 50 N. J. Eq. 164; 24 Atl. Rep. 658; following Miller Tobacco Manufactory Co. v. Commerce, 45 N. J. Law, 18, 24. To the same effect, see American Brewing Co. v. Bienville Brewery, 153 Fed. Rep. 615, 619; Anheuser-Busch Brewing Assn. v. Clarke, 26 Fed. Rep. 410; R. J. Reynolds Tobacco Co. v. Allen Bros. Tobacco Co., 151 Fed. Rep. 819; Clay v. Kline, 149 Fed. Rep. 912 (where the marks involved were cigar bands); DeLong Hook & Eye Co. v. Francis Hook & Eye Co. (2), 139 Fed. Rep. 146; DeLong Hook & Eye Co. v. Francis Hook & Eye Co., 75 C. C. A. 484; 144 Fed. Rep. 682 (where the hooks and eyes of the respective parties were mounted for sale by being stitched on cards).

60—Lacombe, J., in Saxlehner v. Graef, 81 Fed. Rep. 704.

used on a patented article does not become *publici juris* on the expiration of the patent.[61]

§ 121. Of packages, generally.—We have heretofore (sec. 54) noted those technical objections which prevent the package in which the merchandise is sold from being a trademark. It is evident, from the cases referred to in the next preceding section, that the doctrines of unfair competition apply to packages as to every other form of commercial dress in which merchandise is dealt with commercially.

The package usually embraces a label; or it may be a carton, or other package, upon which the designs, emblems, or words selected by the originator of the package are directly imprinted. However it may be composed and by whatever means the emblems upon it are affixed, they can not be protected or recognized in equity except when, and to the extent that, they are distinguishing. To be distinguishing, they must not be common to the trade.

This principle applies to the component parts visible upon the exterior of the package, as well as to what the English courts have comprehensively called the "get-up" of the package.

Judge Lowell, in a carefully considered opinion,[62] quoted the following applications of this rule as applied in England:

"He (the plaintiff) must make out, not that the defendant's are like his by reason of those features which are common to them and other people, but he must make out that the defendant's are like his by reason of something peculiar to him, and by reason of the defendant having adopted some mark, or device, or label, or something of that kind, which distinguishes the plaintiff's from other goods which have, like his, the features common to the trade. Unless the plaintiff can bring his case up to that, he fails."[63]

"The evidence is very strong that one tin may be mistaken for the other, very likely; but why? Because of the features common to them and common to all."[64]

61—Centaur Co. v. Killenberger, 87 Fed. Rep. 725, 726.

62—United States Tobacco Co. v. McGreenery, 144 Fed. Rep. 531, 532.

63—Payton v. Snelling, 17 R. P. C. 48, 52.

64—Payton v. Snelling, 17 R. P. C. 628.

"The only question you have then to consider is whether the defendant's get-up is so like the plaintiffs' as to be calculated to be mistaken for it. But when, as in this case and in the last, what is called the plaintiffs' get-up consists of two totally different things combined, namely, a get-up common to the trade, and a distinctive feature affixed or added to the common feature, then what you have to consider is not whether the defendants' get-up is like the plaintiffs' as regards the common features, but whether that which specially distinguishes the plaintiffs' has been taken by the defendants."[65]

§ 122. The engraver or manufacturer of the label.—The rule that equity will enjoin one who participates in the production of an infringing mark or label was first established in *Guinness v. Ullmer*, in 1847, in which case the plaintiffs were brewers of porter, and the defendants, who were engravers, engraved plates to be used in printing labels in imitation of the plaintiff's label.[66] This decision was followed in 1855 by a case in which a printer printed and sold labels which were fac-similes of the plaintiff's labels, and the piracy was enjoined;[67] and the rule is now extended to include one who deals in counterfeit labels, though he does not manufacture them.[68]

In 1877 a label printer was enjoined by the Superior Court of New York from the manufacture of labels which were colorable imitations of plaintiff's. In affirming the decision of the lower court the New York Court of Appeals announced that it is not necessary in such a case "to establish a guilty knowledge or fraudulent intent on the part of the wrong-

65—Payton v. Ward, 17 R. P. C. 58

66—Guinness v. Ullmer, 10 L. T. 127; Seb. 89.

67—Farina v. Silverlock, 1 K. & J. 509; 3 Eq. Rep. 883; 24 L. J. Ch. 632; 25 L. T. 211; 3 W. R. 532; 6 DeG. M. & G. 214; 26 L. J. Ch. 11; 2 Jur. N. S. 1008; 27 L. T. 277; 4 W. R. 731; 52 Leg. Obs. 342; 30 L. T. 242; 31 L. T. 99; 4 K. & J. 650; Seb. 130. See also to the same effect, Colman v. Crump, 70 N. Y. 573; Cuervo v. Jacob Henkell Co., 60 Off. Gaz. 440; 50 Fed. Rep. 471; Moxie Nerve Food Co. v. Beach, 33 Fed. Rep. 248; De Kuyper v. Witteman, 23 Fed. Rep. 871; Hildreth v. Sparks Mfg. Co., 99 Fed. Rep. 484.

68—Hennessy v. Herrmann, 89 Fed. Rep. 669; Cantrell & Cochrane, Ltd., v. Wittemann, 109 Fed. Rep. 82

doer."[69] It is now the settled rule that "the mere act of printing and selling labels in imitation of the complainant's might be innocent, and, without evidence of an illicit purpose, would not be a violation of the complainant's rights."[70] Judge Thayer, however, held that the court would presume fraudulent intent where counterfeit labels were manufactured and sold and advertised for sale by the defendant.[71]

Where a person induces a manufacturer to make for him goods marked with the trademark of a third person, the manufacturer can hold him liable for all money paid and expense incurred by the manufacturer in compromising a suit brought against him by the owner of the trademark.[72]

Where both parties are in a similar business, one will be enjoined from buying up the empty bottles or other packages used by the other.[73]

Where a suit against a manufacturer using an infringing carton had been compromised, the plaintiff releasing all claims against the defendant's customers, a subsequent suit against

69—Colman v. Crump, 70 N. Y. 573-578; affirming s. c., 40 N. Y. Super. Ct. (8 J. & S.) 548; Seb. 579. The court of appeals in this case further says (per Allen, J.): "It is an infraction of that right (*i. e.*, the right to a trademark) to print or manufacture, or put on the market for sale and sell for use, upon articles of merchandise of the same class as those upon which it is used by the proprietor, any device or symbol which by its resemblance to the established trademark will be liable to deceive the public and lead to the purchase and use of that which is not the manufacture of the proprietor, believing it to be his." From which Mr. Cox makes this deduction: "The distinction would seem to be that where the facts of the case show that the printer of the labels contemplated their use upon goods not made by the owner of the mark, the court will interfere whatever the intent; but where the purpose was that they should be honestly used in such manner as to be tantamount to an application of the mark by its owner, the courts will decline to interfere." Note to Farina v. Silverlock, Cox, Manual, 130.

70—Wallace, J., in De Kuyper v. Witteman, 23 Fed. Rep. 871; Cox, Manual, 694.

71—Carson v. Ury, 39 Fed. Rep. 777; Cox, Manual, 709. See also Von Mumm v. Wittemann, 85 Fed. Rep. 966.

72—Dixon v. Faweus, 9 W. R. 414; 3 Ell. & Ell. 537; 30 L. J. Q. B. 137; 7 Jur. N. S. 895; 3 L. T. N. S. 693; Seb. 194.

73—Evans v. Von Laer, 32 Fed. Rep. 153; Sawyer Crystal Blue Co. v. Hubbard, 32 Fed. Rep. 388.

the manufacturer of the cartons used by the first defendant was dismissed as inequitable.[74]

§ 123. **Of counterfeiting trademarks.**—A counterfeit mark is one which is a fac-simile (*e. g.*, an exact copy or reproduction) of a genuine trademark. Counterfeiting may be accomplished either by using forged fac-simile trademarks, or by using genuine trademarks upon goods substituted for those of the owners of the trademarks; as by refilling bottles, boxes or other packages bearing trademarks after their original contents have been consumed.

§ 124. **Of imitation of trademarks.**—An imitation is a mark so contrived as to resemble an established trademark. The imitation is actionable only in cases where, upon comparison, the court determines that the difference is "merely colorable,"[75] or as stated by Vice-Chancellor Wood: "In every case the court must ascertain whether the differences are made *bona fide* in order to distinguish the one article from them, whether the resemblances and the differences are such as naturally arise from the necessity of the case, or whether, on the other hand, the differences are simply colorable."[76]

§ 125. **Colorable imitation.**—As to what constitutes colorable imitation, some apparent diversity of opinion arises in the cases. In the opinion of Vice-Chancellor Wood from which we have quoted in the foregoing section, he says: "Resemblance is a circumstance which is of primary importance for the court to consider, because if the court finds, as it almost invariably does find in such cases as this, that there is no reason for the resemblance, excepting for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading."[77] But this dictum is not convincing, because if the resemblance is not, in fact, calculated to mislead, the fact that it was adopted for the purpose of misleading is wholly immaterial.

74—Hillside Chemical Co. v. Munson, 146 Fed. Rep. 198.

75—Davis v. Kendall, 2 R. I. 566; Cox, 112; Seb. 103.

76—Taylor v. Taylor, 2 Eq. Rep. 290; 23 L. J. Ch. 255; 22 L. T. 271; Seb. 124.

77—Taylor v. Taylor, *supra*.

Thus it has been held repeatedly that where there is no imitation of the essential part of the trademark, a resemblance in particulars common to the trade is not an infringement.[78]

§ 126. The test of probability of deception.—The variance of opinion as to what constitutes colorable imitation arises from the standards adopted by the different courts as to the tendency of the alleged infringement to deceive the cautious, ordinary or unwary customer. It is never necessary to establish actual deception. Lord Westbury said that it was not "necessary for relief in equity that proof should be given of persons having been actually deceived, and having bought goods with the defendant's mark under the belief that they were the manufacture of the plaintiffs, provided the court be satisfied that the resemblance is such as would be likely to cause the one mark to be mistaken for the other."[79] Accordingly it is no defense to show that all the persons purchasing goods bearing the simulated mark were aware that the goods were not of the plaintiff's manufacture,[80] or that the

78—Portuondo v. Monne, 28 Fed. Rep. 16; Price & Steuart, 1115; Ball v. Siegel, 116 Ill. 137; 56 Am. Rep. 766; *In re* Horsburgh, 53 L. J. Ch. 237; Tucker Mfg. Co. v. Boyington, 9 Off. Gaz. 455; Fed. Case No. 14,229; Thornton v. Crowley, 47 N. Y. Super. Ct. 527; Price & Steuart, 455; Coats v. Merrick, 36 Fed. Rep. 324; 45 Off. Gaz. 347; Marshall v. Hawkins, 4 N. Z. L. R. Sup. Ct. 59; Stachelberg v. Ponce (2), 128 U. S. 686; 32 L. Ed. 569.

79—Edelsten v. Edelsten, 1 DeG. J. & S. 200; 9 Jur. N. S. 479; 11 W. R. 328; 7 L. T. N. S. 768; 1 N. R. 300; and to the same effect, see Monro v. Smith, 13 N. Y. Sup. 708; Cox, Manual, 724; Dixon v. Fawcus, 3 Ell. & Ell. 537; 30 L. J. Q. B. 137; 7 Jur. N. S. 895; 3 L. T. N. S. 693; 9 W. R. 414; *In re* Christiansen's Trademark, 3 R. P. C. 54; Cartmell, 95; Compania General de Tobacos v. Rehder, 5 R. P. C. 61; Cartmell, 103; Orr-Ewing v. Johnston, 7 A. C. 219; 51 L. J. Ch. 797; 46 L. T. 216; 30 W. R. 417; Cartmell, 249; Seb. 646; Reddaway & Co. v. Bentham Hemp Spinning Co., 9 R. P. C. 503 (1892); 2 Q. B. 639; 67 L. T. 301; Braham v. Bustard, 9 L. T. N. S. 199; 1 Hem. & M. 427; 11 W. R. 1061; 2 N. R. 572; Seb. 226; Filley v. Fassett, 44 Mo. 168; Seb. 313; Abbott v. Bakers & Confectioners Tea Assn., W. N. 1871, p. 207; W. N. 1872, p. 31; Seb. 379; Osgood v. Allen, Fed. Case No. 10,603; 1 Holmes, 185; 6 Am. L. T. 20; 3 Off. Gaz. 124; Seb. 410; Job Printers' Union of Chicago v Kinsley, 107 Ill. App. 654.

80—Edelsten v. Edelsten, 9 Jur. N. S. 479; 1 DeG. J. & S. 185; 11 W. R. 328; 7 L. T. N. S. 768; 1 N. R. 300.

maker of the spurious goods, or the jobber who sells them to retailers, informs those who purchase that the article is spurious or an imitation;[81] the reason being that there is no assurance that the retailer will give the same cautionary information to his customers.[82] So where the defendant claimed that the goods bearing the false mark were for his own family's use, he was enjoined;[83] and where the defendants contended that they did not deal in the goods bearing the fraudulent mark, but only acted as forwarding agents, they were enjoined.[84]

It is always the presumption, however, that the consuming purchaser has no opportunity of comparing the conflicting marks; and this presumption is an important element in passing upon the probability of the defendant's mark effecting deception.[85]

There is the further presumption which has been recognized judicially, that the consuming purchaser is "apt to act quickly, and is therefore not expected to exercise a high degree of caution."[86]

Among other statements of the rule as to the necessary probability of deception in cases of unfair competition we find the following: "It is sufficient if the proofs show that the actual and probable result of the use of defendant's label will be to deceive the ordinary purchaser making purchases in the ordinary way."[87]

§ 127. The degree of resemblance which constitutes infringement.—It follows from the principles which we have

81—Coats v. Holbrook, 2 Sandf. Ch. 586; Seb. 79.

82—Chappell v. Davidson, 2 K. & J. 123; 8 DeG. M. & G. 1; Seb. 136.

83—Upmann v. Forester, L. R. 24 Ch. D. 231; 52 L. J. Ch. 946; 49 L. T. 122; 32 W. R. 28; Cartmell, 331.

84—Upmann v. Elkan, L. R. 12 Eq. 140; 40 L. J. Ch. 475; 24 L. T. N. S. 869; 19 W. R. 867; L. R. 7 Ch. 130; 41 L. J. Ch. 246; 25 L. T. N. S. 813; 20 W. R. 131; Seb. 369.

85—Pillsbury v. Pillsbury-Washburn Co., 64 Fed. Rep. 841; 12 C. C. A. 432; Manufacturing Co. v. Trainer, 101 U. S. 51-64; 25 L. Ed. 993; Liggett & Myer Tobacco Co. v. Hynes, 20 Fed. Rep. 883.

86—Paris Medicine Co. v. W. H. Hill Co., 102 Fed. Rep. 148-151; 42 C. C. A. 227.

87—Hazel, J., in Aluminum Cooking Utensil Co. v. National Aluminum Works, 226 Fed. Rep. 815, 817.

reviewed that the question of infringement may be treated from the standpoint of the degree of approximation between the conflicting marks. The rule for applying this test has been thus expressed: "What degree of resemblance is necessary to constitute an infringement is incapable of exact definition, as applicable to all cases. All that courts of justice can do in that regard is to say that no trader can adopt a trademark so resembling that of another trader as that ordinary purchasers buying with ordinary caution, are likely to be misled. Where the similarity is sufficient to create a false impression in the public mind, and is of a character to mislead and deceive the ordinary purchaser in the exercise of ordinary care and caution in such matters, it is sufficient to give the injured party a right to redress."[88]

When the rule is stated in this way, it comes back to the original question, the degree of care expected of the consuming purchaser.

But the true test of likelihood of deception is always to view the possibility of such deception from the standpoint of the consumer, and not from that of the "trade expert."[89]

The application of this rule has sometimes gone far afield from the ancient rule that if a mark contained twenty-five parts, and but one was taken by the defendant, it constituted infringement. Thus in a Missouri case the plaintiff's mark for cigars was the name "Union Station" and the picture of a building known by that name. The defendant's label had a smaller picture of the same building, and the words "The Gilpin-Union Station." Each party displayed his own name or initials on the package. The facts recited in the opinion make out a typical case of technical trademark infringement, yet the court denied the relief sought solely on the ground of the differences in the labels, though the conceded facts show the defendant to have appropriated all of the technical trademark matter of the plaintiff's label.[90]

88—McAdam, J., in Jerome v. Johnson, 59 N. Y. Supp. 859; quoting the first two sentences from Mr. Justice Clifford in McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828.

89—Cuervo v. Owl Cigar Co., 68 Fed. Rep. 541.

90—Nicholson v. Wm. A. Stickney Cigar Co., 158 Mo. 158; 59 S. W. Rep. 121.

§ 128. The degree of care expected of the purchaser.—Mr. Justice Clifford expressed the rule in these words: "What degree of resemblance is necessary to constitute an infringement is incapable of exact definition as applicable to all cases. All that courts of justice can do in that regard is to say that no trader can adopt a trademark so resembling that of another trader as that ordinary purchasers buying with ordinary caution are likely to be misled."[91] But further, in the same opinion, he bases the decision explicitly upon the ground that the defendant's package "is well calculated to mislead and deceive the *unwary*."[92]

In the language of Judge Thomas, "The usual purchaser neither abstracts, or analyzes for the purposes of differentiation and judgment."[93]

Judge Knappen has said "the protection accorded to a trademark is not limited to the cautious and discriminating customer, but embraces the 'ordinary' or 'unwary' purchaser as well."[94]

There are many instances of similar dicta. We have heretofore referred to the assertion of Vice-Chancellor Shadwell, who said that "If a thing contains twenty-five parts, and but one is taken, an imitation of that one will be sufficient to contribute to a deception, and the law will hold those responsible who have contributed to the fraud."[95] It is at this point that we can secure probably the most striking proof of the manner in which the law of trademarks and the law of unfair competition overlap each other. True, the function of the trademark is to distinguish the goods to which it is applied, and whose origin or ownership it indicates. True that the purpose of an intentional infringement is to draw away the

91—McLean v. Fleming, 96 U. S. 245-251; 24 L. Ed. 828; following the language of Lord Cranworth in Seixo v. Provezende, L. R. 1 Ch. D. 192. See also Popham v. Wilcox, 14 Abb. Pr. N. S. 206; 38 N. Y. Super. Ct. 274; 66 N. Y. 69; 23 Am. Rep. 22; Seb. 425; Dawes v. Davies, Seb. 426.

92—McLean v. Fleming, 96 U. S. 245, at p. 256; 24 L. Ed. 832.

93—Cantrell & Cochrane v. Butler, 124 Fed. Rep. 290.

94—DeVoe Snuff Co. v. Wolff, 124 C. C. A. 302; 206 Fed. Rep. 420, 424.

95—Guinness v. Ullmer, 10 L. T. 127. See also Leather Cloth Case, 11 H. L. C. 523; 35 L. J. Ch. 53; 11 Jur. N. S. 513; 12 L. T. N. S. 742; 13 W. R. 873; Popham v. Wilcox, 66 N. Y. 69.

trade secured by the infringed mark for the benefit of the owner of the infringing mark. That infringement is to be determined, not by the question whether any substantial part of the trademark is copied or duplicated by the infringing mark, but by the tendency of the pirated mark to deceive (whether the careful, ordinary or unwary purchaser is immaterial), is an anomaly in our jurisprudence. But the courts have persisted in disregarding the technical composition and detail of trademarks, and have invariably applied the test of tendency of the suspected mark to deceive. The test ignores the absolute right of property which exists in a lawful trademark, and gives the owner of such a mark no other or further rights than are given the plaintiff who uses only generic terms to designate his wares and perforce relies upon the doctrines of unfair competition.[96]

The broad rule as stated above by Mr. Justice Clifford has been elaborated by other courts. In some cases no reference is made to the care and caution expected to be exercised by the purchasing public,[97] while in others it is held that it must be shown that the mark employed bears such resemblance to the complainant's trademark "as to be calculated to mislead the public generally who are purchasers of the article;"[98] sometimes it has been expressed as the deception of "the ordinary mass of purchasers;"[99] or, as by the Massachusetts court, that injunction will not lie "unless the form of the printed words, the words themselves, and the figures, lines

96—Lord Westbury evidently was impressed with this thought when he said, "Imposition on the public is necessary for the plaintiff's title, but in this way only, that it is a test of the invasion by the defendant of the plaintiff's right of property; for there is no injury if the mark used by the defendant is not such as is mistaken, or is likely to be mistaken, by the public for the mark of the plaintiff; but the true ground of this court's jurisdiction is property." Hall v. Barrows, 4 DeG. J. & S. 150.

97—Ransome v. Bentall, 3 L. J. Ch. N. S. 161; Seb. 53; Taylor v. Carpenter (3), 2 Sandf. 603; 11 Paige, 292; Cox, 45; Seb. 84; Coffeen v. Brunton, 5 McLean, 256; Cox, 132; Seb. 109; Shrimpton v. Laight, 18 Beav. 164; Hardy v. Cutter, 3 Off. Gaz. 468; Heinz v. Lutz, 146 Pa. 592; 23 Atl. Rep. 314.

98—Walton v. Crowley, Fed. Case No. 17,133; 3 Blatchf. 440-447; Compania de Tobacos v. Rehder, 5 R. P. C. 61; Cartmell, 103.

99—Blackwell v. Wright, 73 N. C. 310-313; Crawshay v. Thompson, 4 Man. & G. 357; 5 Scott N. R. 562; 11 L. J. C. P. 301; Seb. 72.

and devices, are so similar that any person, with such reasonable care and observation as the public generally are capable of using and may be expected to exercise, would mistake the one for the other."[1] The irreverent layman could not fail to note the remarkable elasticity of the rule as thus laid down.[2] And we find a court of repute holding that "it is the unwary, and not the wary, who are to be protected, as most likely to be taken in by the counterfeit;"[3] and another saying that equity "should presume that the public makes use of the senses of sight and hearing, and that it is possessed of a sufficient amount of intelligence to note the difference these senses convey;"[4] and Sir George Jessel saying: "I am not, as I consider, to decide cases in favor of fools and idiots, but in favor of ordinary English people, who understand English when they see it."[5]

The best considered opinions seem to be those that insist upon fairness in trade even though the only persons likely to be deceived are those who can not read or write.[6]

1—Gilman v. Hunnewell, 122 Mass. 139-148. It is only fair to note that this case was improperly brought as a trademark case, and is treated as such by the court, whereas the facts show that injunctive relief could only have been granted, if at all, to restrain the unfair competition of the defendant. It has been held elsewhere, however, that the relief will not be granted where the defendants' acts are such as could deceive only a careless purchaser. N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 88 Fed. Rep. 694. But this decision was reversed on appeal; s. c., 42 C. C. A. 276; 102 Fed. Rep. 327-332.

2—Substantially the same *dictum* is to be found in Ball v. Siegel, 116 Ill. 137-146; citing Popham v. Cole, 66 N. Y. 69.

3—Swift v. Dey, 4 Robertson, 611; Cox, 319; Seb. 245. And Judge Benedict has said: "It is no answer to say that the ultimate purchaser was ignorant or unwary." Von Mumm v. Frash, 56 Fed. Rep. 830-839. The following cases have held that the right to relief depends only upon a degree of resemblance calculated to deceive the careless and unwary: Colman v. Crump, 70 N. Y. 573, 578; McCann v. Anthony, 21 Mo. App. 83; Wirtz v. Eagle Bottling Co., 50 N. J. Eq. 164; 24 Atl. Rep. 658.

4—Munro v. Tousey, 129 N. Y. 38.

5—Singer Mfg. Co. v. Wilson, L. R. 2 Ch. D. 434; quoted with approval, Munro v. Smith, 13 N. Y. Sup. 708.

6—Walter Baker & Co. v. Puritan Pure Food Co., 139 Fed. Rep. 680, 683; Fischer v. Blank, 138 N. Y. 244; 33 N. E. Rep. 1040; Cox, Manual, Case No. 731.

The English courts have devoted much time to speculating whether "most Englishmen" would mistake the defendant's mark for the plaintiff's, or whether if the mark failed to deceive "most Englishmen" it still might mislead "the ordinary native purchaser in Bombay where the goods go," as has actually been done in the opinion of one court.[7] Under the doctrine so stated, I will not be protected by injunction in a case where the defendant has not copied my trademark sufficiently in detail to deceive "most Englishmen," but if my goods are sold to natives of Africa I may have an injunction against him if he engages in that trade.

If we were to undertake to deduce a general rule from the cases it would be that the test is the liklihood of deception of the consuming purchaser;[8] and in applying this test all doubts are to be resolved in favor of the complainant.[9]

§ 129. Infringement must be by use on same class of goods. —The English Patents, Designs, and Trademark Act, 1883 to 1888, provide that the application for registration must state the particular goods or classes of goods in connection with which the applicant desires the trademark to be registered.[10] A similar provision exists in the act of congress of 1905.[11] Aside from these provisions as to registration, it is self-evident that there can be no infringement unless the two marks are used on the same class of goods;[12] though in this country,

7—Wilkinson v. Griffith, 8 R. P. C. 370-374.

8—Allegretti Chocolate Cream Co. v. Keller, 85 Fed. Rep. 643; Collinsplatt v. Finlayson, 88 Fed. Rep. 693; N. K. Fairbank Co. v. R. W. Bell Mfg. Co., 23 C. C. A. 554; 77 Fed. Rep. 869-877; Hansen v. Siegel-Cooper Co. (1), 106 Fed. Rep. 690-691; Kostering v. Seattle Brewing & Malting Co., 116 Fed. Rep. 620; 54 C. C. A. 76.

9—Anheuser-Busch Brewing Assn. v. Piza, 24 Fed. Rep. 149-151. That injunction will be granted if the resemblance is "calculated to deceive the unwary, the incautious, or the ignorant purchaser," see Cauffman v. Schuler, 123 Fed. Rep. 205.

10—Patents, Designs and Trademarks Act, 1883, Part IV, § 62, subsec. 3.

11—Act of 1905, § 1.

12—*In re* Rabone, Seb. 642; *In re* Jelly, Son & Jones, 51 L. J. Ch. 639; *In re* Whiteley, 43 L. T. N. S. 627; Ainsworth v. Walmsley, L. R. 1 Eq. 518; Hall v. Barrows, 4 DeG. J. & S. 150; Hart v. Colley, 7 R. P. C. 93; L. R. 44 Ch. D. 193; 59 L. J. Ch. 355; Cartmell, 154; Jay v. Ladler, 6 R. P. C. 136; L. R. 40 Ch. D. 649; 60 L. T. 27; 37 W.

owing to the absence of the exact classifications used in the English registration practice, it is probably more exact to say that the marks must be used upon goods of so similar description that goods bearing the defendant's mark may be taken for the manufacture of the plaintiff; as where the plaintiff adopted the words "Lone Jack" to designate smoking tobacco manufactured by him, and the defendant applied the same words to cigarettes. The court gave as its reason for enjoining the defendant that he was holding out his cigarettes as containing the plaintiff's tobacco.[13] And where the defendants were selling shirts under the name of "Wamyesta" and advertising them as made of "Wamyesta," they were enjoined from using that designation at the instance of the Wamsutta Mills, whose product was known as "Wamsutta" muslin, and was not used by defendants in the manufacture of their shirts.[14] Where the complainants used the words "Collins & Co." upon metal articles of their manufacture, but did not manufacture shovels, the defendants were enjoined from placing those words on shovels, they having exported shovels so marked to Australia, where the complainants marketed a portion of their output.[15] In a recent case Judge Bradford said: "Pale ale and half-and-half must, as against an infringer of a trademark for the former, be treated as malt liquors substantially similar to each other and belonging to the same class. Courts should not be astute to recognize in favor of an infringer fine distinctions between different articles of merchandise of the same general nature, and should resolve against the wrong-doer any fair doubt whether the public may or may not be deceived through the application of the spurious symbol."[16] Where the plaintiff was the manu-

R. 505; Cartmell, 184; Colman v. Crump, 70 N. Y. 573; Hecht v. Porter, 9 Pac. C. L. J. 569; Société Anonyme v. Baxter, 14 Blatchf. 261, Fed. Case No. 8099; Amoskeag Mfg. Co. v. Garner, 55 Barb. 151; George v. Smith, 52 Fed. Rep. 830; Air-Brush Mfg. Co. v. Thayer, 84 Fed. Rep. 640.

13—Carroll v. Ertheiler, Cox, Manual, 669; 1 Fed. Rep. 688. To the same effect, see American Tobacco Co. v. Polacsek, 170 Fed. Rep. 117.

14—Wamsutta Mills v. Allen, 12 Phila. 535.

15—Collins Co. v. Oliver Ames & Sons, 18 Fed. Rep. 561. See also to the same effect, Eno v. Dunn, L. R. 15 A. C. 252.

16—Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206-211.

facturer of "Omega Oil," a liniment extensively advertised as a remedy for skin and scalp diseases, a defendant who began to manufacture and sell a soap named "Omega Oil Medicated Soap," advertised by defendant as a remedy for diseases of the skin and scalp, an injunction was granted the plaintiff on the authority of the "Lone Jack" case, Judge Blanchard saying that "The adoption of the words 'Omega Oil' by defendant was calculated to deceive the public into the belief that plaintiff's article was being put up for sale in another form, at least into the belief that the soap was placed on the market by plaintiff or by its consent." [17]

It is the necessary converse of the rule under consideration that it is no defense to an action for trademark infringement that the defendant used the mark in application to another class of merchandise before the plaintiff began his use of the mark. Thus where a defendant had applied the word, "Epicure" to canned peaches and canned tomatoes, that fact did not avail as a defense, where the plaintiff was the first to apply the word to canned salmon, and the defendant afterwards began to apply it to canned salmon. In his opinion, Judge Coxe observes: "The reasoning of some of the authorities would indicate that the defendants had a right to use the brand in connection with other fruit and vegetables, analogous to tomatoes and peaches, but to assert that they have the right to use it on all canned goods is carrying the doctrine far beyond any reported case. Beer and nails do not belong to the same class of merchandise because both are sold in kegs." [18]

In a recent case in which the complainant's mark was applied to baking soda and saleratus, and the defendant's to baking powder, Judge Baker held the parties' goods to be in the same class because they were handled generally by the same class of dealers and purchased by the same class of customers; either is indifferently used to accomplish the same object; so that they come in direct competition with each

17—Omega Oil Co. v. Weschler, 71 N. Y. Supp. 983, 984.

18—George v. Smith, 52 Fed. Rep. 830-832. The unfair competition of the defendant must involve the same class of goods as those of the plaintiff. Basket Stores v. Allen (Neb.), 155 N. W. Rep. 893.

other in sale and use. In that case the rule is announced that "goods are in the same class whenever the use of a given trademark or symbol on both would enable an unscrupulous dealer readily to palm off on the unsuspecting purchaser the goods of the infringer as the goods made by the owner of the trademark, or with his authority and consent."[19]

In the application of the rule, it has been held that the use of a red triangle on lager beer did not infringe the same device used as a trademark for ale.[20]

It has been held in the patent office that suspenders and hose-supporters are not goods of the same descriptive properties.[20a]

§ 130. The value of proof of fraudulent intent.—So much is said of fraudulent intent in the decisions that it is proper to discuss it in this place, in its relation to infringement. As we have seen, equity will restrain the use of the infringing mark without regard to the intent of the defendant. It is, however, a matter of practical importance to establish the deliberate fraud of the defendant where it exists. It was distinctly held by Lord Westbury that an account would only be given with the injunction in respect of any user by a defendant after he had become aware of the prior ownership;[21] and in another case, where defendant claimed to have bought counterfeit champagne believing it to be genuine, an accounting was denied because of the absence of proof of guilty knowledge.[22] And the fraudulent intention of the defendant must be shown in an action at law,[23] or at least to support the recovery of punitive damages.[24] But the rule is fixed both in England and the United States that proof of

19—Church & Dwight Co. v. Russ, 99 Fed. Rep. 276-280.

20—Bass v. Henry Zeltner Brew. Co., 37 C. C. A. 355; 95 Fed. Rep. 1006; affirming Bass v. Henry Zeltner Brew. Co., 87 Fed. Rep. 468.

20a—Frank v. Macwilliam, 117 Off. Gaz. 1165.

21—Edelsten v. Edelsten, 1 DeG. J. & S. 185. For the American rule, see DeVoe Snuff Co. v. Wolff, 124 C. C. A. 302; 206 Fed. Rep. 420, 424.

22—Moet v. Couston, 33 Beav. 578. See also Rose v. Loftus, 47 L. J. Ch. 576; Millington v. Fox, 3 Mylne & Cr. 338, Weed v. Peterson, 12 Abb. Pr. N. S. 178.

23—Edelsten v. Edelsten, *supra*.

24—Fuber v. D'Utassey, 11 Abb. Pr. N. S. 399; Marsh v. Billings, 7 Cush. 322; Cox, 118.

fraudulent intent, or actual deception of the public, are alike unnecessary in actions in equity, in technical trademark cases; nor is it necessary in cases of trademark infringement or unfair competition to prove actual deception of purchasers where there is shown "a manifest liability to deception."[25]

§ 131. The manner of establishing fraudulent intent.—The inspection of the two marks in controversy is the main test of the alleged resemblance,[26] although the testimony of expert witnesses familiar with the trade and the habits of customers is of weight.[27] So, for example, where the plaintiff's mark was a tin star, and the defendant's a tin buzz-saw, both affixed in use upon plug tobacco, the court could have small difficulty in inferring fraudulent intent.[28] Among other matters considered by the courts as probative of the defendant's intent are false representations of securing awards at an exhibition;[29] the fact that defendant, who adopted as a mark for his factory the words "Norfolk House," previously used by plaintiff, kept the publication of that name out of a city directory;[30] and the circumstance that defendant removed his

25—Fuller v. Huff, 43 C. C. A. 453; 104 Fed. Rep. 141. "Thus the inquiry naturally arises: Did appellees' conduct in disposing of the machinery manufactured by it tend to or have the effect of passing the same to purchasers as the machinery manufactured by appellant? In order that this result be accomplished, it was not necessary that appellees or either of them actually take some affirmative action in this respect, or that they or either of them so intended, as actual deception was not necessary. If the name under which appellees disposed of their machinery, together with the method of disposing of the same, was manifestly liable to deceive purchasers, the result would be accomplished. Northwestern Knitting Co. v. Garon, 112 Minn. 321; 128 N. W. Rep. 290; Fuller v. Huff, 104 Fed. 141; 43 C. C. A. 453; 51 L. R. A. 332." Deister Concentrator Co. v. Deister Mach. Co. (Ind. App.), 112 N. E. Rep. 909. See also, to the same effect, Manitowoc Malting Co. v. Milwaukee Malting Co., 119 Wis. 543; 97 N. W. Rep. 389.

26—Drummond v. Tinsley, 52 Mo. App. 10; Liggett & Myers Tob. Co. v. Finzer, 128 U. S. 182-184; 32 L. Ed. 395; Weyman v. Soderberg, 108 Fed. Rep. 63-65.

27—Drummond v. Tinsley, *supra*.

28—Liggett & Myers Tob. Co. v. Sam Reid Tob. Co., 104 Mo. 53.

29—Cave v. Myers, Seton (4th Ed.), 238; Seb. 304.

30—Rodgers v. Rodgers, 31 L. T. N. S. 285; Seb. 442.

place of business into the same locality as the plaintiff,[31] or is dealing in other fraudulent goods.[32]

The use and circulation of removal notices, "so closely similar as to be a deceptive imitation (of plaintiff's stationery), and * * * so ambiguous in phrasing as to lead the unwary to believe that reference was made to the plaintiff, and not to the defendant, is unfair competition."[32a]

The use by a defendant of the words "sole agent," may be considered as an evidence of fraud, where no agency exists, and there is similarity of dress.[33]

A curious instance of facts regarded as indicia of fraud is to be found in a case where a plaintiff whose name, originally "Dr. J. W. Trust," had been changed to "Dr. T. F. Gouraud," was the manufacturer of a cosmetic styled "Gouraud's Oriental Cream," and the defendants, his sons, who had retained the name Trust, engaged in the sale of a cosmetic which they named "Creme Orientale, by Dr. T. F. Gouraud's Sons;" the court holding from these facts that the statement of the relationship, though truthful, was made with fraudulent intent.[34] The use on defendant's label of fictitious medals of award has been treated as evidence of fraudulent intent.[35]

As most of these badges of fraud have been referred to by the courts because of their determining influence in cases of unfair competition, we will consider them at length in that

31—Elgin Nat. Watch Co. v. Illinois Watch Case Co., 89 Fed. Rep. 487, 488; reversed on other grounds, 35 C. C. A. 237; 94 Fed. Rep. 667; Fullwood v. Fullwood, (1), W. N. 1873, p. 93; W. N. 1873, p. 185; Seb. 42. See also to same effect, Lee v. Haley, 21 L. T. N. S. 546; 18 W. R. 181; L. R. 5 Ch. D. 155; 39 L. J. Ch. 284; 22 L. T. N. S. 251; 18 W. R. 242; Viano v. Baccigalupo, 183 Mass. 160; 67 N. E. Rep. 641; Church v. Kresner, 49 N. Y. Sup. 742; International Society v. International Society, 59 N. Y. Supp. 785.

32—Chas. E. Hires Co. v. Consumers' Co., 100 Fed. Rep. 809-812; 41 C. C. A. 71.

32a—Blanchard, J., in United States Frame & Picture Co. v. Horowitz, 100 N. Y. Supp. 705. Citing and following DeYoungs v. Jung, 27 N. Y. Supp. 370; 7 Misc. Rep. 56; Johnson v. Hitchcock, 3 N. Y. Supp. 680.

33—National Water Co. v. Hertz, 177 Fed. Rep. 607.

34—Gouraud v. Trust, 3 Hun, 627; Seb. 460.

35—Bolen & Byrne Mfg. Co. v. Jonasch, 60 N. Y. Sup. 555.

connection. Those we have mentioned are illustrative, however, of the class of facts pertinent to be shown in cases of technical trademark infringement, and to prove which is important for the reasons and purposes above referred to.

§ 132. Infringing by refilling trademarked packages.—There is no doubt that one who furnishes liquors (or any other class of goods) with the expressed purpose that the goods so sold are to be used in refilling genuine packages whose original contents have been removed will be dealt with as an infringer and enjoined in equity.[36] The refilling of genuine packages will be restrained,[37] even where the package, a bottle bearing a name blown in the glass, is used for a similar article, in connection with a label not resembling that borne by it originally.[38] Injunction will issue even where the refilling was done at the request of a customer.[39] Judge Thayer has enjoined a defendant from offering for sale an imitation of Hostetter's Bitters in bulk with advice to customers to refill bottles originally containing the genuine compound, with the spurious article.[40] In this class of cases "the

36—Hostetter Co. v. Brueggeman-Reinart Distilling Co. 46 Fed. Rep. 188; Cox, Manual, 729; Hostetter Co. v. Wm. Schneider Co., 107 Fed. Rep. 705; Hostetter Co. v. Conron, 111 Fed. Rep. 737; Samuel Bros. & Co. v. Hostetter Co., 55 C. C. A. 111; 118 Fed. Rep. 257; Hostetter Co. v. Gallagher Stores, 142 Fed. Rep. 208. Compare Hostetter v. Fries, 17 Fed. Rep. 620, in which defendants compounded a substance to be used in making Hostetter's Bitters, and sold it with directions for so using it, but injunction was denied. This decision is entitled to no weight.

37—Evans v. Von Laer, 32 Fed. Rep. 153; Sawyer Crystal Blue Co. v. Hubbard, 32 Fed. Rep. 388; Rose v. Henley, cited at 47 L. J. Ch. 577; 38 L. T. N. S. 410; Seb. 551; Van Hoboken v. Mohns & Kaltenbach, 112 Fed. Rep. 528; Pontefact v. Isenberger, 106 Fed. Rep. 499; Hiram Ricker & Sons v. Leigh, 77 N. Y. Supp. 540; Eckhart v. Consolidated Milling Co., 72 Ill. App. 70; Scott v. Standard Oil Co., 106 Ala. 475.

38—Evans v. Von Laer, 32 Fed. Rep. 153; Hostetter v. Anderson, 1 V. R. (W. A'B. & W.) Eq. 7; 1 Anst. Jour. 4; Seb. 652; Rose v. Loftus, 47 L. J. Ch. 576; 38 L. T. N. S. 409; Seb. 608. See *contra*, Welch v. Knott, 4 K. & J. 747; 4 Jur. N. S. 330; Seb. 157.

39—Barnett v. Leuchars, 13 L. T. N. S. 495; 14 W. R. 166; Seb. 253.

40—Hostetter v. Brueggeman-Reinart Co., 46 Fed. Rep. 188; Cox, Manual, 729; cited and followed in Hostetter v. Sommers, 84 Fed. Rep. 333. These cases overrule Hostet-

burden is strongly upon the complainant to prove fraud by a fair preponderance of evidence."[41]

The injunction will not be denied because of the defendant covering the trademarks of the original container with a paper label.[42]

The burden is upon the defendant who has undertaken to refill the plaintiff's trademarked containers to "completely and permanently obliterate and remove" the trademark from the container.[43]

§ 133. Packages distinguished from their contents.—Where articles are sold to the consumer only in packages of course the marks upon the packages strike the eye of the consumer before those on the articles, and this fact may often be of controlling importance in cases of unfair competition.[44] Thus, Judge Richards has said, in a case of this character "it does not appear that the defendant attempted to deceive the public by palming off its matches as those of the complainant. There was no simulation of packages. The packages plainly indicate their origin, and, since matches are always sold in packages, the ordinary purchaser could not well be deceived."[45] Where there is simulation of the package relief

ter v. Fries, 17 Fed. Rep. 620, where Judge Wallace refused to enjoin defendants who prepared and sold an extract, giving instructions to their customers for making "Hostetter's Bitters" from the extract. The rule stated in the text is followed in Myers v. Theller, 38 Fed. Rep. 607-609; Hostetter Co. v. Martinoni, 110 Fed. Rep. 524.

41—Coxe, J., in Hostetter Co. v. Comerford, 97 Fed. Rep. 585; and to the same effect see Hostetter Co. v. Bower, 74 Fed. Rep. 235.

42—Prest-O-Lite Co. v. Avery Lighting Co., 161 Fed. Rep. 648, 651.

43—Prest-O-Lite Co. v. Heiden, 135 C. C. A. 515, 517; 219 Fed. Rep. 845, 847; Searchlight Gas Co. v. Prest-O-Lite Co., 131 C. C. A. 626; 215 Fed. Rep. 692, 696; Prest-O-Lite Co. v. Davis, 131 C. C. A. 491; 215 Fed. Rep. 349, 350; Prest-O-Lite Co. v. Avery Lighting Co., 161 Fed. Rep. 648, 650, 652; Prest-O-Lite Co. v. Davis, 209 Fed. Rep. 917, 922, 924; Prest-O-Lite Co. v. Bogen, 209 Fed. Rep. 915, 916; Prest-O-Lite Co. v. Post & Lester Co., 163 Fed Rep. 63, 64.

44—Heide v. Wallace & Co., 129 Fed. Rep. 649, 650 (where liquorice pastilles were sold in boxes); Knickerbocker Chocolate Co. v. Griffing, 144 Fed. Rep. 316 (where chocolate confections were so sold).

45—Diamond Match Co. v. Saginaw Match Co., 74 C. C. A. 59; 142 Fed. Rep. 726, 730.

will be granted even though the contents are unobjectionable.[46]

§ 134. Infringement by refitting and reselling worn trademarked articles.[47]—Akin to refilling trademarked packages are cases where, parts of a trademarked article having worn out in service, the parts are replaced and the article sold without removing the trademark, and where this replacement of parts is made by the owner of the trademark, identity being substantially retained, no fraud, is effected. Otherwise, if the replacement is made by a stranger.[48] The Massachusetts court has refused to enjoin the manufacture of stove castings used to replace worn parts of a plaintiff's trademarked stoves.[49]

Where parts are sold merely for replacement and repair, there is no duty on the part of the manufacturer to so distinguish the parts, by marking or advertising, as to clearly indicate the manufacturer. Thus, relief by injunction has been refused where the defendant failed to so mark repair parts,[50] and has been refused where they were advertised by catalogue and label as being of the defendant's make.[51] So an injunction was refused as against a manufacturer selling ink and paper for use on the Neostyle machine, though the court suggested that the defendants put their names on their future product.[52]

§ 135. Infringement by applying a manufacturer's trademark to goods of his to which he does not intend its application. —In *Hennessy v. White*, the defendants bottled brandy, purchased in casks from plaintiffs, and applied to such bottling a label which was a colorable imitation of that used by plain-

46—Bates Mfg. Co. v. Bates Mach. Co., 141 Fed. Rep. 213.

47—Compare § 152, *post*.

48—General Electric Co. v. Re-New Lamp Co., 128 Fed. Rep. 154; General Electric Co. v. Re-New Lamp Co., 121 Fed. Rep. 164.

49—Magee Furnace Co. v. LeBarron, 127 Mass. 115.

50—Bender v. Enterprise Mfg. Co., 84 C. C. A. 353; 156 Fed. Rep. 641, reversing Enterprise Mfg. Co. v. Bender, 148 Fed. Rep. 313; Columbian Eng. Works v. Mallory, 75 Or. 542; 147 Pac. Rep. 542.

51—Deering Harvester Co. v. Whitman, 33 C. C. A. 558; 91 Fed. Rep. 376.

52—Neostyle Mfg. Co. v. Ellam's Duplicator Co., 21 R. P. C. 185.

tiffs to designate a higher grade of brandy sold by them in bottles only. The court, by Molesworth, J., said: "I think a new feature which has not been present in any other case, and is, therefore, not touched by the language of the other cases, is one which I ought to act upon here; that is, that the makers of articles of different qualities are entitled to brand their best article in a particular way to show the superior value they put upon it." Stowell, C. J., in the same case, in the Victoria Supreme Court, states the rule more broadly: "If a brandy different from that which the manufacturer bottled is put into bottles and sold as the manufacturer's bottled brandy, the fact that it is the manufacturer's bulk brandy does not make the sale less an imposition."[53] There can be no doubt of the right of the manufacturer or selector to designate goods of a certain grade bottled or packed by him by a distinctive trademark, and that no one purchasing goods in bulk from him can thereby acquire the right to pack or bottle such goods under the trademark of the vendor used only upon his packing or bottling. Whether the bulk goods are better than or inferior to the trademarked goods is utterly immaterial except as bearing upon the question of damages.[54]

"It is manifest that the sale of merchandise in bulk by a manufacturer does not justify the vendee in using on his retail packages the label which the manufacturer uses upon the same merchandise only when prepared by himself on smaller packages for the retail trade,"[55] but he is at liberty to so mark them as to truthfully indicate the manufacturer.[56] Where bulk goods were sold without limitation as to the manner in which they were to be re-sold, the effect of the sale was held to be "to invest the defendants (vendees) with the

53—Hennessy v. White, 6 W. W. & A'B. Eq. 216-221; Seb. 650. See also to same effect Hennessy v. Hogan, 6 W. W. & A'B. Eq. 225; Seb. 651; Krauss v. Jos. R. Peebles' Sons Co., 58 Fed. Rep. 585.

54—See the case in which a person purchasing pens from a manufacturer removed the labels and substituted others marked with a numeral indicating another grade of pen made by the same manufacturer. Gillott v. Kettle, 3 Duer, 624; Cox, 148.

55—Taft, J., in Krauss v. Jos. R. Peebles' Sons Co., 58 Fed. Rep. 585-592.

56—Russia Cement Co. v. Katzenstein, 109 Fed. Rep. 314.

title to the article, and with the right to divide it into small packages, as (they) might see fit, and sell the same as originating from the plaintiff, according to the fact."[57]

In accordance with the general doctrine of this section, a bill disclosed that the complainant was the manufacturer of two preparations used for making root-beer—one a syrup, the other, an extract. The defendant bought the extract and made a beverage from it by the addition of simple syrup and carbonated water, and sold it under the complainant's name, "Hires Root Beer," from which he was enjoined.[58]

In England Lord Justice Phillimore has recognized this rule, saying, "this is a passing-off which is actionable; not the usual passing-off when a man sells his own goods representing them to be those of another trader, but a more subtle and possibly a more injurious passing-off, when a man sells the second-class goods of a trader representing them as the first-class goods of that trader."[59]

§ 136. Substitution.—By "substitution," as used here, is meant the substitution by a retail merchant of goods other than those called for by a purchaser. In its narrower sense it is confined to the retail merchant who commits the offense. In its broader sense it includes the manufacturer of the substituted goods in cases where he has so prepared the goods as to make the substitution possible, and for the purpose and with the intent that they may be substituted.[60] Of such manufacturers the Supreme Court of New York, by Barrett, J., said: "The law of trademarks has been gradually expanding so as to meet just such cases. The courts, in a long and unbroken line of decisions, have endeavored to uphold and enforce commercial morality, and have afforded their protection to honest enterprise and skill."[61] As to the retailer who

57—Wheeler, J., in Russian Cement Co. v. Frauenhar, 126 Fed. Rep. 228; affirmed, Russia Cement Co. v. Frauenhar, 66 C. C. A. 500; 133 Fed. Rep. 518.

58—Chas. E. Hires Co. v. Xepapas, 180 Fed. Rep. 952.

59—A. G. Spalding & Bros. v. Gamage, Ltd., 31 R. P. C. 125, 139.

60—Enoch Morgan's Sons Co. v. Wendover, 43 Fed. Rep. 420.

61—Morgan Sons Co. v. Troxell, Cox, Manual, 674. The New York Court of Appeals, treating this case as purely a technical trademark case, reversed it in 89 N. Y. 292. If there had been considered by the appellate court the doctrines

performs the actual substitution, there is no question that he will invariably be enjoined from repetitions of his offense.[62]

The law as to substitution is admirably embraced in the language of Judge Lacombe: "A court of equity will not allow a man to palm off his goods as those of another, whether his misrepresentations are made by word of mouth, or more subtly, by simulating the collocations of details of appearance by which the consuming public has come to recognize the product of his competitor."[63]

The sale of an imitation article without misrepresentation will not be enjoined. Where the article was a bitters made in imitation of Hostetter's Bitters, but the defendant had sold the goods without any misrepresentation of their identity and without suggesting their adaptibility for substitution, injunctive relief was refused.[64]

False oral representation that defendant's goods are those of the complainant will be enjoined,[65] though where the defendant's affidavits contradict those of the plaintiff concerning such representations preliminary injunction will be denied,[66] and the proof must be clear on final hearing to entitle plaintiff to the relief sought.[67]

The substitution of cigars, in boxes of a manufacturer bearing his trademark, entitles him to the recovery of punitive damages in an action at law, though no actual damages are proven.[68]

we have now under discussion, the decision of the lower court would have been affirmed. Taendsticksfabriks Aktiebolaget Vulcan v. Myers, 11 N. Y. Sup. 663; Avery v. Meikle, 81 Ky. 75; Cox, Manual, 686, and cases cited elsewhere in this chapter.

62—Saxlehner v. Eisner & Mendelson Co., 88 Fed. Rep. 61-70; Munro v. Smith, 13 N. Y. Sup. 708; N. K. Fairbank Co. v. Dunn, 126 Fed. Rep. 227; Barnes v. Pierce, 164 Fed. Rep. 213.

63—Enterprise Mfg. Co. v. Landers, Frary & Clark, 65 C. C. A. 587; 131 Fed. Rep. 40, 41; affirming 121 Fed. Rep. 923, and to the same effect see Edison Mfg. Co. v. Gladstone, — N. J. Eq. —; 58 Atl. Rep. 391, not officially reported.

64—Hostetter Co. v. Van Vorst, 62 Fed. Rep. 600.

65—Weber Medical Tea Co. v. Kirchstein, 101 Fed. Rep. 580.

66—Lavanburg v. Pfeiffer, 52 N. Y. Supp. 801.

67—Lavanburg v. Pfeiffer, 66 N. Y. Supp. 39.

68—Lampert v. Judge & Dolph Drug Co., 238 Mo. 409; 141 S. W. Rep. 1095; reversing Lampert v. Judge & Dolph Drug Co., 119 Mo. App. 693, 699; 100 S. W. Rep. 659.

§ 137. The use of misleading signs and circulars.—The use of misleading business signs will be restrained in equity, whether or not such signs are fixed before a particular place of business, or are distributed through the trade. The general rule has been thus stated by the Chancellor of Upper Canada in a case involving the use of signs bearing words "The Golden Lion" used upon a dry goods establishment: "Where it is clear to the court that the defendant himself intended an advantage by the use of a particular sign or mark in use by another, and believes he has obtained it, or, in other words, that the defendant himself thought the use of it was calculated to advertise him at the expense of the plaintiff, and this was his object in using it, and where such has been the effect of the user, I think the court should say to him 'Remove that sign: its use by you may, as you intend, damage the plaintiff. It can not be necessary or valuable to you for any other purpose. You have your choice of many signs which, as a mere attraction, or to give your store a marked designation, must answer a fair business purpose equally well.'"[69]

It will be noted that in the foregoing case the deception employed consisted in duplicating the tradename in which the plaintiff's business was conducted. The same principle has been applied by a New York court in granting equitable protection to a flag design used in newspaper advertising by a real estate auctioneer. The advertising device which was employed was the representation of a flag having an ornamentation of stars, fancifully arranged along its upper and lower edges. The defendant duplicated this device in his newspaper advertising matter, and there was testimony tending to show that persons had actually been deceived into believing that defendant's advertising was that of the plaintiff.[70]

In the latter case, therefore, the signs were not used upon a place of business. In a Missouri case, equitable relief was granted to a brewing company in the use of white muslin signs of peculiar size and lettering which had been distributed both by the plaintiff and the defendant brewing com-

69—Walker v. Alley, 13 Grant Up. Can. Ch. 366.

70—Johnson v. Hitchcock, 3 N. Y. Supp. 680.

panies to the retail trade throughout the city of St. Louis. The decree in the lower court was for the plaintiff. The St. Louis Court of Appeals, in reversing the decree and directing the injunction for the plaintiff, said: "The correct decision of the case at bar depends upon the finding of two propositions: was the imitation of the plaintiff's signs by defendant merely the result of an accident; or was it the result of a preconceived design to mislead the public into the belief that the plaintiff's beer was being sold at the defendant's place of business? Was the imitation of the sign close enough to bring about such a deception?"[71]

The more usual cases are those of signs bearing similar tradenames exhibited on competing stores in the same vicinity, in which the sign of the later comer is enjoined if calculated to mislead the public into the false belief that they are patronizing the older establishment.[72]

Circulars.—The usual remedy by injunction against unfair competition will be granted where a competitor issues circulars calculated to deceive customers into the false belief that the goods of the parties are identical.[73] The relief has been granted where the defendant's circulars were sent to the plaintiff's customers and recited that defendant had theretofore distributed the goods, and that the defendant's manufacturing was done in part at the plaintiff's street address.[74]

Similarly, the use of display signs calculated to deceive the public into patronizing one competitor in the belief that they are patronizing the other, will be enjoined,[75] as will the publication of circulars calculated to induce the false belief that a book published by complainant was fraudulent.[76]

71—American Brewing Co. v. St. Louis Brewing Co., 47 Mo. App. 14, 20.

72—Miskell v. Prokop, 58 Nebr. 628; 79 N. W. Rep. 552; Nolan Bros. Shoe Co. v. Nolan, 131 Calif. 271; 63 Pac. Rep. 480; Ricard v. Caton College Co. (Minn.), 92 N. W. Rep. 958.

73—Brown v. Braunstein, 83 N. Y. Supp. 1096; Van Stan's Stratena Co. v. Van Stan, 209 Pa. 564; 58 Atl. Rep. 1064. For a form of injunction in such a case see Bunker v. Kenna, Price & Stewart 883.

74—American Novelty & Mfg. Co. v. Manufacturing Electrical Novelty Co., 73 N. Y. Supp. 755.

75—Cady v. Schultz, 19 R. I. 193; 32 Atl. Rep. 915; Duke v. Cleaver, 19 Tex. Civ. App. 218; 46 S. W. Rep. 1128.

76—Halstead v. Houston, 111 Fed. Rep. 376.

Relief by preliminary injunction has been denied where defendant resold machines of plaintiff's manufacture, advertising them as "cheap" machines.[77]

§ 138. Infringement by a non-identical word or mark.— The general rule is that there may be infringement even in the absence of exact similarity between the marks.[78]

In 1866 Lord Cranworth said in a leading case: "If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market may be as much a violation of the rights of that rival as the actual copy of his device."[79] This dictum was elicited in a case where the plaintiff sold wines in casks stamped with the device of a crown and an eagle, and the initials "B. S." on the head of the cask, and a crown, the word "Seixo" and a date at the bung hole, from which the wine had acquired the name "Crown Seixo;" while the defendants sold wine in casks stamped on the head and at the bung hole with the device of a crown, the initials "C. B.," the words "Seixo

77—Oliver Typewriter Co. v. American Writing Mach. Co., 156 Fed. Rep. 177.

78—Liggett & Myer Tobacco Co. v. Hynes, 20 Fed. Rep. 883. "What degree of resemblance is necessary is, from the nature of things, a matter incapable of definition *a priori*. All that courts of justice can do is to say that no trader can adopt a trademark so resembling that of a rival as that ordinary purchasers, purchasing with ordinary caution, are likely to be misled." Lord Cranworth in Seixo v. Provezende, L. R. 1 Ch. D. 192.

79—Seixo v. Provezende, *supra*; 12 Jur. N. S. 215; 14 L. T. N. S. 314; 14 W. R. 357; Seb. 256.

The doctrine of the leading case applies to all cases where the goods of a particular dealer or manufacturer have become known by a name derived from his trademark. Anglo-Swiss Condensed Milk Co. v. Metcalf, L. R. 31 Ch. D. 454; 55 L. J. Ch. 463; 34 W. R. 345; 3 R. P. C. 28; Cartmell, 48; *In re* Speer's Trademark, 4 R. P. C. 521; 55 L. T. N. S. 880; Cartmell, 317; *In re* Baschiera's Trademark, 33 S. J. 469; *In re* La Société Anonyme des Verreries de l'Estoile, 10 R. P. C. 436; L. R. (1894) 1 Ch. D. 61; 11 R. P. C. 142; Wilkinson v. Griffith, 8 R. P. C. 370; Cartmell, 344; Morgan Envelope Co. v. Walton, 82 Fed. Rep. 469; 81 Off. Gaz. 1615; Johnson & Johnson v. Bauer & Black, 27 C. C. A. 374; 82 Fed. Rep. 662; Kann v. Diamond Steel Co., 89 Fed. Rep. 706.

de Cima," and figures "1861." The defendants were enjoined notwithstanding the fact that the marks were not similar.

Nick-names.—Where a commercial article has, fortuitously or otherwise, acquired a nick-name by which it is known and called for, that nick-name will be protected in equity. Notwithstanding its proper designation, "still if for some reason the general public has given to the product another and different name, by which it alone is known to the trade, the appellant (plaintiff) becomes entitled to protection by injunction against one who thereafter endeavors through the adoption of such term as the public employs as synonymous for or as a secondary designation of such product."[80] The thing suggesting the nick-name need not be identical with plaintiff's mark.

Under this rule, plaintiffs who made a certain beer to which they applied the device of a bull-dog's head were granted an injunction against the use by competing dealers of a label similar in shape to the plaintiff's and bearing a terrier's head. There was no resemblance between the labels beyond the similarity in shape, but the plaintiffs' beer had come to be known as "Dog's Head Beer," and the use of a dog's head upon similar merchandise by the defendants was manifestly for the purpose of passing off their beer as being the plaintiffs'.[81] It is self-evident that a trademark may be infringed by a mark entirely different, but suggesting to customers and the public the same word or idea. Thus when an English house had used in India a trademark for yarn which had led the natives to call for it as "Bhe Hathi" (meaning "Two Elephant") yarn, a competing firm was enjoined from exporting yarn to India under a trademark of which the principal feature was the representation of two elephants.[82] On the same reasoning the word "Sportsman's" accompanied by a picture of two mounted huntsmen, used as a trademark for cherry brandy, was held to be infringed by the picture of a huntsman standing beside his horse, and the words "Hunts-

80—Carland, J., in Denver Chem. Co. v. Lilley, 133 C. C. A. 73; 216 Fed. Rep. 869.

81—Read v. Richardson, 45 L. T. N. S. 54; Cox, Manual, No. 698.

82—Orr-Ewing & Co. v. Johnston & Co., 40 L. T. N. S. 307; Seb. 646.

man's Cherry Brandy," where the proof *aliunde* showed that the plaintiffs' liquor had become known to the public as "The Hunter's Cherry Brandy."[83]

Judge Sanborn has well said that "every suit of this character is founded on the fact that the action, or the proposed action, of the defendant has deceived, or is calculated to deceive, ordinary purchasers buying with usual care, so that they have purchased, or will probably purchase, the goods of the defendant under the mistaken belief that they are those of the complainant."[84] So that each case must turn upon the peculiar facts involved. Thus where a plaintiff had for some time manufactured tennis racquets uniformly stamped at a particular place upon the handle with the words "The Demon," and the defendant began to manufacture and sell racquets of a similar design, stamped, in the corresponding place upon the handle, with the word "Demotic," the use of the word "Demotic" was restrained.[85] So the word "Curative," applied to soap, has been held to infringe the word "Cuticura," similarly applied;[86] and a red Greek cross has been held to be infringed by a maltese cross with a red center, each being used as a mark upon medicinal plasters.[87]

83—*In re* Barker's Trademark, 53 L. T. N. S. 23; Cartmell, 72. Similar cases are Barlow v. Johnson, 7 R. P. C. 395; Cartmell, 73; Upper Assam Tea Co. v. Herbert, 7 R. P. C. 183; Cartmell, 333; *In re* Worthington's Trademark, L. R. 14 Ch. D. 8; 49 L. J. Ch. 646; 42 L. T. N. S. 563; 28 W. R. 747; Cartmell, 351; Jerome v. Johnson, 59 N. Y. Supp. 859.

84—Kann v. Diamond Steel Co., 89 Fed. Rep. 706.

85—Slazenger v. Feltham, 6 R. P. C. 531; Cartmell, 310. Thus where an anchor had been registered in England as an umbrella trademark, the word "Ancross" for umbrellas was refused registration. *In re* Thewlis & Blakey's Trademark, 10 R. P. C. 369.

86—Potter Drug & Chemical Corp. v. Miller, 75 Fed. Rep. 656.

87—Johnson & Johnson v. Bauer & Black, 27 C. C. A. 374; 82 Fed. Rep. 662; reversing same case, 79 Fed. Rep. 954. In the opinion Judge Jenkins said: "It sufficiently appeared by the testimony that the goods of the appellant have come to be known, and are offered, ordered and sold, as 'Red Cross Plasters;' and we can not but think that the maltese cross adopted by the appellee, in so far as it contains a red circle, has a tendency to promote confusion, and will interfere with the legitimate trade of the appellant. * * * The red cross speaks to the eye, and the article being known by that designation speaks also to the ear by that name."

The degree of resemblance between pictorial marks necessary to establish infringement is illustrated by a case in which the picture of a rooster standing on the body of his dead adversary was held to infringe a representation of a chicken cock standing under the branch of an olive tree.[88]

Other instances in which the courts have declared a word or words used as a trademark to be infringed by a different word or words will be found instructive. For the convenience of the reader they are tabulated in alphabetical order.

The Trademark or Tradename.	*Held to be infringed by.*
"Abacus."	"Arcade."[89]
"Alba."	"Antique."[90]
"American Girl."	"American Lady."[91]
"Anvil."	"Anchor."[92]
"Apollinaris."	"Apollinis."[93]
"Auto."	"Auto-Noisette."[94]
"Beaded."	"Nu-B-Ded."[95]
"Black Diamond."	"Diamond Gem."[96]
"Bovilene."	"Bovina."[97]
"Burgess."	"Burgiss."[98]
"Canadian Club Whiskey."	"Canadian Rye Whiskey."[99]
"Cascarets."	"Cascara."[1]

88—Cusimano & Co. v. Olive Oil Imp. Co., 38 So. Rep. 200; 114 La. 312.

89—Kenffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

90—*Ibid.*

91—Wolf Bros. & Co. v. Hamilton-Brown Shoe Co., 165 Fed. Rep. 413; 91 C. C. A. 363; Hamilton-Brown Shoe Co. v. Wolf Bros. & Co., 240 U. S. 251; 60 L. Ed. —.

92—Kenffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

93—Apollinaris Co. v. Herrfeldt, 4 P. R. 478; Apollinaris Brunnen v. Somborn, 14 Blatchf. 380; Fed. Case No. 496.

94—Walter Baker & Co. v. Delapenha, 160 Fed. Rep. 746.

95—United Lace & Braid Mfg. Co. v. Barthels Mfg. Co., 221 Fed. Rep. 456, 462.

96—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

97—Lockwood v. Bostwick, 2 Daly, 521.

98—Burgess v. Hills, 26 Beavan, 244.

99—Walker v. Mikolas, 79 Fed. Rep. 955; Hiram Walker & Sons v. Hockstaeder, 85 Fed. Rep. 776.

1—Sterling Remedy Co. v. Gorey, 110 Fed. Rep. 372.

The Trademark or Tradename.	*Held to be infringed by.*
"Cascarets."	"Castorets." [2]
"Cashmere Bouquet."	"Violets of Cashmere." [3]
"Celluloid."	"Cellonite." [4]
"Ceresota."	"Certosa." [5]
"Ceresota."	"Cressota." [6]
"Chartreuse."	"Chasseurs." [7]
"Chatterbox."	"Chatterbook." [8]
"Clark's O. N. T."	"Clark's N. E. W." [9]
"Cocoaine."	"Cocoine." [10]
"Cocoatina."	"Cocaotine." [11]
"Coe's Superphosphate of Lime."	"Andrew Coe's Superphosphate of Lime." [12]
"Corona."	"Corinth." [13]
"Cottolene."	"Cottoleo." [14]
"Cottolene."	"Chefolene." [15]
"Creamalt."	"Crown Malt." [16]
"Cupola."	"Composite." [17]
"Cyclops Machine Works."	"Cyclops Iron Works." [18]
"Demon."	"Demotic." [19]

2—Sterling Remedy Co. v. Spermine Remedy Co., 50 C. C. A. 657; 112 Fed. Rep. 1000.

3—Colgate v. Adams, 88 Fed. Rep. 899.

4—Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94.

5—Northwestern Consol. Mill Co. v. Wm. Callahan & Son, 177 Fed. Rep. 786.

6—Northwestern Consl. Mill Co. v. Mauser & Cressman, 162 Fed. Rep. 1004.

7—A. Bauer Co. v. Order of Carthusian Monks, 56 C. C. A. 484; 120 Fed. Rep. 78, 80.

8—Estes v. Leslie, 29 Fed. Rep. 91.

9—Clark Thread Co. v. Armitage, 21 C. C. A. 178; 74 Fed. Rep. 936; affirming Clark Thread Co. v. Armitage, 67 Fed. Rep. 896.

10—Burnett v. Phalon, 9 Bos. 192.

11—Schweitzer v. Atkins, 37 L. J. Ch. 847.

12—Coe v. Bradley, Fed. Case No. 2941; 9 Off. Gaz. 541.

13—Kenffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

14—N. K. Fairbank Co. v. Central Lard Co., 64 Fed. Rep. 133.

15—N. K. Fairbank Co. v. Ogden Packing Co., 220 Fed. Rep. 1002.

16—George G. Fox Co. v. Glynn, 191 Mass. 344; 78 N. E. Rep. 89.

17—Kenffel & Esser Co. v. H. S. Crocker Co., *supra*.

18—Hainque v. Cyclops Iron Works, 136 Calif. 35; 68 Pac. Rep. 1014.

19—Slazenger v. Feltham, 6 R. P. C. 531.

The Trademark or Tradename.	*Held to be infringed by.*
"Doric."	"Delos."[20]
"Derby."	"Derwent."[21]
"Dr. Williams' Pink Pills for Pale People."	"Dr. Wilson's Pink Pills for Anaemic People."[22]
"Duplex."	"Deluxe."[23]
"Economy."	"Economic."[24]
"Egyptian Deities."	"Egyptian Amasis."[25]
"Elastic Seam."	"Stretchiseam."[26]
"El Destino."	"El Divino" and "El Destinacion."[27]
"Electro-Silicon."	"Electric-Silicon."[28]
"Every Day."	"Everybody."[29]
"Excelsior."	"Excellent."[30]
"Flor de Margaretta."	"Margarita."[31]
"Genuine Durham Smoking Tobacco," with the picture of a bull.	"The Durham Smoking Tobacco," with the picture of a bull's head.[32]
"German."	"Germania."[33]
"German Household Dyes."	"Excellent German Household Dyes."[34]
"Germea."	"Germ."[35]

20—Kenffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

21—Derby Dry Plate Co. v. Pollard, 2 Times L. R. 276.

22—Dr. Williams Med. Co. v. Tothill, Cape Good Hope, 20 S. C. R. 483; Dr. Williams Med. Co. v. Alexander, Cape Good Hope, 27 S. C. R. 589.

23—Kenffel & Esser Co. v. H. S. Crocker Co., *supra.*

24—*Ibid.*

25—Anargyros v. Egyptian Amasis Cigarette Co., 66 N. Y. Supp. 626.

26—J. A. Scriven Co. v. Girard Co., 140 Fed. Rep. 794.

27—Pinto v. Trott, 8 P. R. 173

28—Electro-Silicon Co. v. Trask, 59 How. Pr. 189; followed in *Same* v. Levy, 59 How. Pr. 469.

29—Proctor & Gamble Co. v. Globe Refining Co., 92 Fed. Rep. 357; 34 C. C. A. 405.

30—Volger v. Force, 71 N. Y. S. 209.

31—Benedictus v. Sullivan, 12 R. P. C. 25.

32—Blackwell v. Armistead, 3 Hughes, 163; Fed. Case No. 1,474.

33—Walter Baker & Co. v. Baker, 77 Fed. Rep. 181.

34—Oppermann v. Waterman, 94 Wis. 583; 69 N. W. Rep. 569.

35—Sperry v. Percival Milling Co., 81 Cal. 252.

The Trademark or Tradename.	*Held to be infringed by.*
"Gold Dust."	"Gold Drop." [36]
"Golden Crown."	"Golden Chain." [37]
"Gothic."	"Ionic." [38]
"Guinness."	"Genuine." [39]
"Hermitage."	"Heritage." [40]
"Holeproof."	"No-hole." [41]
"Home."	"Home Delight." [42]
"Home Brand."	"Home Comfort." [43]
"Honeymoon."	"Honeycomb." [44]
"Hostetter Bitters."	"Host-Style Bitters." [45]
"Hostetter & Smith."	"Holsteter & Smyte." [46]
"Humphrey's Homeopathic Specifics."	"Reeves' Imported Homeopathic Specifics." [47]
"Iron Ox."	"Iron Oxide." [48]
"Junket Tablets."	"Junket Capsules." [49]
"Keepclean."	"Sta-Klean." [50]
"Ky's Criterion."	"Ky's Credential." [51]
"LaCarolina."	"LaCoralina." [52]

36—N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 42 C. C. A. 376; 102 Fed. Rep. 327; reversing s. c., 88 Fed. Rep. 694.

37—Parlett v. Guggenheimer, 67 Md. 542; 10 Atl. Rep. 81.

38—Keuffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

39—Guinness v. Heap, Seb. 617.

40—W. A. Gaines & Co. v. Turner-Looker Co., 123 C. C. A. 79; 204 Fed. Rep. 553.

41—Holeproof Hosiery Co. v. Fitts, 167 Fed. Rep. 378.

42—New Home Sewing Machine Co. v. Bloomingdale, 59 Fed. Rep. 284.

43—Griggs, Cooper & Co. v. Erie Preserving Co., 131 Fed. Rep. 359.

44—Kentucky Distilleries & Warehouse Co. v. Wathen, 110 Fed. Rep. 641-644.

45—Hostetter v. Becker, 73 Fed. Rep. 297.

46—Hostetter v. Vowinkle, 1 Dill. 329; Fed. Case No. 6714.

47—Humphreys' Specific Med. Co. v. Wenz, 14 Fed. Rep. 250-253.

48—Iron Ox. Co. v. Co-op. Society, 24 R. P. C. 425; same v. Leeds, 24 R. P. C. 434.

49—Hansen v. Siegel-Cooper Co. (2), 106 Fed. Rep. 691.

50—Florence Mfg. Co. v. J. C. Dowd & Co., 178 Fed. Rep. 73; 101 C. C. A. 565; reversing Florence Mfg. Co. v. J. C. Dowd & Co., 171 Fed. Rep. 122.

51—Kentucky Distilleries & Warehouse Co. v. Wathen, 110 Fed. Rep. 641-644.

52—Havana Commercial Co. v. Nichols, 155 Fed. Rep. 302.

The Trademark or Tradename.	*Held to be infringed by.*
"Lacto-Peptine."	"Lactopepsine."[53]
"Landlords' Protective Bureau."	"Landlords' Protective Department."[54]
"Leopoldshall."	"Leopoldsalt."[55]
"Lightning Hay Knives."	"Lightning Pattern Hay Knives."[56]
"Limetta."	"Limette."[57]
"Listerine."	"Listerseptine,"[58] and "Listogen."[59]
"Little Shop."	"Little Antique Shop."[60]
"Maizena."	"Maizharina."[61]
"Manufacturers' Outlet Co."	"Taunton Outlet Co."[62]
"Maryland Club Rye."	"Maryland Jockey Club Rye."[63]
"Mechanics' Store."	"Mechanical Store."[64]
"Mellwood."	"Mill Wood."[65]
"Miller's Chicken Cock Whiskey."	"Miller's Game Cock Rye."[66]
"Momaja."	"Mojava."[67]

53—Carnrick v. Morson, L. J. N. of C. (1877), p. 71.

54—Koebel v. Chicago Landlord's Protective Bureau, 210 Ills. 176; 71 N. E. Rep. 362; affirming Chicago Landlord's Protective Bureau v. Koebel, 112 Ill. App. 21.

55—Radde v. Norman, L. R. 14 Eq. 348.

56—Hiram Holt Co. v. Wadsworth, 41 Fed. Rep. 34.

57—Drewry & Son v. Wood, 127 Fed. Rep. 887.

58—Lambert Pharmacal Co. v. Kalish Pharmacy, 219 Fed. Rep. 323.

59—Lambert Pharmacal Co. v. Bolton Chem. Corp., 219 Fed. Rep. 325.

60—Crawford v. Lans, 60 N. Y. Supp. 387.

61—Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823; 23 Blatchf. 46.

62—Samuels v. Spitzer, 177 Mass. 226; 58 N. E. Rep. 693.

63—Cahn v. Gottschalk, 2 N. Y. Supp. 13.

64—Weinstock, Lubin & Co. v. Marks, 109 Cal. 529.

65—Mellwood Distilling Co. v. Harper, 167 Fed. Rep. 389.

66—G. G. White Co. v. Miller, 50 Fed. Rep. 277.

67—American Grocery Co. v. Sloan, 68 Fed Rep. 539.

The Trademark or Tradename.	*Held to be infringed by.*
"Morse's Compound Syrup of Yellow Dock Root."	"Dr. Morse's Improved Yellow Dock and Sarsaparilla Compound."[68]
"Mottled German Soap," with circle, moon and stars.	"S. W. McBride's German Mottled Soap," with a crescent and star.[69]
"Moxie."	"Noxie."[70]
"Moxie Nerve Food."	"Standard Nerve Food."[71]
"Nickel-In."	"Nickel-Saved."[72]
"Normal."	"Normandy."[73]
"Notamiss."	"Nevermiss."[74]
"Old Crow."	"White Crow."[75]
"Old Joe."	"Old Geo."[76]
"Old Mill Soap."	"Old Stone Mill Soap."[77]
"oMo."	"DMD."[78]
"Pancoast."	"Pan-coast."[79]
"Paragon."	"Pebble."[80]
"Pepto-Mangan."	"Pepto-Manganate of Iron and Cascara."[81]
"Portland."	"Famous Portland."[82]
"Pride."	"Pride of Syracuse."[83]
"Pride of Rome."	"Pride of the Home."[84]

68—Alexander v. Morse, 14 R. I. 153.

69—Proctor v. McBride, Fed. Case No. 11441.

70—Moxie Nerve Food Co. v. Beach, 33 Fed. Rep. 248.

71—Moxie Nerve Food Co. v. Baumbach, 32 Fed. Rep. 205.

72—Schendle v. Silver, 70 N. Y. Sup. Ct. 330; 18 N. Y. Supp. 1.

73—Keuffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

74—Daniel O'Donnell v. Riscal Mfg. Co., 228 Fed. Rep. 127, 130.

75—W. A. Gaines & Co. v. Leslie, 54 N. Y. Supp. 421; 25 Misc. Rep. 20.

76—Bluthenthal v. Mohlmann, 48 Fla. 321; 42 So. Rep. 1046; 38 So. Rep. 709.

77—Swift & Co. v. Brenner, 125 Fed. Rep. 826.

78—Omo Mfg. Co. v. Mystic Rubber Co., 225 Fed. Rep. 92.

79—Janney v. Pan-Coast Ventilator & Mfg. Co., 128 Fed. Rep. 121.

80—Keuffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

81—M. J. Breitenbach Co. v. Spangenberg, 131 Fed. Rep. 160.

82—Van Horn v. Coogan, 52 N. J. Eq. 380; 28 Atl. Rep. 788.

83—Hier v. Abrahams, 82 N. Y. 519.

84—Ft. Stanwix Canning Co. v. Wm. McKinley Canning Co., 63 N. Y. Supp. 704.

The Trademark or Tradename.	*Held to be infringed by.*
"Robert's Parabola Gold-Burnished Sharps."	"William Clark & Sons' Parabola Gold-Burnished Sharps."[85]
"Rogers."	"RoDgers."[86]
"Roof Leak."	"Never Leak."[87]
"Roy Watch-Case Co."	"Camm-Roy Watch-Case Co."[88]
"Rubberset."	"Rubber-Bound,"[89] and "Set in Rubber."[90]
"Ru-ber-oid."	"Rubberoid."[91]
"Sanitas."	"Condisanitas."[92]
"Sapolio."	"Saphia."[93]
"Sapolio."	"Sapho."[94]
"Sapolio."	"Sopono."[95]
"Savonol."	"Savoline."[96]
"Sawyer's Crystal Blue and Safety Box."	"Sawin's Soluble Blue and Pepper Box."[97]
"Seccotine."	"Securine."[98]
"Shawknit."	"Seamless."[99]

85—Roberts v. Sheldon, 8 Biss. 398; Fed. Case No. 11916.

86—International Silver Co. v. Rodgers Bros. Cutlery Co., 136 Fed. Rep. 1019, 1021.

87—Elliott Varnish Co. v. Sears, Roebuck & Co., 221 Fed. Rep. 797; reversed 232 Fed. Rep. 588.

88—Roy Watch-Case Co. v. Camm-Roy Watch-Case Co., 59 N. Y. Supp. 979.

89—Rubber & Celluloid H. T. Co. v. Rubber-Bound Brush Co., 81 N. J. Eq. 419; 88 Atl. Rep. 210; Ann. Cas. 1915B, 365; affirmed, 81 N. J. Eq. 519; 88 Atl. Rep. 210.

90—Rubber & Celluloid H. T. Co. v. F. W. DeVoe & C. T. Reynolds Co., 233 Fed. Rep. 150.

91—Standard Paint Co. v. Rubberoid Roofing Co., 140 C. C. A. 235; 224 Fed. Rep. 695.

92—Sanitas Co. v. Condy, 4 P. R. 195.

93—Enoch Morgan's Sons Co. v. Schwachofer, 5 Abb. Pr. N. C. 265.

94—Enoch Morgan's Sons Co. v. Whittier-Coburn Co., 118 Fed. Rep. 657.

95—Enoch Morgan & Sons Co. v. Ward, 81 C. C. A. 616; 152 Fed. Rep. 690.

96—Field v. Wagnel Syndicate, L. R. (1900) 1 Ch. 651.

97—Sawyer v. Kellogg, 7 Fed. Rep. 720; 9 Fed. Rep. 601.

98—McCaw, Stevenson & Orr, Ltd. v. Nickols, 21 R. P. C. 15.

99—Shaw Stocking Co. v. Mack, 12 Fed. Rep. 707; 21 Blatchf. 1.

The Trademark or Tradename.	*Held to be infringed by.*
"Shrewsbury, Marshall & Co. Patent Thread."	"Schrewsbury-Marchal Patent Thread." [1]
"Simplex."	"Simplicity." [2]
"Six Little Tailors."	"Six Big Tailors." [3]
"Sorosis."	"Sartoris." [4]
"Southern Company, St. Louis."	"Southwestern, St. Louis." [5]
"Star."	"Lone Star." [6]
"Stark."	"Star." [7]
"Steinway."	"Steinberg." [8]
"Stephens."	"Steel Pens." [9]
"St. Ives."	"St. Ives." [10]
"Stuart's Dyspepsia Tablets."	"Dr. Stewart's Dyspepsia Tablets." [11]
"Sunlight."	"American Sunlight." [12]
"Swan."	"Black Swan." [13]
"Tonge's."	"Tung's." [14]
"Trafford."	"Stafford." [15]
"Uneeda."	"Iwanta." [16]
"Universal."	"University." [17]
"Vitae-Ore."	"Vitalizing Ore." [18]

1—Marshall v. Ross, L. R. 8 Eq. 651.

2—Keuffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

3—Mossler v. Jacobs, 65 Ill. App. 571.

4—Little v. Kellam, 100 Fed. Rep. 353.

5—Southern White Lead Co. v. Cary, 25 Fed. Rep. 125.

6—Hutchinson v. Covert, 51 Fed. Rep. 832; 61 Off. Gaz. 1017.

7—Gardner v. Bailey, Seb. 365; Fed. Case No. 5221.

8—Steinway v. Henshaw, 5 P. R. 77.

9—Stephens v. Peel, 16 L. T. N. S. 145.

10—Alpin v. Richards, 20 R. P. C. 799.

11—Stuart v. F. G. Stewart Co., 91 Fed. Rep. 243; 33 C. C. A. 480.

12—Lever Bros. v. Pasfield, 88 Fed. Rep. 484.

13—*Ex parte* Caire, 15 Off. Gaz. 248.

14—Tonge v. Ward, 21 L. T. N. S. 480.

15—Smith v. Carron Co., 13 P. R. 108.

16—National Biscuit Co. v. Baker, 95 Fed. Rep. 135.

17—Keuffel & Esser Co. v. H. S. Crocker Co., 118 Fed. Rep. 187.

18—Noel v. Ellis, 89 Fed. Rep. 978.

The Trademark or Tradename.	*Held to be infringed by.*
"Wamsutta."	"Wamyesta."[19]
"Warner."	"Wiener."[20]
"Warren."	"Warranted."[21]
"Wearever."	"Everlasting."[22]
"Welcome."	"Welcome A. Smith."[23]
"Willoughby Lake."	"Willoughby Ridge."[24]
"Yusea."	"U-C-A."[25]
"55."	"35."[26]

It follows that a word may infringe a symbol, or *vice versa*. Thus the figure of Columbia is an infringement of the word "Columbia," previously applied to the same class of merchandise.[26a] But the use by a plaintiff of a conventional diamond-shaped design has been held not to confer a trademark right in the word "diamond," Judge Adams remarking: "If the complainant's goods had ever been known in the trade as 'diamond steel,' or generally as 'diamond' goods, it would undoubtedly be protected in the use of the word 'diamond' as a tradename, even though such word nowhere appeared in connection with the symbol of a conventional diamond forming its trademark. Its use by a competitor, either as its corporate name or tradename for its product, under such circumstances would undoubtedly tend to deceive, and fall within the condemnation of the cases of complainant's counsel. See, especially, *Johnson v. Bauer*, 82 Fed. Rep. 662."[27]

19—Wamsutta Mills v. Allen, 12 Phila. 535.

20—Warner Bros. Co. v. Wiener, 134 C. C. A. 393; 218 Fed. Rep. 635; Warner Bros. Co. v. Wiener, 130 C. C. A. 424; 214 Fed. Rep. 30.

21—Frost v. Rindskopf, 42 Fed. Rep. 408.

22—Aluminum Cooking Utensil Co. v. National Aluminum Works, 226 Fed. Rep. 815.

23—Lever Bros. Ltd., Boston Works v. Smith, 112 Fed. Rep. 998.

24—Pike Mfg. Co. v. Cleveland Stone Co., 35 Fed. Rep. 896.

25—Welsbach Light Co. v. Adam, 107 Fed. Rep. 463.

26—Collins v. Reynolds Card Mfg. Co., 7 Abb. N. C. 17, Price & Stewart, 262.

26a—Morgan Envelope Co. v. Walton, 82 Fed. Rep. 469; 81 Off. Gaz. 1615; In this connection, see Kann v. Diamond Steel Co., 89 Fed. Rep. 706; and *In re* Thewlis & Blakey's Trademark, 10 R. P. C. 369.

27—Pittsburg Crushed Steel Co. v. Diamond Steel Co., 85 Fed. Rep. 637-642.

The addition of other symbols, words or initials to the trademark of another will not operate to avoid a charge of infringement. "No one who has counterfeited a legitimate trademark and applied the spurious symbol in competition with the genuine can avoid the charge of infringement by showing that the false mark has in practice been so accompanied, on labels, capsules or otherwise, by tradenames, designations, descriptions or other accessories, not forming part of it, as to render it unlikely that the public has been deceived. Such a showing, while it may affect the nature or measure of the relief to be granted, can not defeat a suit for infringement."[28]

In the absence of proof of any deception of the public, the courts have not been inclined to declare a different mark an infringement unless the similarity was close.

Mark	*Relief refused as against*
"Coca-Cola."	"Koke."[29]
"Colonel."	"Colonial."[30]
"Cuticura."	"Cuticle."[31]
"Don Carlos."	"Don Caesar."[32]
"Everyday Soap."	"Everybody's Soap."[33]
"Glacier."	"Glazine."[34]
"Grape-nuts."	"Grain-Hearts."[35]
"Hurricane."	"Tempest."[36]
"Ivy."	"Ivory."[37]
"Kelvindale."	"Kelvinside."[38]

28—Bradford, J., in Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206-212.

29—Coca-Cola Co. v. Branham, 216 Fed. Rep. 264.

30—St. Mungo Mfg. Co. v. Viper Co., 27 R. P. C. 420.

31—Potter D. & Chem. Corp. v. Pasfield Soap Co. (1), 102 Fed. Rep. 490; Same v. Same (2), 106 Fed. Rep. 914; 46 C. C. A. 40.

32—Chance v. Gulden, 165 Fed. Rep. 624; 92 C. C. A. 58; reversing Gulden v. Chance, 163 Fed. Rep. 447.

33—Proctor & Gamble Co. v. Globe Refining Co., 92 Fed. Rep. 357; 34 C. C. A. 405.

34—McCaw, Stevenson & Orr, Ltd. v. Lee Bros., 23 R. P. C. 1.

35—Postum Cereal Co. Ltd. v. American Health Food Co., 109 Fed. Rep. 898.

36—Hurricane Patent Lantern Co. v. Miller, 56 How. Pr. 234.

37—Goodwin v. Ivory Soap Co., 23 R. P. C. 389.

38—Meikle v. Williamson, 27 R. P. C. 775.

Mark	*Relief refused as against*
"Neeco."	"Nawaco." [39]
"New Departure."	"New Idea." [40]
"Norub."	"Nodust." [41]
"No-to-bac."	"Bacocuro." [42]
"One Night Cure."	"Beeshore One Night Cough Cure." [43]
"Puddine."	"Pudding." [44]
"Pyramid."	"Spiralette." [45]
"Roof Leak."	"Never Leak." [46]
"Sal-Vet."	"Sal Tone." [47]
"Sappota Tolu."	"Elastic Tolu." [48]
"S. B."	"B. & S." [49]
"Shuron."	"Stay-on." [50]
"Sozodont."	"Zodenta." [51]
"Weber."	"Webster." [52]
"Wincarnis."	"Vincalis." [53]
"Yama-Mai."	"Ma-mie." [54]

Thus it has been held that the mark "Filofloss," applied to silk, is a valid trademark notwithstanding the prior use of

39—New England Confectionery Co. v. National Wafer Co., 140 C. C. A. 30; 224 Fed. Rep. 344.

40—Hamilton Mfg. Co. v. Tubbs Mfg. Co., 216 Fed. Rep. 401.

41—Van Zile v. Norub Mfg. Co., 228 Fed. Rep. 829.

42—Sterling Remedy Co. v. Eureka Chem. Mfg. Co., 80 Fed. Rep. 105; 25 C. C. A. 314.

43—Kohler Mfg. Co. v. Beeshore (2), 59 Fed. Rep. 572-576; 8 C. C. A. 215.

44—Clotworthy v. Schepp, 42 Fed. Rep. 62.

45—Moebius v. Louis De Jonge & Co., 215 Fed. Rep. 443.

46—Sears, Roebuck & Co. v. Elliott Varnish Co., 232 Fed. Rep. 588, 590 (C. C. A. 7); reversing Elliott Varnish Co. v. Sears, Roebuck & Co., 221 Fed. Rep. 797.

47—S. R. Feil Co. v. John E. Robbins Co., 136 C. C. A. 258; 220 Fed. Rep. 650.

48—Adams v. Heisel, 31 Fed. Rep. 279.

49—Burt v. Smith, 71 Fed. Rep. 161-163.

50—Kirstein, Sons & Co. v. Cohen Bros., 39 Can. Sup. Ct., 286.

51—Hall & Ruckel v. Ingram, 126 O. G. 759.

52—Foster v. Webster Piano Co., 13 N. Y. Supp. 338.

53—Coleman & Co. Ltd. v. Jno. Brown & Co., 16 R. P. C. 619.

54—Boessneck v. Iselin, 82 N. Y. Supp. 164.

the mark "Filoselle" applied to silk of a different character;[55] that the mark "Star" and an uncolored tin star is not infringed by "Starlight" and a red paper star;[56] that "B. T. Babbitt's Trademark Best Soap" is not infringed by "P. T. Butler's Trademark Best Soap";[57] that the name "Social Register" applied to a directory is not infringed by the words "Newport Social Index";[58] that the name "Vichy" was not infringed by "Lithia-Vichy", there being numerous artificial waters upon the market;[59] that the mark "Rough-on-Rats" was not infringed by "Rough on Skeeters," the goods not being in competition,[60] that the book title "Farthest North, Nansen," was not infringed by "The Fram 'Expedition.'"[61] While the word "Muffler" is closely similar to "Mufflet," and the latter is a valid trademark for neck-scarfs, the use of the former can not be enjoined because it is aptly descriptive of the article to which it is applied.[62]

For the same reason, "Poresknit" as a trademark for underwear, is not infringed by the words "Porous Underwear."[63]

It is important to note in this connection the expression of Lord Cranworth, that "It would be a mistake to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side. The rule so restricted would be of no practical use."[64]

And another rule is that a defendant can not evade the charge of infringement by "showing that the device or inscription upon the imitated mark is ambiguous, and capable of being understood by different persons in different ways."[65]

55—Rawlinson v. Brainard & Armstrong Co., 59 N. Y. Supp. 880; 28 Misc. Rep. 287.

56—Liggett & Myers Tobacco Co. v. Finzer, 128 U. S. 182; 32 L. Ed. 395.

57—Babbitt v. Brown, 68 Hun, 515.

58—Social Reg. Assn. v. Murphy, 128 Fed. Rep. 116.

59—La Republique Francaise v. Schultz (4), 115 Fed. Rep. 196.

60—Wells v. Ceylon Perfume Co., 105 Fed. Rep. 621.

61—Harper v. Lare, 93 Fed. Rep. 989; Harper & Bros. v. Lare, 43 C. C. A. 182; 103 Fed. Rep. 203.

62—Hygienic Fleeced Underwear Co. v. Way, 70 C. C. A. 553; 137 Fed. Rep. 592, 595.

63—Chalmers Knitting Co. v. Columbia Mesh Knitting Co., 160 Fed. Rep. 1013.

64—Seixo v. Provezende, L. R. 1 Ch. D. 192.

65—Lord Watson in Singer Mfg. Co. v. Loog (3), 8 App. Cas. 39.

§ 139. Patent office rulings on similarity of alleged conflicting marks.—The decisions of the several commissioners of patents as to similarity and dissimilarity of marks alleged to be conflicting or identical are frequently instructive and valuable as illustrations. In the language of Allen, Commissioner, "The question of anticipation by a prior registered mark may be tested by the question of infringement. The doctrine of the patent law that that which would infringe if later in date will anticipate if earlier is applicable to questions of trademark, for it involves only the question of substantial identity."[66]

In the following cases registration was refused upon a prior-registered mark because of the similarity adjudged by the Commissioner to exist between them:

The Applicant's mark	*Rejected on*
"Colonial."	"Colonial Dame."[67]
"Dyspepticide."	"Dyspepticure."[68]
"Liveroid."	"Liveraid."[69]
"Maple Leaf."	"Silver Leaf."[70]
"Nitro-Hunter."	"Nitro."[71]
"Pepko."	"Pep-Kola."[72]
"Satin Skin."	"Satinette."[73]
"Sagafoam."	"Sea Foam."[74]
"Telegraphone."	"Telegraphophone."[75]
"Velva."	"Velvet."[76]

§ 140. Miscellaneous matters relating to infringement.—In the cases of infringement it is manifest that the policy of the

66—*Ex parte* Keystone Chamois Co., 101 Off. Gaz. 3109.

67—Allen B. Wrisley Co. v. Buck, 95 Off. Gaz. 2483.

68—*Ex parte* Foley & Co., 87 Off. Gaz. 1957.

69—*Ex parte* Dr. Harter Med. Co., 106 Off. Gaz. 1779.

70—*Ex parte* Vogel & Son, 99 Off. Gaz. 2321.

71—*Ex parte* W. B. Belknap & Co., 105 Off. Gaz. 745.

72—*Ex parte* Sutton, 108 Off. Gaz. 291.

73—Wood v. Hinchman, 110 Off. Gaz. 600.

74—*Ex parte* Sodafoam Baking Powder Co., 96 Off. Gaz. 1239.

75—*Ex parte* Hutchins, 100 Off. Gaz. 1330.

76—*Ex parte* Willard Chem. Co., 107 Off. Gaz. 1972.

law is clear, and that difficulty in determining questions of infringement arises only out of the facts.

It was asked in the English House of Lords, "How can observations of judges upon other and quite different facts bear upon the present case, in which the only question is what is the result of the evidence?"[77] Analogies will, however, frequently be found in the adjudicated cases which may assist in classifying the character of infringement under consideration.

Infringements which display the name or initials of the defendant are none the less infringements if any substantial portion of the mark is taken from the plaintiff's mark.[78] This principle has been applied to a case where the defendant had washed plaintiff's labels off his bottles, leaving only the marks blown or moulded in the glass, and had pasted his own labels upon the bottles,[79] although in similar cases, where the name of the defendant was conspicuously displayed on the new label, injunction was refused.[80] But the fact that the defendant does display his name upon his goods is always to be considered as a circumstance in his favor.[81]

Infringement applied to goods of equal quality.—It is settled that the fact that the defendant's goods are equal in quality to the plaintiff's is no defense to the action of infringement. As said by Judge McLean: "To entitle a complainant to protection against a false representation it is not essential that

77—Lord Watson in Johnson v. Orr-Ewing, H. L. 7 App. Cas. 219.

78—Sawyer Crystal Blue Co. v. Hubbard, 32 Fed. Rep. 388; Anheuser-Busch Brewing Association v. Clarke, 26 Fed. Rep. 410; Garrett v. T. H. Garrett & Co., 24 C. C. A. 173; 78 Fed. Rep. 472; Anheuser-Busch Brewing Association v. Piza, 24 Fed. Rep. 149; Hostetter v. Adams, 10 Fed. Rep. 838; Pepper v. Labrot, 8 Fed. Rep. 29; Shaw Stocking Co. v. Mack, 12 Fed. Rep. 707; McCann v. Anthony, 21 Mo. App. 83; Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206.

79—Hostetter v. Anderson, 1 W. W. & A'B. Eq. 7; Seb. 652; Rose v. Loftus, 47 L. J. Ch. 576; 38 L. T. N. S. 409; Seb. 608; Rose v. Henly, Seb. 551.

80—Welch v. Knott, 4 K. & J. 747; Barret v. Gomm, 74 L. T. (Journal) 388.

81—"This is one of the important means of identification." Severens, J., in Proctor & Gamble Co. v. Globe Refining Co., 34 C. C. A. 405; 92 Fed. Rep. 357-362. And see Kann v. Diamond Steel Co., 89 Fed. Rep. 706; P. Lorillard Co. v. Peper, 30 C. C. A. 496; 86 Fed. Rep. 956-959; affirming P. Lorillard Co. v. Peper, 65 Fed. Rep. 597; Blackwell v. Crabb, 36 L. J. Ch. 504; Beard v. Turner, 13 L. T. N. S. 746.

the article should be inferior in quality."[82] And in an English case involving the manufacture of metallic hones, Lord Denman instructed the jury that "even if the defendant's hones were not inferior, the plaintiff was entitled to some damages, inasmuch as his right had been invaded by the fraudulent act of the defendant."[83] It may be regarded as settled that it is immaterial, in the language of Judge Morris, whether the defendant's goods "be better or worse in quality."[84]

§ 141. The use of letters and numerals.—The principle that there can be trademark rights in letters or numerals can not be considered as finally settled. *Gillott v. Esterbrook*,[85] in which the defendant was enjoined from using the numerals "303," was for a time regarded as upholding their use as a trademark, but the case is known and recognized as a case of unfair competition.[86] The leading English case, *Ainsworth v. Walmsley*, is very similar to *Gillott v. Esterbrook, supra*, in that while the imitation of a series of numbers was considered as one of the elements justifying injunction, Vice-Chancellor Wood carefully distinguished them as not being a technical trademark.[87] There is no case, however, in England in which the courts have recognized "a mere numeral or combination of numerals, standing alone, as sufficiently arbitrary and distinctive to constitute a trademark,"[88] and the United States Circuit Court of Appeals for the Sixth Circuit has flatly held that a "bare numeral" can not be a trademark.[89]

Of course numerals may form a part of a trademark, in combination or collocation with words, figures or designs, and

82—Colleen v. Brunton (2), 5 McLean, 256; Fed. Case No. 2,947.

83—Blofield v. Payne, 4 B. & Ad. 410; Seb. 50. See also Taylor v. Carpenter (2), 2 W. & M. 1; Cox, 32; Taylor v. Carpenter (3), 2 Sandf. Ch. 603; Edelsten v. Edelsten, 1 DeG. J. & S. 185; Seb. 213.

84—Sawyer v. Horn, 1 Fed. Rep. 2138. To the same effect see Cutter v. Gudebrod Bros. Co., 55 N. Y. Supp. 298; Grocers' Supply Co. v. Dupuis (Mass.), 107 N. E. Rep. 389.

85—47 Barb. 455; Cox, 340.

86—Browne on Trademarks (2d ed.), § 228.

87—Ainsworth v. Walmsley, L. R. 1 Eq. 518-527.

88—Sebastian on Trademarks (4th Ed.), p. 79.

89—Dennison Mfg. Co. v. Scharff Tag, Label & Box Co., 68 C. C. A. 263; 135 Fed. Rep. 625, 628.

many cases in which their imitation has been restrained turned upon this point;[90] they will also be protected when used in an arbitrary and distinctive manner which conveys no idea of number, although they would probably not be so used except in collocation with designs or words.[91] In one case it was held that a complainant was entitled to the exclusive use of a trademark consisting of the figures ½, only in the form, size, color and style in which it had been registered and used.[92]

The strongest case holding that numerals alone may form a valid technical trademark is *Shaw Stocking Co. v. Mack*,[93] in which Judge Coxe ably reviews the decisions and argues that the rejection of numerals as trademark was invariably because of their use indicating quality rather than origin or ownership; but he finally bases the reason of his decree of injunction flatly upon the defendant's fraudulent competition.

The practical difficulty in the way of constructing a trademark from numerals alone is that the defendant could always find a multiplicity of excuses for selecting the same numerals, and the cases indicate that the courts grant ample protection to their use as against their fraudulent imitation.[94]

Even where numerals were originally indicative of origin and ownership, if they have come to be used to indicate quality, any one having the right to make or sell the article in connection wherewith such numerals are so used may designate the article by the numerals.[95]

90—Boardman v. Meriden Britannia Co., 35 Conn. 402; Lawrence Mfg. Co. v. Lowell, 129 Mass. 325; Humphreys' Specific Med. Co. v. Wenz, 14 Fed. Rep. 250; Carver v. Pinto Leite, L. R. 7 Ch. App. 90; Robinson v. Finlay, L. R. 9 Ch. D. 487; Broadhurst v. Barlow, W. N. 1872, p. 212; Carver v. Bowker, Seb. 581; Ralli v. Fleming, Ind. L. R. 3 Calc. 417.

91—Kinney v. Basch, 16 Am. Law Reg. N. S. 596; Seb. 542—properly a case of unfair competition.

92—Kinney v. Allen, 1 Hughes, 106; Seb. 557; Fed. Case No. 7826.

93—12 Fed. Rep. 707. See also to the same effect Smith & Davis Mfg. Co. v. Smith, 89 Fed. Rep. 486.

94—Gilliott v. Kettle, 3 Duer 624; American Solid Leather Button Co. v. Anthony, 15 R. I. 338; Collins v. Reynolds Card Mfg. Co., 7 Abb. N. C. 17; India Rubber Comb Co. v. Jewelry Co., 45 N. Y. Sup. Ct. 258; Sohl v. Geisendorf, 1 Wills. (Ind.) 60; Hazard v. Caswell, 57 How. Pr. 1; Glen & Hall Mfg. Co. v. Hall, 61 N. Y. 226; 19 Am. Rep. 278; Seb. 443; Humphreys' Homeopathic Medicine Co. v. Hilton, 60 Fed. Rep. 756.

95—Smith & Davis Mfg. Co. v. Smith, 89 Fed. Rep. 486.

The number 888 used as a call for a telephone company's so-called "trouble department" was the basis of an application for injunction against a rival company which adopted the same number for the same purpose. The theory of the application was that the calls being the same, the later user would or might learn of defects in the rival's customer's service and use this information to induce its rival's patrons to use the respondent's telephones. The application is, upon the face of the opinion, one of the most grotesque attempts to pervert the law of unfair competition. The relief sought for was denied.[96]

In regard to letters, standing alone or in initial combinations, the English courts have from an early period treated them as trademarks,[97] although it appears that under the English Act of 1875, 38 and 39 Vict., c. 91, Vice-Chancellor Hall has held a single letter can not be registered as a trademark.[98]

The use of a single letter would appear to be at least unsafe, although it might in the United States be regarded as a trademark; and Judge Bradford in a recent opinion suggests that a single letter or figure may be "so peculiar and unusual in form or ornamentation" as to be a valid trademark.[99]

Combinations of letters, used as initials, have been frequently approved as trademarks in the American decisions,[1] and in the case of *Amoskeag Mfg. Co. v. Trainer*,[2] in the federal supreme court, the decision, which held the letters "A C A" were not a valid trademark, was based upon the

96—Rocky Mountain Bell Telephone Co. v. Utah Telephone Co., 31 Utah 377; 88 Pac. Rep. 26.

97—Ransome v. Bentall, 3 L. J. Ch. 161; Motley v. Downman, 3 My. & Cr. 1; Millington v. Fox, 3 My. & Cr. 338; Crawshay v. Thompson, 4 M. & G. 357; Kinahan v. Bolton, 15 Ir. Ch. 75; Hopkins v. Hitchcock, 14 C. B. N. S. 65; Hall v. Barrows, 4 DeG. J. & S. 150; Barrows v. Pelsall, Seb. 530; *In re* Barrows, L. R. 5 Ch. D. 353; Cartier v. Carlile, 31 Beav. 292; Cartier v. Westhead, Seb. 199; Cartier v. May, Seb. 200; Moet v. Clybonn, Seb. 533; Moet v. Pickering, L. R. 8 Ch. D. 372; *Ex parte* Young, Seb. 537; Ransome v. Graham, 51 L. J. Ch. 897; Bondier v. Depatie, 3 Dorion, 233; *In re* Brook, 26 W. R. 791.

98—*In re* Mitchell, L. R. 7 Ch. D. 36; 46 L. J. Ch. 876; 26 W. R. 326; Cartmell, 226.

99—Dennison Mfg. Co. v. Thomas Mfg. Co., 94 Fed. Rep. 651-658.

1—Geron v. Gartner, 47 Fed. Rep. 467; Frank v. Sleeper, 150 Mass. 583.

2—101 U. S. 51; 25 L. Ed. 993.

theory that those letters as used by the complainant were indicative of quality, and not of origin or ownership, as Judge Coxe has pointed out.[3] There can scarcely be a doubt that both numerals and letters of the alphabet may sometimes be technical trademarks, and the objection to their use in that capacity has been well stated by Judge Colt in the Supreme Court of Massachusetts to be "the difficulty of giving to bare numbers the effect of indicating origin or ownership, and of showing that the numbers used were originally designed for that purpose."[4] And the same practical suggestion was offered by the Supreme Court of Connecticut in these words: "It may be difficult to give to bare numbers the effect of indicating origin or ownership, and it may be still more difficult to show that they were originally designed for that purpose; but if it be once shown that that was the original design, and that they have had that effect, it may not be easy to assign a reason why they should not receive the same protection, as trademarks, as any other symbol or device."[5]

A review of the cases indicates that the use of numerals or letters has been restrained sometimes on the theory that they were technical trademarks, but never where they were merely used to indicate quality;[6] and where injunction has issued, the facts show that the infringing figures or letters were used in fraudulent competition.[7]

In this connection it is well to note that "there can be no doubt, and indeed it is not disputed, that two letters may constitute a trademark."[8] So the American courts have

3—Shaw Stocking Co. v. Mack, 12 Fed. Rep. 707.

4—Lawrence Mfg. Co. v. Lowell, 129 Mass. 325; Price & Steuart, 418.

5—Boardman v. Meriden Britannia Co., 35 Conn. 402; Cox, 490.

6—*In re* Eagle Pencil Co., 10 Off. Gaz. 981; Amoskeag Co. v. Trainer, 101 U. S. 51; 25 L. Ed. 993; Stevens Linen Works v. William & John Don & Co., 121 Fed. Rep. 171; affirmed 62 C. C. A. 582; 127 Fed. Rep. 950.

7—Ransome v. Bentall, 3 L. J. Ch. N. S. 161; Gillot v. Kettle, 3 Duer, 624; Ainsworth v. Walmsley, L. R. 1 Eq. 518; Gillott v. Esterbrook, 47 Barb. 455; Cox, 340; 48 N. Y. 374; 8 Am. Rep. 553; Broadhurst v. Barlow, W. N. 1872, p. 212; Seb. 411; Kinney v. Basch, Seb. 542; Avery v. Meikle, 81 Ky. 75.

8—Kinahan v. Bolton, 15 Ir. Ch. 75.

uniformly held that monograms or groups of two or more letters not indicative of quality constitute valid trademarks; thus we find that the following marks have been held valid: "A. G." applied to cigars and coffee;[9] "B. B. B." applied to a medicine;[10] "B. B. H." applied to iron;[11] "S. B." applied to cough-drops;[12] "G. E." applied to electric lamps;[13] "G. F." applied to velvet ribbon;[14] "O. F. C." applied to whiskey;[15] "A. C. A." applied to ticking;[16] "J. H. W." applied to boots;[17] "T. O. C." applied to oil-cloth.[18] And we find that similar groups of letters and monograms have been treated as valid by the English decisions.[19]

§ 142. The judicial test of infringement.—It may be said, generally, that the courts will apply to the facts, in the class of cases that we are considering, any and all tests which are necessary to determine whether or not the competition established by the defendant is fraudulent. In delivering the opinion of the federal supreme court in *Coats v. Merrick Thread Co.*, Mr. Justice Brown observed: "The differences are less conspicuous than the general resemblance between the two. At the same time, they are such as could not fail to impress themselves upon a person who examined them with a view to ascertain who was the real manufacturer of the thread."[20]

9—Godillot v. American Grocery Co., 71 Fed. Rep. 873.

10—Foster v. Blood Balm Co., 77 Ga. 216; 3 S. E. Rep. 284.

11—Hall v. Barrows, 4 DeG. J. & S. 150.

12—Burt v. Smith, 71 Fed. Rep. 161.

13—General Electric Co. v. Renew Lamp Co., 128 Fed. Rep. 154.

14—Giron v. Gartner, 47 Fed. Rep. 467.

15—Geo. T. Stagg Co. v. Taylor, 95 Ky. 651; 27 S. W. Rep. 247.

16—Amoskeag Mfg. Co. v. Trainer, 101 U. S. 51; 25 L. Ed. 993; (dissent of Mr. Justice Clifford). To the same effect see Burton v. Stratton, 12 Fed. Rep. 696; Smith v. Imus, 32 Alb. L. J. 455; Frank v. Sleeper, 150 Mass. 583; 23 N. E. Rep. 213.

17—Walker v. Reid, Fed. Case No. 17084.

18—Standard Table Oil Cloth Co. v. Trenton Oil Cloth & Linoleum Co., 71 N. J. Eq. 555; 63 Atl. Rep. 846.

19—Hopkins v. Hitchcock, 14 C. B. N. S. 65; Paul v. Barrows, 4 DeG. J. & S. 150; *In re* Barrows, L. R. 5 Ch. D. 353; Cartier v. Carlile, 31 Beavan, 292; Moet v. Pickering, L. R. 8 Ch. D. 372; Frankau v. Pope, 11 Cape of Good Hope, 209.

20—Coats v. Merrick Thread Co., 149 U. S. 562; 37 L. Ed. 847.

And in all cases the court will inspect not only the differences but the resemblances, as both must be considered in ascertaining whether the competition between the parties is fair or fraudulent. As said by Judge Severens: "It has been said that it is the resemblances that should be looked at, rather than the differences. But the existence of the latter negatives the former, and it is necessary to take both into view, in order to get a correct picture of the whole."[21]

Of course the defendant can not avail himself of dissimilarities which become apparent only upon comparison of the plaintiff's and defendant's packages or marks. This is because purchasers do not have the opportunity of making comparisons. "A specific article of approved excellence comes to be known by certain catchwords easily retained in memory, or by a certain picture which the eye readily recognizes. The purchaser is required only to use that care which persons ordinarily exercise under like circumstances. He is not bound to study or reflect. He acts upon the moment. He is without the opportunity of comparison. It is only when the difference is so gross that no sensible man acting on the instant would be deceived, that it can be said that the purchaser ought not to be protected from imposition. Indeed, some cases have gone to the length of declaring that the purchaser has a right to be careless,[22] and that his want of caution in inspecting brands of goods with which he supposes himself to be familiar ought not to be allowed to uphold a simulation of a brand that is designed to work fraud upon the public. However that may be, the imitation need only be slight if it attaches to what is most salient; for the usual inattention of a purchaser renders a goodwill precarious, if exposed to imposition."[23]

21—Proctor & Gamble Co. v. Globe Refining Co., 92 Fed. Rep. 357-362; 34 C. C. A. 405.

22—It has been held on circuit that the careless purchaser will not be protected. N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 88 Fed. Rep. 694; but the case was reversed on appeal: s. c., 102 Fed. Rep. 327-332; 42 C. C. A. 376. The test generally applied is, whether one "in the use of ordinary care" can be deceived. Sartor v. Smith, 125 Ia. 665; 101 N. W. Rep. 515.

23—Jenkins, J., in Pillsbury v. Flour-Mills Co., 64 Fed. Rep. 841-847; 12 C. C. A. 432.

The foregoing extract very fully expresses the character of supervision over fairness in trade exercised by our courts of equity. When an article has become known by a catchword or a peculiar package, any one seeking to use that form of package, or a mark or name that suggests the catchword, must take care to keep within the bounds of fairness in trade in so doing.[24]

Mere colorable distinctions, so arranged as to escape notice,[25] the use of labels which may be removed by retail dealers, leaving the imitated marks free to effect deception,[26] and all the other devices and schemes of fraudulent competition disclosed by the reports, are taken into consideration in determining the right to equitable relief. One of the most important tests is the existence of similarities of detail, whether of design, form, size, color or material. Relief will always be granted when "it is manifest from a comparison (of the two articles in controversy) that one was copied from the other."[27] The court does not search for dissimilarities, but for points of resemblance.[28]

24—Stuart v. F. G. Stewart Co., 91 Fed. Rep. 243; 33 C. C. A. 480. So the use of the word "Iwanta" has been enjoined as being a fraud upon the owner of the trademark "Uneeda," both words being applied to biscuit. National Biscuit Co. v. Baker, 95 Fed. Rep. 135. And so of the phrase "Candy Cathartic" used by the plaintiff with the word "Cascarets" and by the defendant with the word "Cascara." Sterling Remedy Co. v. Gorey, 110 Fed. Rep. 372-373.

25—Taylor v. Taylor, L. R. 2 Eq. 290; 23 L. J. Ch. 255.

26—Barlow v. Johnson, 7 R. P. C. 395.

27—Shipman, J., in Dixon Crucible Co. v. Benham, 4 Fed. Rep. 527-530.

28—Hostetter v. Adams, 10 Fed. Rep. 838-842. Thus Judge Lacombe, in considering conflicting liquor labels, said: "Inspection of the labels must carry conviction to any unbiased and unprejudiced mind that the later label was prepared by some one who had seen the earlier one, and that it was designed, not to differentiate the goods to which it was affixed, but to simulate a resemblance to complainant's goods sufficiently strong to mislead the consumer, although containing variations sufficient to argue about should the designer be brought into court. This is the usual artifice of the unfair trader." Collinsplatt v. Finlayson, 88 Fed. Rep. 693. In another recent case the same court says: "There are as usual a number of minor differences between the form and the dress of the two packages, which are expatiated upon in the affidavits and the brief; but no one can look at both packages,

"Where there are found strong resemblances, the natural inquiry for the court is, why do they exist? If no sufficient answer appears, the inference is that they exist for the purpose of misleading."[29]

No matter what minor differences may exist in the tests of infringement applied by various courts, it has been uniformly noted that the fact that purchasers have no opportunity of comparison must be considered, and the genuine and alleged infringing marks must be judged by the court, therefore, in the light of that fact.[30]

Where the resemblance resides in the form, color, etc., of the defendant's container, the usual defense is that the container is common to the trade. That defense is not favored when the differences present "do not destroy the general similarity of appearance to the ordinary purchaser,"[31] and the fact that the containers were specially manufactured for the defendant is of weight.[32]

"The test of infringement * * * is the same as is applied in design patents; that is, whether ordinary purchasers would be mislead by the similarity between the designs in controversy."[33]

without perceiving that there are strong resemblances, which could easily have been avoided had there been an honest effort to give defendant's goods a distinctive dress." National Biscuit Co. v. Baker, 95 Fed. Rep. 135.

In referring to conflicting lables, Judge Gilbert, in a recent decision, says "these differences are such as are usually introduced where the intention is to make an unfair use of an established trademark, and at the same time so far depart therefrom as to avoid the charge of infringement." Kostering v. Seattle Brewing & Malting Co., 54 C. C. A. 76; 116 Fed. Rep. 620.

29—Lurton, J., in Paris Medicine Co. v. W. H. Hill Co., 102 Fed. Rep. 148-151; 42 C. C. A. 227.

30—Pillsbury v. Pillsbury-Washburn Flour Mills Co., 64 Fed. Rep. 841-847; 12 C. C. A. 432; Manhattan Med. Co. v. Wood, Fed. Case No. 9026; 4 Cliff, 461; 108 U. S. 218; 27 L. Ed. 706; Allegheny Fertilizer Co. v. Woodside, Fed. Case No. 206; 1 Hughes, 115; Sawyer v. Kellogg, 7 Fed. Rep. 721; Sawyer v. Kellogg, 9 Fed. Rep. 601; Liggett & Myers Tob. Co. v. Hynes, 20 Fed. Rep. 883; Hostetter v. Adams, 10 Fed. Rep. 838-842.

31—Brown, J., in Moxie Co. v. Daoust, 124 C. C. A. 434; 206 Fed. Rep. 434, 436; reversing 197 Fed. Rep. 678.

32—*Ibid.*

33—Thomas, J., in Howard Dustless Duster Co. v. Carleton, 219 Fed. Rep. 913, 916.

The doctrine of general effect.—In an Australian case we find one of the best and clearest of the early statements of the rule, that "We are to consider whether the infringement of the plaintiff's rights has been proved, not by taking particular isolated points, but by looking at the general resemblance of the packages."[34] The rule has been recognized universally, the United States Supreme Court disposing of one case by saying "it is manifest that the general appearance of the package * * * is well calculated to mislead and deceive the unwary and all others."[35] The reason for the rule has possibly nowhere been better stated than by the late Mr. Justice Brewer, who said "elaborate descriptions of the points of resemblance or those of difference are, taken by themselves alone, always unsatisfactory. The eye, at a glance, takes in the whole of one exhibit and the whole of another; and the comparison thus made of the two is the surest, and the only satisfactory way of satisfying the judgment as to the existence of the alleged deceptive imitation."[36] Of course evidence of instances of actual deception is always admissible.[37]

In conclusion it is important to bear in mind that courts of equity have always avoided laying down any hard and fast rules by which to determine what constitutes fraud. The reason for this absence of set rules has been well stated as follows: "Were courts of equity to once declare rules prescribing the limitations of their power in dealing with it, the jurisdiction would be perpetually cramped and eluded by new schemes which the fertility of man's invention would contrive."[38]

When one who has been lawfully advertising himself as agent for a particular article has his agency revoked, he may be enjoined from the use of the word "agency" even

34—Stawell, C. J., in Wolfe v. Hart, 4 Viet. L. R. Eq. 134 (1878).

35—McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828.

36—P. Lorillard Co. v. Peper, 86 Fed. Rep. 956, 958; 30 C. C. A. 496.

37—Liggett & Myers Tob. Co. v. Finzer, 128 U. S. 182; 32 L. Ed. 395.

38—Weinstock, Lubin & Co. v. Marks, 109 Cal. 529-539.

though he continues to deal in the same articles as before;[39] and the agent may enjoin the use of a label naming him as the agent for the product.[40]

§ 143. Restraint of use of misleading advertisements and the like.—The requirement of fairness in trade has led to the injunction of the use of circulars containing garbled extracts from a letter, published for the purpose of diminishing plaintiff's sales, the part of the letter published having a meaning contrary to that of the letter as a whole.[41] The use of the autographic signature of the defendant's former distiller has been enjoined, when the distiller had withdrawn from defendant's employment and established a competing distillery.[42]

In testing the misleading character of the advertisement complained of, it will be considered as an entirety, rather than analyzed as to its parts. "The question whether any particular statement was true or otherwise is not a pertinent question; the really pertinent question is whether the advertisements as a whole were calculated to deceive."[43]

In a notable English case, the form of injunction granted against misleading advertisements was: "To restrain the defendant, his agents, servants, and work people, from further advertising, or issuing to the public, the posters, the cards, the catalogue, the advertisements, and the green card, and then generally from using the name 'Singer' in connection with sewing machines not of the plaintiff's manufacture, in any way calculated to induce the belief that such machines are the manufacture of the plaintiffs."[44]

In a case often referred to, the publishers of the "Times" were granted an injunction to restrain a dealer from advertising bicycles for sale in such a way as to induce the public to suppose that the proprietors of the "Times" were connected

39—Edison v. Hawthorne, 106 Fed. Rep. 172-174; affirmed under same title, 48 C. C. A. 67; 108 Fed. Rep. 839.

40—Coleman v. Flavel, 40 Fed. Rep. 854.

41—Halstead v. Houston, 111 Fed. Rep. 376.

42—George T. Stagg Co. v. Taylor, 95 Ky. 651; 27 S. W. Rep. 247.

43—Lord Parker, in A. G. Spalding Bros. v. A. W. Gamage, Ltd., 32 R. P. C. 273, 286.

44—Romer, J., in Singer Mfg. Co. v. James Spence & Co., 10 R. P. C. 297, 309.

with the sale.[45] This decision, as was said by Mr. Justice Romer, in a later case, was based on the fact that the plaintiffs "did not wish to be treated as vendors of cycles * * * it was an injury to them to be so treated, and on that ground the learned judge thought that the defendant ought to be restrained from doing what he did."[46]

It has been held that the use of the plaintiff's trademark in advertising matter, although not applied to his merchandise by the defendant, constitutes infringement of the trademark.[47]

In determining whether the advertisement is misleading in character, the rule adopted by Mr. Justice Kekewich seems eminently proper. The court should not hear opinion evidence as to whether the advertisement "is likely to deceive or not," but on that issue is to apply his own eye and his own intelligence, and try to put himself "into the position of a person of average intelligence wishing to buy" the advertised article. But fact witnesses who have seen the advertisement and gone to the advertiser in the false belief that he had the plaintiff's goods for sale are material witnesses and their testimony may be conclusive "that not only can persons be deceived, but that persons have been deceived."[48]

Of course there is "no property in the advertisement," and a defendant who copies plaintiff's advertising matter (specifically, the phrases "Why pay cash for seeds? We trust you") is not "in any way tampering with business or property" and will not be enjoined.[49]

§ 144. Infringement in another jurisdiction.—Where goods bearing an infringing mark are in possession of the defendant, within the jurisdiction, though intended for exportation, the jurisdiction of the court is complete and relief will be granted.[50]

But where the act of infringement occurs wholly in a foreign country an entirely different question is presented, and

45—Walter v. Ashton, L. R. (1902) 2 Ch. 282.

46—Wertheimer v. Stewart, Cooper & Co., 23 R. P. C. 481, 483.

47—Addley Bourne v. Swan & Edgar, Ltd., 20 R. P. C. 105, 120.

48—Singer Mfg. Co. v. British Empire Mfg. Co., 20 R. P. C. 313, 318, 319.

49—Wertheimer v. Stewart, Cooper & Co., 23 R. P. C. 481.

50—Orr-Ewing v. Johnson, 13 C. D. 434; 7 A. C. 219.

relief has been denied even though the court had jurisdiction over the parties, and the mark involved had been registered in the United States; Judge Kirkpatrick remarking that "to hold that the branding of goods in a foreign country with a trademark registered in the United States constitutes unfair competition in trade would be but another way of extending the trademark rights of a citizen of the United States beyond the borders of the country."[51]

§ 145. Trademarks of variable sound and pronunciation.— The owner of a valid trademark is, under all the authorities, entitled to equitable protection against one who subsequently adopts a mark calculated to create confusion of the goods of the respective parties.

Thus the use of the mark "Iwanta" was enjoined by Judge Lacombe because it was expressive of the same idea as "Uneeda" previously applied to biscuit,[52] and in a later case, where the owner of the trademark "Yusea" sought to enjoin the use of the mark "U-C-A" Judge Hazel said:

"The controlling contention in this action is whether the complainant, having a prior and exclusive right to the designation 'Yusea,' has thereby also obtained an exclusive right to the use of the various pronunciations and the complex words or syllabic formations to which this particular word is susceptible. A moment's reflection reveals the various pronunciations and composite words to which 'Yusea' may be adapted. A trademark which is variously pronounced and distorted to suit the purposes of trade and the fancies of the manufacturer in his endeavor to catch the public eye may yet be protected, within the fair and reasonable scope of a trademark, however artfully it may be conceived. It appears from the affidavits of complainant's manager and advertising agent, the person who conceived the word, that the common pronunciation by the trade in general is as if it were spelt 'You see a,' and that the mantles manufactured by complainant are commonly known as 'You-see-a mantles.' This is accentuated by the ordinary pronunciations that follow a casual observation of this complex word. The unique alterations in

51—Vacuum Oil Co. v. Eagle Oil Co., 122 Fed. Rep. 105.

52—National Biscuit Co. v. Baker, 95 Fed. Rep. 135.

the pronunciations of the word must, I think, be regarded as incidental to its use. This perhaps enhances its value as an advertising medium. They do not change the registered designation, and the word 'Yusea' remains the dominating word in the trademark. * * * The trademark, because of its variable sound and pronunciation, became more prominently known to the public, and thereby served the purpose for which it was conceived; *i. e.*, to attract the attention of the public to the original conception."[53]

§ 146. The effect of a plurality of marks for a single article.—It would seem obvious that a trader might acquire and own as many trademarks as he desires. It would seem that he might, if he desired, have as many different trademarks for the same article of merchandise as he saw fit. It seems perfectly clear that a trademark which is valuable because it attracts custom in one community may be utterly valueless in another.

The British decisions are replete with instances of special marks used for colonial trade, the same article being sold in Great Britain under a different mark. As a matter of fact many articles of merchandise are dealt in under a plurality of marks in this country, certain marks being used in the Northern trade, and different marks on the same merchandise for the Southern and Pacific Coast trade. It would seem that the courts would be as little concerned with the number of marks owned and used by a manufacturer as they would be with the number of patents or copyrights he might own or the number of any other chattels it might please him to acquire and for which he haply has the means to pay. And yet, these views which on their face appear manifestly obvious, are in conflict with the sole decision so far rendered upon this question and to which we will now briefly advert.

In *Candee v. Deere*,[54] the complainant manufactured "Moline" plows at Moline, Illinois. On different qualities of these plows they used the marks "A. No. 1," "A. X. No. 1," "No. 1," "X. No. 1," "No. 3," and "B. No. 1." The word

53—Welsbach Light Co. v. Adam, 107 Fed. Rep. 463, 465.

54—Candee v. Deere, 54 Ill. App. 439.

"Moline" being geographical, the complainant's case failed, and the letters and numbers being merely descriptive of different qualities of the plow did not help the complainant's case.

This case, consequently, appears quite irrelevant to the present question; but it has been used as the basis of the decision of Judge Jenkins dealing directly with the effect of ownership of a plurality of marks used on the same article, in which he says:

"The principal question which is suggested by the bill and the evidence is whether the manufacturer of a single article has the right to use, and be protected in the use of, more than one trademark for that article. I find little authority upon the subject, and have given to the question much consideration. Upon principle, I think that he can not. A trademark must denote origin. A trademark is defined by Mr. Upton to be the name, symbol, figure, letter, form, or device adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells, and distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and thus enable him to secure such profits as result from a reputation for superior skill, industry or enterprise. Upton, Trademarks, p. 9, c. 1. How can that purpose be accomplished, if a manufacturer dealing in a single article used a thousand different trademarks to designate the article and its origin? Such use necessarily produces confusion, and fails of the single purpose of the trademark, to designate with certainty the origin of the product. Certainly no manufacturer would, in regard of self-interest, indulge in such a practice; for he would thereby defeat the very purpose he sought to accomplish. This consideration has led me to the conviction that the complainant, the originator of perforated rolled toilet paper, would not do that which would blind the public mind to the originator and manufacturer of the article, and would tend to dissipate its trade. It is more probable (and the evidence, I think, sustains the conclusion) that its design was, by the various names, to distinguish between the size, shape, and quality of the paper manufactured, and that the marks were not placed thereon as indicating origin. The only authority which I have been able to find passing directly upon

this question is the case of *Candee v. Deere*, 54 Ill. 439, 457. In the conclusion reached by the Supreme Court of Illinois upon this particular question, I fully concur. It is remarkable that, with respect to so simple a product as that in question, it should be found that so large a number of claimed trademarks should be used by one manufacturer. A court of equity can not be impressed by an appeal to protect that which produces infinite confusion. It may be that in the struggle for trade the whims of retailers must be consulted, and that rivalry between dealers to present something attractive to the public eye must exist; but the courts of equity do not sit to indulge the whims of purchasers, or to protect one in creating confusion. They sit to protect and to enforce legal and equitable rights. If this bill can be maintained, the extent of the proprietorship of the complainant in the use of arbitrary names applied to the subject of toilet paper would be limited only by the imagination of its officers."[55]

§ 147. Confusion of mail matter as test of the right to injunction.—The fact that the use of the mails is involved in the majority of commercial transactions has made the question of the confusion of mail matter one of the tests most frequently applied in cases involving firm names, corporate names, and the like, to determine whether or not the plaintiff is entitled to the relief sought.[56] Thus we find in a case where the Continental Insurance Company of New York, sought to enjoin the Continental Fire Association of Texas from the use of its corporate name, Judge Meek gave as one of the principal grounds for denying the relief sought that "on account of the marked dissimilarity of the addresses of the two companies, mail matter intended for one of them will hardly be misdirected or miscarried to the other."[57] In a more recent case Judge Kohlsaat, in enjoining the name "Lilliputian Outfitters" at the instance of a complainant doing business as the "Lilliputian Bazaar," based the right or relief upon the prob-

55—Albany Perforated Wrapping Paper Co. v. John Hoberg Co., 102 Fed. Rep. 157, 158.

56—N. E. Lynn Shoe Co. v. Auburn-Lynn Shoe Co., 100 Me. 461; 62 Atl. Rep. 499.

57—Continental Insurance Co. v. Continental Fire Ass'n, 96 Fed. Rep. 846, 849

able confusion of mail matter, says, "It is evident that complainant is a manufacturer and dealer, and that he does a large mail-order business, as does also the defendant. It hardly needs saying that the proficiency of the mails at this date is such that every nook and corner of the nation as well as of Manitoba is as accessible as were places 50 miles away from New York a few years ago. It can not be otherwise than that the advertising and canvassing of these two rival concerns pass and repass each other innumerable times in their journeys to the centers of trade as well as to the homes of the people —mute contestants for the favor of supplying the wants of each customer."[58]

In a New York case, a plaintiff who was the originator of a proprietary remedy sold to the defendant his business and goodwill, including the sole right to use the names "Dr. David Kennedy, of Rondout, N. Y.," and "Dr. D. Kennedy, of Rondout, N. Y." It was subsequently held that the defendant had the right to receive and open all letters addressed to the plaintiff by either of the forms of addresses named.[59]

In a subsequent suit, the plaintiff sought to enjoin the defendant from receiving and opening letters addressed to him by name at Kingston, N. Y. In granting the injunction, Betts, J., said: "It ought to be an extremely difficult matter for one person or corporation to obtain the right to open and examine another person's private correspondence without his consent. There is something so repugnant in such a proposition to all our ideas of common fairness that to simply state it is to arouse antagonism thereto. I am of the opinion that this can never become the settled law of this state in any case unless it clearly and unequivocally appears that both parties at the time of making any contract, agreement, or bill of sale relating thereto clearly understood and agreed that that was to be the result of the arrangement entered into."[60]

In *American Clay Mfg. Co. of Pennsylvania v. American Clay Mfg. Co. of New Jersey*, 198 Pa. 189, 47 Atl. Rep. 936, the plaintiff was a Pennsylvania corporation, and the defendant

58—Ball v. Best, 135 Fed. Rep. 434, 437.

59—Kennedy Corp. v. Kennedy, 55 N. Y. Supp. 917.

60—Kennedy v. Dr. David Kennedy Corp., 66 N. Y. Supp. 225-229.

a corporation of New Jersey authorized to do business in Pennsylvania. Both were engaged in the same line of trade at Pittsburg, and the result was a confusion in correspondence and in the drawing and honoring of checks and drafts; and the defendants were enjoined. 'There are two classes of cases,' says Mitchell, J., 'involving judicial interference with the use of names: First, where the intent is to get an unfair and fraudulent share of another's business; and, second, where the effect of defendant's action, irrespective of his intent, is to produce confusion in the public mind, and consequent loss to the complainant. In both cases the courts of equity administer equitable relief.'"[61]

§ 148. Hotel, restaurant and theatre names and rights created thereby.—As we have seen elsewhere, as a general rule, the name of a place of business will be protected as against competitors who adopt misleading signs or other advertising matter in order to divert to themselves the business established by the one first adopting the name. It is apparent that there is this distinction between the names of hotels and the names of other places of business; as to other commercial enterprises there may be unfair competition between places of business located in different cities or sections, and doing a mail-order business, or transacting business generally by mail, while as to hotels, no such unfair competition can arise because there can be no confusion created by two hotels in different cities, having the same name. The names of hotels, moreover, stand in a class by themselves because of the complex character of the business involved. In one of the early opinions, Campbell, J., in a case involving the name "Irving House," drew this distinction in the following words: "We think that the principle of the rule is the same, to whatever subject it may be applied, and that a party will be protected in the use of a name, which he has appropriated, and by his skill made valuable, whether the same is upon articles of per-

61—Archbald, J., in Van Houten v. Hooton Cocoa & Chocolate Co., 130 Fed. Rep. 600, 603. That a decree is proper which provides that all mail doubtfully addressed shall be received by one party and opened in the presence of a representative of the other party, see J. I. Case Works v. J. I. Case Co. 162 Wis. 185; 155 N. W. Rep. 128.

sonal property which he may manufacture, or applied to an hotel where he has built up a prosperous business. * * * To make the application, if one man has, by close attention to the comfort of his guests, and by superior energy, made his hotel desirable for the traveler, and caused its name to become popular throughout the land, another man ought not to be permitted to assume the same name in the same town, and thus deprive him who first appropriated the name of some portion of the fruits of that goodwill which honestly belongs to him alone."[61a] Under this doctrine, the hotel names "Columbia,"[62] "McCardel House,"[63] "Osborn House,"[64] "Vonderbank Hotel,"[65] "What Cheer,"[66] "Woods Hotel,"[67] "Metuchen Inn,"[68] and "Hotel Dominion,"[69] have been recognized and protected in equity.

The owners of hotels have further been protected by injunction against the unauthorized use of the name of the hotel by persons running carriages and other conveyances for the transportation of travelers. Thus the proprietor of the Irving Hotel was granted an injunction against the use of the name of the hotel by the defendant upon his coaches, and upon badges worn by his employes. In granting the injunction, Cantel, J., said, "The question is, whether the defendants have committed a fraud. I can not doubt that their intention was to mislead, and to induce travelers to believe that they were servants of the proprietor of the Irving Hotel."[70] A similar rule was made in favor of the lessee of the "Revere House" under practically the same circumstances.[71]

More recently, the Supreme Court of New York granted an injunction to restrain the use of the name of the "Holland

61*a*—Howard v. Henriques, 3 Sandf. 725.

62—Whitfield v. Loveless, 64 Off. Gaz. 442.

63—McCardel v. Peck, 28 How. Pr. 120.

64—Hudson v. Osborne, 21 L. T. N. S. 386.

65—Vonderbank v. Schmidt, 44 La. Ann. 264.

66—Woodward v. Lazar, 21 Cal. 449; Gamble v. Stephenson, 10 Mo. App. 581.

67—Woods v. Sands, Fed. Case No. 17,963.

68—Busch v. Gross, 71 N. J. Eq. 805; 64 Atl. Rep. 754.

69—O'Grady v. McDonald, 72 N. J. Eq. 805; 66 Atl. Rep. 175.

70—Stone v. Carlan, Cox, Case No. 104.

71—Marsh v. Billings, 7 Cush. 322.

House" as a trademark for cigars. At the time that the cigars so marked were placed upon the market, there was no hotel of the name open for business in the city of New York. The plaintiffs were the proprietors of a building in the course of construction, which was to be used for hotel purposes, however, and that building was well known throughout the city of New York as the "Holland House." The injunction was granted upon the ground that the defendant intended to falsely represent to the public that the cigars were in some way connected with the hotel known as the "Holland House."[72] Where both parties used the words "Opera House,"—"contemporaneously * * * and without any definite intention to enjoy such use exclusively," both places of amusement being in the same locality, a suit for injunction was dismissed.[73]

The use of the same name by the owner of another class of building (for example, the later use of a name as that of a hotel which had been adopted for an apartment house) will not be enjoined in the absence of proof of damage.[74]

§ 149. Artistic productions as subjects of unfair competition.—Has the artist who creates a distinctive character in a picture any right to its protection aside from the copyright laws, assuming that the picture is not used as a trademark? Outcalt, a designer of comic pictures, exploited the character of "Buster Brown," in various pictures. He sold the pictures to a newspaper, by which they were copyrighted. Upon his application to enjoin that paper from publishing comic sections embracing pictures of "Buster Brown" in scenes and situations other than those in which Outcalt had depicted him, Judge Lacombe dismissed the motion as based upon a theory both novel and unsound.[75] It is to be hoped that the question will receive further judicial consideration. It is far from clear that the creator of such a figure of comic

72—Kingsley v. Jacoby, 20 N. Y. Supp. 44.

73—Chadron Opera House Co. v. Loomer, 71 Nebr. 785; 99 N. W. Rep. 649.

74—Astor v. West 82d Str. Realty Co., 152 N. Y. S. 631; 167 App. Div. 273.

75—Outcalt v. New York Herald, 146 Fed. Rep. 205.

illustrative purpose has no rights that a court of equity can recognize.

But where a charge of unfair competition is based upon the reproduction by the defendant of works of art which the complainant might have, but has not, copyrighted, a very different question is presented. The sale of the uncopyrighted work by the plaintiff is a dedication to the public, and the defendant or any other may copy the work by any process without being guilty of unfair competition.[76]

§ 150. Trade rights in patentable but unpatented articles. —Following the consideration of the question of unfair competition as applied to uncopyrighted works of art, it would seem equally obvious that, as to those features which are patentable, the right to patentable but unpatented machines, manufactures and designs would by two years' public use (see sec. 4886 R. S. U. S.; sec. 4933 R. S. U. S. as to designs) pass to the public, and that the doctrines of unfair competition could not be invoked to impair the public right therein. Thus, in the case of a new style of printing type, in denying equitable relief Judge Putnam said: "The type in question has no characteristics in particular, except that of utility; and, if the bill could be sustained, the plaintiff would obtain a perpetual patent for a useful article, running indefinitely, without any assistance from the patent office of the United States. On putting the question in this form, it is so clearly met by the law that it needs no discussion."[77]

So where plaintiff has an application for patent pending the defendant (until patent issues) has a clear right to make the article which is the subject of the application; but he has no right to copy every detail of form, shape and appearance of that article, and copy the plaintiff's advertising matter with its cuts and illustrations.[78]

One who attempts to keep his discovery a secret, while vending a product made under the process of his discovery,

76—Bamforth v. Douglass Post Card & Mach. Co., 158 Fed. Rep. 355, 357.

77—Keystone Type Foundry v. Portland Pub. Co., 180 Fed. Rep. 301, 303; affirmed in Keystone Type Foundry v. Portland Pub. Co., 186 Fed. Rep. 690; 108 C. C. A. 508.

78—Stewart v. Hudson, 222 Fed. Rep. 584.

over a term of years, filing application for patent only when the secrecy of his invention appears to be in jeopardy, may have his patent held void upon the ground of abandonment.[79]

§ 151. "The right to imitate."—This expression has been employed by Mr. Justice Holmes, in referring to the manufacture of "Artificial" Hunyadi water. It is an apt and comprehensive phrase, as pointing out the fact that the thing used by the plaintiff to distinguish his goods is a thing of common right, incapable of exclusive appropriation, and hence the defendant has, in a limited sense, "the right to imitate." The language of Mr. Justice Holmes is as follows: "If there is any well-founded doubt as to the right to use a personal tradename with proper guards against deception to signify what one is imitating, where one has the right to imitate, there can be none that one is at liberty to refer to a geographical expression to signify the source of one's model."[80] But the "right to imitate" must be exercised with great caution, and evidence that actual deception has resulted from the attempted exercise of that so-called right by the defendant will incline a court of equity very strongly against the defendant; for example, the sale of a whisky made in the United States under the name "Canadian Type" in competition with "Canadian Club."[81]

§ 152. **Use of machine manufacturer's name in sale of repair parts.**—The question of the right of a dealer in repair parts for machinery to describe those parts by the name of the machine in whose repair they are used, gives rise to the adjustment of the dealer's right to truthfully describe his repair parts, and the manufacturer's right to be protected against a misrepresentation that the parts are of his manufacture. The dealer in repair parts for Ford automobiles who advertised such parts prefixed with the word "Ford" was enjoined upon the doctrine that "While the defendant has a right to

79—Macbeth-Evans Glass Co. v. General Electric Co., 231 Fed. Rep. 183.

80—Saxlehner v. Wagner, 216 U. S. 375, 381; 54 L. Ed. 525; affirming Saxlehner v. Wagner, 85 C. C. A. 321; 157 Fed. Rep. 745.

81—Hiram Walker & Sons v. Grubman, 224 Fed. Rep. 725.

inform the public that he is manufacturing articles suitable for use on Ford machines, he should not be permitted to advertise them as Ford articles, but should be required to describe them in such a way as to indicate that they are not manufactured by the complainant."[82]

§ 153. Solicitation of customers by former employe.—It is still an open question whether one who has, as a salesman or otherwise, had the entree to customers, may on entering a competing employment solicit the trade of those customers. On principle, to prevent a salesman from continuing to sell goods to the same trade, but for another employer, would be to impose a burden on him which equity should not recognize or seek to impose. The Georgia court has well said, in such a case, "We are of the opinion, however, that he (the defendant) can not be restrained from selling his commodities, for himself or for any employer, in any part of the city, or to any person, so long as he does not use any property belonging to the complainant, or copies thereof that were surreptitiously made. So far we think ourselves well within equity jurisdiction, on general principles."[83]

The protection, by injunction, against the use of lists of customers of a former employer, has been granted in a number of cases, the injunction being made so broad as to restrain the employe and later employer from calling upon the customers named in such lists or soliciting their patronage, under circumstances aptly described as follows: "It follows that defendant tea company and its officers and agents will be restrained from obtaining the benefit of plaintiff's list of customers by hiring drivers away from the plaintiff for the purpose of having them canvass and solicit trade from the plaintiff's customers formerly served by them. That this was done in the case of Wahl and other drivers admits of no doubt.

"The defendant tea company undoubtedly has the right to solicit the trade of plaintiff's customers, and to obtain a list thereof by using opportunities for observation open to all. Plaintiff has no vested property rights in the trade of such

82—Brown, J., in Ford Motor Co. v. Wilson, 223 Fed. Rep. 808. Compare § 134, *ante*.

83—Fish, J., in Stein v. National Life Association, 105 Ga. 821 (1899).

customers. The vice of defendant's position is that it obtained the lists or copies thereof by hiring the drivers and made the lists of value to itself by sending the drivers to transfer, if possible, the trade from their former employer to their new employer. In other words, although the end might be lawful, the means adopted were unlawful. This is a case not of malicious interference with contracts where equity refuses to interfere unless the services are of a unique and special character, but of unfair competition. * * * The conduct of defendants amounts to an unlawful obtaining and use of a trade list."[84] And in most of the cases in which such relief has been granted it has been based upon the theft or surreptitious copying of the customer's list of the former employer, rather than upon any theory that, in the absence of such a physical thing as the stolen or copied list, there should be any denial of the employe's right to solicit the trade of the same customers for another employer;[85] but there are other cases having no such refinement to support them, in which the driver-salesmen of laundries or bakeries, in the absense of any written or printed list, have been enjoined from soliciting their former trade,[86] and these cases seem to the writer to be wholly vicious and opposed to public policy. They give to the first employer the power to deprive the employe of the right to earn a livelihood among the people to whom he is known, so that a contract of simple employment is, by judicial construction, converted into a covenant not to reengage in business on a particular route or with particular people. There is no consideration for such a covenant, and it is thought that the liberty of the customer, as well as the employe, is unwarrantably abridged by such decisions.

It must be conceded that the courts have gone a long way in curbing the activities of former employes. Not only has the employe been enjoined from soliciting the trade of his

84—Pound, J., in Witkop & Holmes Co. v. Great Atlantic & Pacific Tea Co., 124 N. Y. Supp., 956 (Sup. Ct., 1910).

85—Stevens & Co. v. Stiles, 29 R. I. 399.

86—Empire Steam Laundry Co. v. Lozier, 165 Calif. 95; 130 Pac. Rep. 1180; Smith v. Kernan, 8 Ohio Dec., reprint 32; Boosing v. Dorman, 133 N. Y. S. 910; 148 App. Div. 824.

former customers, but from selling to customers who, unsolicited, sought to buy goods from him.[87]

In following this line of procedure it has been several times held that the employe not only can not solicit the customers whose names were originally given him by the earlier employer, but that he could not solicit the trade of such customers as he had procured for the former employer by his own efforts.[88]

In all of the cases referred to, there was no question of business secrecy, and all proceeded upon the theory that there was an abuse of confidence when the salesman tried to profit by the trading acquaintance made in the course of his former employment. Logically, it is quite immaterial whether the solicitor was employed by a bakery, a laundry, or an insurance company; and amidst the flood of false reasoning attending this subject it is refreshing to find the Georgia court making this clear statement: "The relation of Stein to the association was not a confidential one in the sense that he, by reason of it, acquired a knowledge of any business secrets. * * * That knowledge of the policyholders which would be useful to him, in the event of his representing as agent another company, was not confided to him by the association, if derived from it at all. Persons may have taken out policies in the association on account of personal friendship for Stein or confidence in his integrity, and there is no reason why he should not be allowed to solicit their business for another company which he represents, his agency for the association having been terminated."[89]

In a New York case the injunction sought against an insurance solicitor was denied in an opinion which states: "The uncontradicted evidence tends to show, and the custom is so universal that the court may take judicial notice, * * * that the business of a fire insurance agent, at least in the smaller cities and towns, is to represent contemporaneously several insurance companies, and consists in soliciting per-

87—Loven v. People, 158 Ills. 159.

88—Witkop & Holmes Co. v. Boyce, 61 N. Y. Misc. 126; Empire Steam Laundry Co. v. Lozier, 165 Calif. 95; 130 Pac. Rep. 1180 (based on Calif. Civ. Code, § 1985).

89—Fish, J., in Stein v. National Life Association, 105 Ga. 821 (1899).

sons to permit the agent to place insurance for them, or in being solicited by those desirous of being insured, for the same purpose. Only in rare cases do those who seek insurance express preference for any one fire insurance company over another, or request that their insurance be placed in any particular company. The proof in this case tends to show that, for the three and one-half years Shipman was the agent of the plaintiff and other companies, he was rarely, if ever, requested to place insurance with any particular company, and exercised his own judgment in determining with which of the insurance companies he represented he would place the insurance. * * * The policyholder was free to renew with any company he might see fit or not to renew his policy at all. Shipman procured the insurance for the plaintiff in the first place from customers or patrons of his own. It is entirely lawful for the defendant, so long as he does not use for that purpose the information gathered exclusively from the plaintiff's property, to solicit these customers and patrons in behalf of any insurance company he may see fit, the plaintiff or any other, so long as he does not abridge the enjoyment by the plaintiff of his beneficial interest in existing contracts of insurance by inducing improper cancellations."[90]

It is the writer's conclusion that the more offensive decisions touching upon the question under consideration are due to the confusion of law with ethics, which is over-prevalent in modern judicial decisions as well as in modern legislation. In reaching the conclusion to grant the injunction the rights of the employe have been wiped out, in some instances, by treating his knowledge of the former employer's customers as "confidential knowledge," though no trade secret is involved, and the names and addresses of the customers could be lawfully ascertained by anyone who might see fit to follow the salesman in his daily or weekly canvass. One opinion of this type reads as follows:

> "The obligation of an employe not to divulge or use confidential knowledge gained in the course of his employment to the prejudice of his employer is the foundation of

90—Hooker, J., in National Fire Insurance Co. v. Sullard, 97 N. Y. App. Div. 233.

every contract of hiring. It is unfair for the defendant to take advantage of knowledge imparted to him in confidence and use that knowledge to destroy plaintiff's business. The defendant furnished an employe of plaintiff's competitor with information of plaintiff's customers for the purpose and which was used by such employe in making deliveries for such competitor, and he claims the right to personally go over the route, call upon each customer of the plaintiff whose name and address had been furnished him for the purpose of plaintiff's business, solicit orders for plaintiff's competitors, take up plaintiff's trading-stamp books from such customers, and issue a trading book of like stamp value to the customer furnished by plaintiff's competitor. If such conduct must be approved and adjudged to be right, proper, and lawful, there would seem to be no limitation upon the gross betrayal of confidence by an unscrupulous employe." [91]

In the case of an advertising solicitor Judge Grosscup stated very clearly what the writer conceives to be sound doctrine: "Complainant charges that Mahin has enticed away its clients, and has been procuring them to cancel contracts with the complainant not yet fully performed. As to the first part of this charge, I hold it was within Mahin's right, after the connection ceased, to not only receive, but to solicit, the patronage of these clients. Whether he could rightfully advise them to break existing contracts with complainant is another question." [92]

§ 154. Inciting breach of contract as unfair competition.— The general principles of the law of unfair competition extend to those acts, done in competition, which are designed to disturb the contractual relations between employer and employe, or between the plaintiff and a third party. Those principles came into existence long before the broad doctrines of the modern law of unfair competition came into existence. They were established before the day of Blackstone, and were originally developed in cases involving the enticement of the servant, or apprentice, from the master. They were expanded to include cases of inciting breach of the contracts of opera

91—Brown, J., in Witkop & Holmes Co. v. Boyce, 118 N. Y. Supp. 461, 464.

92—Proctor & Collier Co. v. Mahin, 93 Fed. Rep. 875, 876.

singers by the leading case of *Lumley v. Gye*, in 1853,[93] and the law governing the subject of incited breach generally was summed up by the late Mr. Justice Brewer as follows: "It has been repeatedly held that, if one maliciously interferes in a contract between two parties and induces one of them to break that contract to the injury of the other, the party injured can maintain an action against the wrongdoer."[94]

Since unfair competition became recognized as a distinct division of equity jurisprudence the courts have recognized that the cases of incited breach, where the tortfeasor was in commercial competition with the plaintiff, should be classified as unfair competition cases.[95]

Obviously, however, when a breach is incited by one who is not a business competitor of the party damaged by the breach, the tort is not of a kind to be considered in this book.

As between competitors, the reported cases disclose two general classes of acts done in procuring the breach. The first class of cases involves facts showing no deceit or misrepresentation, but the breach of the existing contract is obtained, or sought to be secured by persuasion or the offering of the same class of goods or service at lower cost, or possibly at the same cost. The knowledge of an existing contract, and the offer to one of the contracting parties of goods or service, the acceptance of which will necessarily induce the breach of that existing contract, has been deemed sufficient to create liability in some instances.[96] And in several cases one who has caused the breach of a contract by merely urging it and offering

93—Lumley v. Gye, 2 El. & Bl. 216; 75 E. C. L. 216.

94—Angle v. Chicago, etc., Railway Co., 151 U. S. 1; 38 L. Ed. 55.

95—They are referred to as unfair competition in the following cases: *Federal.* Citizens' Light, Heat & Power Co. v. Montgomery Light & Water Power Co., 171 Fed. Rep. 553; Sperry & Hutchinson Co. v. Pommer, 199 Fed. Rep. 309, 314; Lewis v. Bloede, 202 Fed. Rep. 7, 21. *Massachusetts.* Wheeler-Stenzel Co. v. American Window Glass Co., 202 Mass. 471. *New York.* American Law Book Co. v. Edward Thompson Co., 84 N. Y. Supp. 225. *Oklahoma.* Schonwald v. Ragains, 32 Okla. 223; 122 Pac. Rep. 203.

96—Heath v. American Book Co., 97 Fed. Rep. 533; Judge Jackson points out that the school-boards who breached at defendant's mere solicitation could not be recovered against; hence plaintiff, which had undoubtedly sustained damage, would have no remedy unless against the party so inducing the breach.

other goods in lieu of those contracted for, has been held liable to the party injured.[97]

But the better reasoning is that there must be evidence of force, misrepresentation or fraud employed in effecting the breach, or the third party is not liable.[98]

When such force, misrepresentation or fraud exist the liability of the wrongdoer is well settled. He may be liable also, because of offering to indemnify the breaching party against the consequences of his breach.

"The trader who has made a contract with another person has a right, which the law will protect, to have that other keep it. Other traders have a correlative right to solicit the custom to which the contract relates. Whatever damage results to the first trader by the mere solicitation is privileged, so far as the solicitor is concerned, in the interest of proper freedom of competition. Were the law otherwise, the first person occupying the field of public service in many localities, by procuring long contracts to take water, light, and the like from him, might intrench himself in a monopoly there for years, because another thereafter could not solicit customers, thus bound, to change their patronage to him, and thereby enable a rival enterprise to enter the field. The faithful observance of contracts, however, is as essential to the public welfare as the right of competition. Property rights, public and private morality, and liberty itself, are insecure when the law encourages the non-observance of contract obligations. Hence, while the law allows the trader by mere solicitation to persuade customers to change their business relations, it does not permit such a solicitor, even in the interest of competition,

97—*Federal.*—Sperry & Hutchinson Co. v. Associated Merchants' Stamp Co., 208 Fed. Rep. 205; *Maryland.* Cumberland Glass Mfg. Co. v. DeWitt, 120 Md. 381; 87 Atl. Rep. 927; *Massachusetts.* Wheeler-Stenzel Co. v. American Window Glass Co., 202 Mass. 471.

98—*Alabama.*—Tennessee Coal Co. v. Kelly, 163 Ala. 348; *California.* Boyson v. Thorn, 98 Cal. 578; 33 Pac. Rep. 492; *Indiana.* Jackson v. Morgan, 49 Ind. App. 376; 94 N. E. Rep. 1021; *Kentucky* Chambers v. Baldwin, 91 Ky. 121; Bourlier v. Macauley, 91 Ky. 135; 15 S. W. Rep. 60; *Missouri.* Glencoe Sand & Gravel Co. v. Hudson, 138 Mo. 439; 40 S. W. Rep. 93; *New York.* Ashley v. Dixon, 48 N. Y. 430; *North Carolina.* Swain v. Johnson, 151 N. C. 93; 65 S. E. Rep. 619; *North Dakota.* Sleeper v. Baker, 22 N. D. 386.

to go further, intervening actively between the contracting parties, as a dominant agency in producing a breach by promise of indemnity to one of them to induce the breach. When the solicitor knowingly and intentionally goes beyond mere solicitation to induce another man's customer to do business with him, and promise to hold that other man's customer harmless for breach of contract with him, he transcends the rights of the law of competition, has no 'sufficient justification,' and thereby becomes liable to him whose customer is taken over. Such conduct is an unlawful interference with another man's rights, for which he may maintain an action and recover nominal damages, although the contract be not actually breached in consequence of the solicitation." [99]

§ 155. **Contracts relating to stock quotations.**—In the case of stock market quotations, the contract being between a stock exchange and the telegraph companies and binding the latter to certain channels of distribution, the United States Supreme Court (by a vote of 6 to 3) has decided that injunction will lie against the telegraph companies and the unauthorized recipients, from the companies, of such quotations.[1]

In the seventh circuit it had been held by the circuit court of appeals that the exchange had a property right in the quotations,[2] a conclusion reaffirmed by the supreme court in a later case.[3]

§ 156. **Appropriation of "blind" advertising as unfair competition.**—The legal relationship of advertising to the business in which it is employed is not yet clearly established. The publication of a catch-word or catch-phrase, as the opening of an advertising campaign, is a frequent expedient. The name of the advertiser and the name of the product do not appear in the preliminary advertising, whose purpose is to

99—Jones, J., in Citizens' Light, Heat & Power Co. v. Montgomery Light & Water Power Co., 171 Fed. 553, 560 (C. C. 1909).

1—Chicago Board of Trade v. Christie Grain & Stock Co., 198 U. S. 236; 49 L. Ed. 1031.

2—Board of Trade v. L. A. Kinsey Co., 130 Fed. Rep. 507, 513; 64 C. C. A. 669.

3—"It is established that the quotations are property and are entitled to the protection of the law." Mr. Justice McKenna, in Hunt v. New York Cotton Exchange, 205 U. S. 322, 333; 51 L. Ed. 825.

arouse curiosity. When that theoretical curiosity is aroused, the names of the goods and the advertiser are disclosed to the impatient public. The first steps in such a campaign are styled "blind" advertising.

Obsessed by the idea that its proper field for new customers was among the dissatisfied customers of others, a St. Louis laundry published the word "Stopurkicken" (which it believed to be "an attractive misspelling and contraction of the phrase 'stop your kicking'") on signboards and printed cards. Before the key was published, an enterprising printing concern distributed cards bearing the advertised word, followed by its own name. This act obviously destroyed the value of the laundry's advertisement. An action for damages resulted in a nominal verdict and judgment for the plaintiff was reversed on appeal. The reversal was predicated upon the grounds that there was no trademark right in the word so advertised, and as it had not been used in connection with a disclosure of the plaintiff's name or business it had not been associated in the mind of the public with the plaintiff's business. There was also no competition at all between clothes-washing and the sale of printed matter, and therefore no unfair competition.[4]

It may be doubted whether the contemptible appropriation by another of such "blind" advertising can not be restrained or punished; the wrong and injury are manifest, and there should be a remedy. But the successful action will not be grounded on unfair competition unless the parties are competitors. "If there is no competition there is no unfair competition."[5]

4—Westminster Laundry Co. v. Hesse Envelope Co., 174 Mo. App. 238; 156 S. W. Rep. 767.

5—Carland, J., in Carroll v. Duluth Superior Mill. Co., 232 Fed. Rep. 675, 681 (C. C. A. 8); following Borden Ice Cream Co. v. Borden Condensed Milk Co., 201 Fed. 510; 121 C. C. A. 200; Corning Glass Works v. Corning Cut Glass Co., 197 N. Y. 173; 90 N. E. Rep. 449; Apollo Bros. v. Perkins, 207 Fed. 530; 125 C. C. A. 192; Investor Publishing Co. v. Dobinson, 82 Fed. Rep. 56; Forney v. Engineering News Publishing Co., 57 Hun. 588; 10 N. Y. Supp. 814; Hanover Star Milling Co. v. Allen, 208 Fed. Rep. 513; 125 C. C. A. 515; affirmed, 240 U. S. 403; Simplex Automobile Co. v. Kahnweiler, 162 App. Div. 480; 147 N. Y. Supp. 617; Astor v. West 82d Street Realty Company, 167 App. Div. 273; 152 N. Y. Supp.

§ 157. The appropriation of ideas, aside from patent, trademark or copyright, as unfair competition.—In many of the preceding sections in this chapter we have examined the borderland of industrial property rights. The ever recurring questions presented to the courts are, has the plaintiff a property right in this particular thing, and is there an invasion of that particular right? The whole body of the law of unfair competition is founded on the law of property. We return inevitably to considerations of the terms "property" and "rights," and the expansion of those terms to meet new needs are a strong test of the adaptability of equity to instant emergencies. Sir Frederick Pollock has tentatively defined the law of property as "the systematic expression of the degrees, and forms of control, use, and enjoyment, that are recognized and protected by law,"[6] with the suggestion that it may turn out to cover more than this, if we give the widest acceptable sense to the word property.

In the absence of copyright, a producer of talking-machine records sought to enjoin a competitor from selling records copied from those made by the plaintiff, his product being advertised as "duplicates from the original records." Judge Chatfield, in granting the injunction, appreciated the novelty and difficulty of the questions raised, and the lengths to which his decision might be used as in support of other claims of property right, more or less remote from the specific right challenged before him. His conclusions were reached as follows:

"Reference has been made to the rights of a photographer who should make a film for moving pictures, of some historical or unique occasion, and should sell the film to parties who should reproduce it in a moving-picture machine. Other parties might make pictures from the film, or from the exposure, and a question, in some respects, similar to the present, might be involved. A dressmaking establishment might employ high-priced designers, and their product might be copied, and the designs thus appropriated. Architects might build houses and utilize extremely valuable methods and ideas, and others

631; Sartor v. Schaden, 125 Iowa, 697; 101 N. W. 511.

6—First Book of Jurisprudence, Ch. VII.

building houses might follow these ideas. Sculptors might carve statues of great commercial value, and stone carvers might copy these sculptures. It can not now be determined how far such appropriation of ideas could be prevented; but it would seem that where a product is placed upon the market, under advertisement and statement that the substitute or imitating product is a duplicate of the original, and where the commercial value of the imitation lies in the fact that it takes advantage of and appropriates to itself the commercial qualities, reputation, and salable properties of the original, equity should grant relief."[7]

Reduced to its final analysis, the doctrine of this case is that if I make for sale a copy of another's unpatented, uncopyrighted physical production, I do so at my peril, having regard to the novelty, cost of production, and other distinctive features of the original. The right to multiply copies created by this decision would seem to make copyright statutes superfluous. The case would seem to present a typical *damnum absque injuria*, and to establish an extremely doubtful precedent.

This subject has been discussed in a number of cases, the *Fonotipia* case being one of rather extreme views. These cases can not readily be classified, but fall roughly into two divisions:

First, cases where the injunction has been granted upon the finding of fact that the copying of the plaintiff's merchandise resulted in the sale of defendant's merchandise as and for that of the plaintiff.[8]

7—Fonotipia Limited v. Bradley, 171 Fed. Rep. 951, 964.

8—Fonotipia Limited v. Bradley, 171 Fed. Rep. 951; Fox & Co. v. Glynn, 191 Mass. 344; 78 N. E. Rep. 89; 9 L. R. A. (N.S.) 1096; Steiff v. Bing, 215 Fed. Rep. 204; Strause v. Weil, 191 Fed. Rep. 527; Enterprise Mfg. Co. v. Landers, Frary & Clarke, 131 Fed. Rep. 240; 65 C. C. A. 587; Yale & Towne Mfg. Co. v. Alder, 154 Fed. Rep. 37; 83 C. C. A. 149; E. B. Estes & Sons v. George Frost Co., 176 Fed. Rep. 338; 100 C. C. A. 258; Stewart v. Hudson, 222 Fed. Rep. 584; U. S. Expansion Bolt Co. v. Kroneke Hdw. Co., 225 Fed. Rep. 383; Rushmore v. Manhattan S. & S. Works, 163 Fed. Rep. 939; 90 C. C. A. 299; 19 L. R. A. (N.S.) 269; Rushmore v. Saxon (C. C.) 158 Fed. Rep. 499; Baldwin v. Grier Bros. Co., 215 Fed. Rep. 735; Grier Bros. Co. v. Baldwin, 219 Fed. Rep. 735; 135 C. C. A. 433; Moxie Co. v. Daoust,

Second, cases where the injunctive relief has been denied upon the ground that the defendant has the absolute right to copy the plaintiff's merchandise so long as he "does not pretend that the copy is an original product of the complainant."[9] The ultimate distinction between this group of cases[10] and the former is that unfair competition is found to exist in the one group, and found absent in the other.

The cases under consideration are strongly analogous to those involving geographical or otherwise descriptive names which have acquired, through user, a secondary meaning.[11]

206 Fed. Rep. 434; 124 C. C. A. 316.

9—Keystone Type Foundry v. Portland Pub. Co., 108 C. C. A. 508; 186 Fed. Rep. 690.

10—Diamond Match Co. v. Saginaw Match Co., 74 C. C. A. 59; 142 Fed. Rep. 727; Rathbone, Sard & Co. v. Champion Steel Range Co., 110 C. C. A. 596; 189 Fed Rep. 26; 37 L. R. A. (N.S.) 258; Pope A. M. Co. v. McCrum-Howell Co., 112 C. C. A. 391, 40 L. R. A. (N.S.) 463; 191 Fed. Rep. 979; Rice & Co. v. Redlich Mfg. Co., 122 C. C. A. 442; 44 L. R. A. (N.S.) 1057; 202 Fed. Rep. 155; Armstrong Seatag Oyster Co. v. Smith's Island Oyster Co., 139 C. C. A. 656; 224 Fed. Rep. 100; Eisenstadt Mfg. Co. v. J. M. Fisher Co., 232 Fed. Rep. 957; Flagg Mfg. Co. v. Holway, 178 Mass. 83; 59 N. E. Rep. 667.

11—"In such cases the first question is always whether the points of similarity are essential features of the thing sold. When they are, the right to copy them is necessarily involved in the right to sell that particular thing; if the plaintiff is affected, it is his mischance that his manufacture has not become associated with some arbitrary and unessential feature. Yet even here it is often possible to insist upon the second comer's adding some arbitrary mark, itself not essential, by way of distinction. The case is in essence no different from those of the secondary user of descriptive or geographical names. The plaintiff in both cases finds himself in such a position that his customers have come to associate his make with some feature which in its origin did not represent him at all. It can make no difference that in cases of genuine secondary user the feature is itself a symbol, representative, but representative of something else than the plaintiff's manufacture, while in cases like this the feature was not originally a symbol at all. In each case the feature has become a symbol of the maker, and, when others use it, he runs the chance of losing his customers. There is equal reason in each case to compel the second comer to add some distinguishing mark to the feature to avoid its acquired meaning. Nor does it matter in substance whether the feature lies in the case or container or in the very thing itself. Coca Cola Co. v. Gay-Ola Co., 200 Fed. 720; 119 C. C. A. 164; Id., 211 Fed. 942; 128 C. C. A. 440; Hiram Walker & Sons v. Grubman (D.

Hence, the principles applied are those which we have heretofore considered.

In examining these cases, it is curious to note how far some courts have gone toward attempting to establish a *quasi* right of property in ideas, which has no existence at common law, and which, if it did exist, would obviate all necessity for patent or copyright statutes.[12]

C.) 222 Fed. Rep. 478. The limitation in application must be the feasibility of a mark which shall not be too burdensome.

"In cases like Enterprise Mfg. Co. v. Landers, Frary & Clark, 131 Fed. Rep. 240; 65 C. C. A. 587; Yale & Towne Mfg. Co. v. Alder, 154 Fed. Rep. 37; 83 C. C. A. 149; and Grier Bros. Co. v. Baldwin, 219 Fed. Rep. 735; 135 C. C. A. 433, there were features added by the defendant which could have no purpose, and, what is more to the point, no effect, except to mislead the buyer into supposing the goods were of the plaintiff's make. They could be subtracted from the article without affecting those features which controlled the buyer's choice. Such cases as Rushmore v. Manhattan Screw & Stamping Works, 163 Fed. Rep. 939; 90 C. C. A. 299; 19 L. R. A. (N.S.) 269; Lovell-McConnell Mfg. Co. v. American Ever-Ready Co., 195 Fed. Rep. 931; 115 C. C. A. 619; and Rushmore v. Badger Brass Mfg. Co., 198 Fed. Rep. 379; 117 C. C. A. 255, avowedly rest upon the same basis, yet the doctrine was in those cases pressed very far, since the design of a motor lamp or horn may well be a part of the reason why the buyer chooses them. To deny the second comer the right to use that design seems rather to step beyond the principle which protects only such symbols as are representative of the plaintiff's manufacture, nor does it seem an entirely adequate answer to say that the features enjoined are nonfunctional. It is only when the mechanical operativeness of the thing is certainly all that determines the buyer's choice that such a criterion is safe. Margarete Steiff, Inc. v. Bing (D.C.) 215 Fed. Rep. 204." Learned Hand, J., in Champion Spark Plug Co. v. A. R. Mosler & Co., 233 Fed. Rep. 112, 115.

12—"The defendants have made exact copies of the complainants' photographs by the half-tone process, and are selling the copies upon post cards at a much lower price than the originals can be sold. They have been engaged in this business for more than a year. At first they printed and sold their half-tone cards with the name "Bamforth & Co." thereon, as well as the titles of the pictures; but, upon the advice of counsel, the use of the complainants' name was soon discontinued. No cards bearing their name had been printed for several months before the bill was filed, and the defendants disclaim any intention to resume its use, conceding that such action on their part was improper, and that a threatened continuance thereof should be enjoined. But they claim the right to go on with the reproduction of the subjects and the

§ 158. Threats as unfair competition. That threatened acts which would tend to injure or destroy the wronged person's business, as well as baseless threats founded on no intention or basis of action, may under appropriate circumstances be enjoined, is well established.

titles of complainants' cards, taking the position that these cards are uncopyrighted photographs which have been dedicated to the public by repeated sales, and may therefore be copied freely by any person and by any process.

"In my opinion this position can not be successfully assailed. No question under the law of trademarks or the law of unfair competition is now involved. These cards are not trademarks, either singly or collectively, in any sense of the word. They do not identify and distinguish the complainants' product, but are the product itself; and there can be no question of unfair competition, because the complainants have no legal right to the exclusive production and sale. It would be useless to elaborate a subject so well understood. A photograph, if it be also an artistic production, the result of original intellectual conception on the part of the author, may be copyrighted with the same effect as if it were a book; but, without this protection of the federal statutes, neither the book nor the photograph can continue to be the author's exclusive property, after it has been printed and offered to the public for sale. No authorities need be cited for so plain a proposition. The copyright statutes would have been unnecessary if the author had been able to protect the fruit of his mental efforts in any other way; and, if he declines or omits to avail himself of the protection thus provided, he is conclusively presumed to have presented to the public the product of his creative powers, although he may have had no intention of making such a gift. No doubt a photograph might be adopted as a trademark to distinguish a manufactured article; but, how a photograph, if it be also a work of art and therefore capable of copyright, can be the subject of unfair competition, I am unable to understand. The only possible way to compete with such a photograph is to reproduce it, and any one may do this lawfully after it has been published, unless the protection of the federal statutes concerning copyright has previously been obtained. The question, therefore, does not belong to the region of unfair competition, but concerns the subject of copyright alone. If the photograph is artistic and has been copyrighted, its reproduction is forbidden. If no copyright at all, or—what comes to the same thing—no valid copyright, has been obtained, the author has no exclusive right in the product of his artistic skill, and to copy is therefore not to compete unfairly in a legal sense, but to compete with the full sanction of the law." J. B. McPherson, J., in Bamforth v. Douglass Post Card & Machine Co., 158 Fed. Rep. 355, 357.

A threat to refuse to sell goods to one under contract with a third party, if he proceeds to perform his contract is actionable.[13] So of a threat to ruin a customer of another if he persists in dealing with that other.[14]

A threat to dismiss the men under him if they continued to deal with a certain merchant was held to sustain a judgment for damages in a suit of the merchant against a railway foreman, who had a rival merchant as a tenant.[15] In Texas, however, it was held that a corporation having a company store on which it issued checks to its employes in lieu of pay, was not liable for threatening to discharge any employe who might deal with a competing merchant.[16]

Intimidation of a competitor's selling force by threats may be enjoined,[17] as well as threats by a board of fire insurance underwriters to boycott persons holding policies issued by the plaintiff corporation.[18] Threats made in the course of a conspiracy of competitors to ruin the plaintiff's business are actionable.[19]

Threats of suits for patent infringement, are peculiarly subject to the scrutiny of courts of equity, for the reasons concisely stated in a typical case by Judge Quarles:

> "If such a campaign be skillfully conducted for a series of years, as seems to have been the case here, the competitor is helpless. His orders are countermanded, old customers desert him, through fear of litigation, or demand bond of indemnity as a condition for placing orders. His business is melting away. Everywhere the trade is apprehensive of 'peremptory measures' if they buy goods of an infringer. He appeals to the patentee to bring suit, and offers to enter an appearance in any court having jurisdiction, but all to no purpose. Customers will not listen to his explanations or denials, and unless he can get relief in a court of equity, his business, which represents 20

13—Schonwald v. Ragains, 122 Pac. Rep. 203; 32 Okla. 223.

14—Standard Oil Co. v. Doyle, 118 Ky. 662.

15—Graham v. St. Charles St. R. Co., 47 La. Ann. 214.

16—Robison v. Texas Pine Land Ass'n. (Tex. Civ. App.), 40 S. W. Rep. 843.

17—Drake Hdw. Co. v. Wrought-Iron Range Co., 78 N. Y. Supp. 1114; Economist Furnace Co. v. Wrought-Iron Range Co., 86 Fed. Rep. 1010.

18—Continental Ins. Co. v. Board of Fire Underwriters, 67 Fed. Rep. 310.

19—Rourke v. Elk Drug Co., 75 N. Y. App. Div. 145.

years of effort, may be entirely ruined by a competition which is malicious and unfair."[20]

It is the general rule that a notice warning the public or specific dealers or users of a suit for patent infringement is not actionable unless it appears that the notices were not given in good faith, or that they were entirely without foundation in the scope of the defendant's patent.[21] The determination of the question of *bona fides* in the making of such threats is obviously of great difficulty at times. "The question whether the patent owner is acting in good faith in advertising his claims to the manufacturer's customers by circulars or letters can seldom be determined from the contents of the communication alone, and, like all questions of intent, must gen-

20—Dittgen v. Racine Paper Goods Co., 164 Fed. Rep. 85; affirmed 96 C. C. A. 433; 171 Fed. Rep. 631 (C. C. A. 7); Judge Blodgett stated the rule more fully in an early case: "The proof in this case also satisfies me that these threats made by defendants were not made in good faith. The proof shows that defendants brought three suits against Emack's customers, for alleged infringement of the Goodrich patent by selling the Emack slates; that Emack assumed the defense in these cases, and, after the proofs were taken, and the suits ripe for hearing, the defendants voluntarily dismissed them, the dismissals being entered under such circumstances as to fully show that the defendants knew that they could not sustain the suits upon their merits; that said suits were brought in a mere spirit of bravado or intimidation, and not with the *bona fide* intent to submit the question of infringement to a judicial decision. • • •.

"The effect of the circulars sent out by the defendant Kane certainly must have been to intimidate dealers from buying of the complainant, or dealing in slates of his manufacture, because of the alleged infringement of the Goodrich patent. No business man wants to incur the dangers of a lawsuit for the profits which he may make as a jobber in handling goods charged to be an infringement of another man's patent. The inclination of most business men is to avoid litigation, and to forego even certain profits, if threatened with a lawsuit which would be embarrassing and vexatious, and might mulct them in damages far beyond their profits; and hence such persons, although having full faith in a man's integrity, and in the merit of his goods, would naturally avoid dealing with him for fear of possibly becoming involved in the threatened litigation." Emack v. Kane, 34 Fed. Rep. 44.

21—Clip Bar Mfg. Co. v. Steel Protected Concrete Co., 209 Fed. Rep. 874; United Electric Co. v. Creamery Package Mfg. Co., 203 Fed. Rep. 53; Everett Piano Co. v. Bent, 60 Ills. App. 372.

erally be determined by the extrinsic facts."[22] The continued circulation of threats, coupled with failure to bring a suit to determine the questions of the validity of the patent and its alleged infringement are jointly considered as controlling evidence that the threats are not made in good faith.[23]

§ 159. Private actions for damages under the federal anti-trust acts.—The Sherman act (July 2, 1890, 26 Stat. L. 209, ch. 647) provides:

"§ 7. Any person who shall be injured in his business or property by any other person or corporation by reason of anything forbidden or declared to be unlawful by this act, may sue therefor in any Circuit Court of the United States in the district in which the defendant resides or is found, without respect to the amount in controversy, and shall recover three-fold the damages by him sustained, and the costs of suit, including a reasonable attorney's fee."

The cases arising under this section, so far as reported, are less than 60 in number, and but a small percentage have resulted in judgments for the plaintiff. But the section has been interpreted and enforced according to its terms, both as to entry of judgment for treble the amount of the verdict, and the addition of an amount fixed by the trial court as a reasonable attorney's fee.[24]

The right of action depends upon the fundamental question whether the acts complained of come within the condemnation of the act.[25] Next it must appear that the plaintiff has been injured in person or property by reason of the illegal contract or combination.[26]

The following plaintiffs have been held entitled to maintain the action. One who has, by reason of the agreement and combination of the defendants, been compelled to pay an

22—Wallace, J., in Adriance, Platt & Co. v. National Harrow Co., 58 C. C. A. 163; 121 Fed. Rep. 827, 829 (C. C. A. 2).

23—Electric Renovator Mfg. Co. v. Vacuum Cleaner Co., 189 Fed. Rep. 754.

24—Montague & Co. v. Lowry, 193 U. S. 38; 48 L. Ed. 608; affirming 115 Fed. Rep. 27; 52 C. C. A. 621; 63 L. R. A. 58.

25—Whitwell v. Continental Tobacco Co., 125 Fed. Rep. 454; 60 C. C. A. 290; 64 L. R. A. 689.

26—Monarch Tobacco Works v. American Tobacco Co., 165 Fed. Rep. 774.

unreasonable and excessive price for merchandise[27] or freight;[28] a cut-price book dealer who was unable to buy books because of the agreement of the publishers' association not to sell to price-cutters;[29] one who was unable to buy window glass of the quality and grade necessary to supply his customers, and thereby lost trade and custom;[30] a municipal corporation forced to pay an excessive price for iron pipe;[31] a corporation not actually engaged in business at the time of defendant's combination, that combination being formed to prevent the plaintiff from re-engaging in business;[32] a manufacturer injured by the boycott of a labor organization.[33]

Defendants who have participated in the wrongful combination will not be heard to complain that others in that combination should be joined as co-defendants.[34]

Although the jurisdiction of the federal courts is exclusive,[35] the sufficiency of the declaration will be tested by the local practice in civil actions.[36] It is not sufficient to follow the

27—United States Tobacco Co. v. American Tobacco Co., 163 Fed. Rep. 701.

28—Thomsen v. Union Castle Mail S. S. Co., 166 Fed. Rep. 251.

29—Mines v. Scribner, 147 Fed. Rep. 927

30—Wheeler-Stenzel Co. v. National Window Glass Assn., 152 Fed. Rep. 864; 81 C. C. A. 658; 10 L. R. A. (N.S.) 972.

31—Chattanooga Foundry & Pipe Works v. Atlanta, 203 U. S. 390; 51 L. Ed. 241.

32—Pennsylvania Sugar Ref. Co. v. American Sugar Ref. Co., 166 Fed. Rep. 254

33—Loewe v. Lawlor, 208 U. S. 274; 52 L. Ed. 488. Congress was fairly prompt in attempting to relieve labor unions from any liability of this kind in the future. The Clayton Act provides: "§ 6. That the labor of a human being is not a commodity or article of commerce. Nothing contained in the anti-trust laws shall be construed to forbid the existence and operation of labor, agricultural, or horticultural organizations, instituted for the purposes of mutual help, and not having capital stock or conducted for profit, or to forbid or restrain individual members of such organizations from lawfully carrying out the legitimate objects thereof; nor shall such organizations, or the members thereof, be held or construed to be illegal combinations or conspiracies in restraint of trade, under the anti-trust laws."

34—Atlanta v. Chattanooga Foundry & Pipeworks, 127 Fed. Rep. 23; 61 C. C. A. 387; 64 L. R. A. 721.

35—Loewe v. Lawlor, 130 Fed. Rep. 633.

36—Monarch Tobacco Co. v. American Tobacco Co., 165 Fed. Rep. 774.

words of the statute; the declaration should state the substantial facts constituting the alleged combination or contract,[37] and the acts done which resulted in damages to the plaintiff's business or property.[38] Where both an unlawful contract and an unlawful combination or conspiracy are relied on, they should be pleaded in separate counts.[39]

The Clayton Act (of October 15, 1914, 38 Stat. L. 730) has a similar provision:

> "§ 4. That any person who shall be injured in his business or property by reason of anything forbidden in the anti-trust laws may sue therefor in any District Court of the United States in the district in which the defendant resides or is found or has an agent, without respect to the amount in controversy, and shall recover three-fold the damages by him sustained, and the cost of suit, including a reasonable attorney's fee."

37—Gilley v. United Shoe Mach. Co., 152 Fed. Rep. 726.

38—Rice v. Standard Oil Co., 134 Fed. Rep. 464.

39—Rice v. Standard Oil Co., 134 Fed. Rep. 464.

CHAPTER IX.

REGISTRATION.

§ 160. **Introductory.**—The English Patents, Designs and Trademarks Act, 1883-1888, provides that there can be no institution of proceedings to prevent or to recover damages for the infringement of a trademark capable of registration unless it has been registered.[1] This provision does not occur in the Acts of Congress of 1881 or 1905, and could have no force or effect if it did, as there can be no valid trademark legislation by congress except under and by virtue of the commerce clause of the federal constitution (clause 3 of sec. VIII). As stated by Mr. Justice Miller: "When, therefore, congress undertakes to enact a law which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several states, or with Indian tribes. If not so limited, it is in excess of the power of congress."[2]

§ 161. **The invalid registration acts.**—In order to obtain a substantial idea of the difficulties which have attended our national legislation upon trademarks, it is only necessary to read the text of the several enactments of congress, which are collated in the appendix to this book. The Act of July 8, 1870, was based upon an entire misconception or disregard of the power resident in congress. Both it and the subsequent penal Act of August 14, 1876, were framed with the evident intention of providing a uniform trademark law for the several states. As will be seen by reference to the annotations to those acts, in the appendix, their validity was questioned and negatived upon circuit,[3] and it was finally settled by

1—46 and 47 Vict., c. 57, § 77; Hazzopulo v. Kaufmann, 23 Sol. J. 819; Goodfellow v. Prince, L. R. 35 Ch. D. 9.

2—Trademark Cases, 100 U. S. 82; 25 L. Ed. 550.

3—Leidersdorf v. Flint, 8 Biss. 327, Fed. Case No. 8,219.

the supreme court that they were unconstitutional and therefore void.[4]

§ 162. The power of congress to protect trademarks.—"The commerce clause of the federal constitution presents the remarkable instance of a national power which was comparatively unimportant for eighty years, and which in the last thirty years has been so developed that it is now, in its nationalizing tendency, perhaps the most important and conspicuous power possessed by the federal government."[5]

With the judicial determination that the Act of July 8, 1870, was void, came the realization by congress that within the scope of authority contained in the words "The congress shall have power * * * to regulate commerce with foreign nations, and among the several states, and with the Indian tribes," must rest the foundation for its future trademark legislation. With this fact before it, congress proceeded to the enactment of the Act of March 3, 1881, embodied in the supplement to the Revised Statutes as sec. 322. No reason appears for the fact that under that act protection and the benefits of registration were extended only to "owners of trademarks used in commerce with foreign nations or with the Indian tribes," and not to owners of trademarks used in interstate commerce. But such is the fact, which it was left to future legislation to remedy.[6]

§ 163. The constitutionality of the present registration act.—It is a remarkable fact that during the period from March 3, 1881, to February 20, 1905, the question of the constitutionality of the Act of 1881 was never passed upon by any court.

4—Trademark Cases, 100 U. S. 82, 25 L. Ed. 550.

5—Prentice & Egan, Commerce Clause of the Federal Constitution, p. 1.

6—"The laws of the United States now in force * * * relate only to trademarks specially used in commerce with foreign nations, or with the Indian tribes. Act of March 3, 1881 (21 St. at Large, Ch. 137, § 1). They are particularly restricted so as not to give cognizance to any court of the United States in an action or suit between citizens of the same state, unless the trademark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe." Wheeler, J., in Luyties v. Hollender, 21 Fed. Rep. 281.

The Court of Appeals of the Seventh Circuit, speaking by Judge Jenkins, held that the validity of the Act of 1881 was "fairly doubtful."[7]

In the same case, the United States Supreme Court expressly declined to pass upon the question of constitutionality.[8]

So the Act of 1881, more limited in its scope, and essentially a mere registration act, has been superseded by an act of much wider scope, while as yet the power of congress to create any enactment whatever relative to the registration of trademarks was not only undetermined, but clouded by the doubt expressed in the language of the Court of Appeals of the Seventh Circuit. The labor performed by that court in the development of the law of unfair competition entitles its dictum to high respect; and because of the doubt which that court had seen fit to express, as well as the likelihood that the broad scope of the present trademark act would cause its constitutionality to be determined at no distant date, it may be well to note the argument which suggested itself as that which must be overcome if the present act was to be held constitutional.

It being conceded that the jurisdiction of congress over the subject of trademarks, if it has any at all, aside from the treaty-making power, arises solely by authority of the commerce clause of the federal constitution, it was urged that unless trademarks themselves are the subjects of interstate commerce, the jurisdiction of congress fails.

A trademark, as we have seen elsewhere, is an incorporeal hereditament, having no independent life or existence of its own, but existing only as appendant to the goodwill of a business, or as an integral part of that goodwill. When the trademark is applied to an article of commerce, that article may be the subject of interstate commerce, but it by no means follows that the trademark affixed upon the article, or the package containing the article, is itself being dealt with as

7—Illinois Watch Case Co. v. Elgin National Watch Co., 94 Fed. Rep. 667 669; 87 Off. Gaz. 2323; 35 C. C. A. 237.

8—Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S. 665-667; 45 L. Ed. 365. And see Warner v. Searle & Hereth Co., 191 U. S. 195-205; 48 L. Ed. 145; affirming Searle & Hereth Co. v. Warner, 50 C. C. A. 321; 112 Fed. Rep. 674.

a subject of interstate traffic. This distinction, it has been urged, is amply supported by the language of the supreme court in *Champion v. Ames*, 188 U. S. 321, 47 L. Ed. 492, where it is said that "Lottery tickets are *subjects of traffic, and therefore of commerce.*"

The status thus fixed upon lottery tickets as the subjects of interstate commerce is curiously distinguished from policies of fire and marine insurance by the supreme court; but the language which that tribunal has more than once employed in reference to insurance policies is instructive as indicating its probable attitude toward trademarks. Thus in one of the later insurance cases, Mr. Justice McKenna says: "The contract of insurance is not an instrumentality of commerce. The making of such a contract is a mere incident of commercial intercourse."[9]

The distinction between lottery tickets and insurance policies is one which has not only baffled the layman, but aroused much discussion between members of the bar; but in the language of the supreme court in the lottery cases, and in the insurance cases, the court has uniformly held that nothing which is not an instrumentality of commerce can come within the purview of the interstate commerce clause of the constitution.

In *Williams v. Fears*, 179 U. S. 270, 45 L. Ed. 186, Mr. Chief Justice Fuller has emphasized "the difference between interstate commerce or an instrumentality thereof on the one side, and the mere incidents which may attend the carrying on of such commerce on the other."

It would seem clear that the sharpest attack upon the constitutionality of the present act would be along the line of the cases referred to, and if the court determined as a matter of fact, that trademarks were mere incidents attending the carrying on of interstate commerce, it would necessarily follow that the present act, as well as its predecessor, has been founded upon a misconception of the jurisdiction of congress. Without weighing the argument, or pursuing it in the light of other decisions of the supreme court, such as those which relate to bills of lading and the like, and without ven-

9—New York Life Insurance Co. v. Cravens, 178 U. S. 389-401; 44 L. Ed. 1116.

turing a personal opinion upon the merits of the argument, it will suffice to say that the present act is of extremely doubtful constitutionality, and that sec. 17, giving jurisdiction to certain courts over trademarks registered in accordance with the provisions of the act, without regard to the amount in controversy (a provision incorporated from sec. 7 of the Act of 1881) offers the opportunity of readily raising the constitutional question. It is manifestly desirable that the question should be raised and finally disposed of in the near future, that it may be definitely settled.

This argument is substantially embodied in the report of the Committee on the Judiciary of the House of Representatives during the Forty-sixth Congress, as a result of the deliberations of that committee upon a resolution to amend the constitution, and a proposed bill for which the Act of 1881 was subsequently substituted. The proposed amendment to the constitution is embodied in the committee's report, a portion of which is as follows: "The bill seeks to re-enact substantially the trademark legislation of 1870 (Rev. Stat., secs. 4937-4947, inclusive) save that it is confined to foreign and interstate commerce. Its theory is that by thus separating them from interstate commerce the objections of the supreme court as to constitutionality will be removed.

"The resolution to amend the constitution is as follows:

"ARTICLE XVI.

"Section 1. Congress for promotion of trade and manufacture, and to carry into effect international treaties, shall have power to grant, protect, and regulate the exclusive right to adopt and use trademarks.

"It is based upon the idea that such legislation, though confined to foreign and interstate commerce, is unconstitutional, or its advocates may only fear that that may be so, and wish the amendment *ex abundante cautela*, and to give confidence to those using trademarks.

"If the Congress of the United States now has power to pass such laws, the amendment would be useless. Has it that power?

"After careful consideration we are of the opinion that it has not. The supreme court in the foregoing opinion avoided deciding that question. A trademark is a convenience of commerce. Its purpose is to identify the thing to be sold.

"But it is no more than the guaranty in writing, or by some words, sign, or device, attached to the thing to be sold, that it is what the seller represents it to be by such writing, etc. By themselves they are not merchandise. Their only use is to attach to merchandise for such identification. They are not necessary to commerce. On the countless things sold in this country, foreign and domestic, there are no trademarks but on about 8,000.

"In *Paul v. Virginia* (8 Wallace 168, 19 L. Ed. 359), the court held that congressional control did not cover policies of insurance sent from one state of the Union into another where a premium was paid therefor. They said the policies were but 'mere contracts of indemnity against loss by fire.' We think trademarks mere contracts of indemnity against loss by fraud.

"Thus the supreme court has held a contract to be within federal control in *Almy v. California*. That was a bill of lading for goods to be shipped out of the state. But that decision rested solely upon the ground that 'a bill of lading or some other instrument of the same import is necessarily always associated with every shipment of articles of commerce from the ports of one country to another. The necessities of commerce require it.' (See *Almy v. California*, 24 Howard, 170, 16 L. Ed. 644.) And that decision rests not on the power of congress over commerce, but on the prohibition against the states taxing exports, etc. The bill of lading was but evidence of the contract of shipping. Taxing it, taxed the exported article. And in the *Pensacola Telegraph Company v. Western Union Telegraph Company* (96 U. S. 9, 24 L. Ed. 710) the court pronounced the telegraph 'one of the necessities of commerce. It in indispensable as a means of intercommunication, but especially so in commercial transactions.' We think this last case could better stand on the power 'to establish postoffices and post-roads.' Yet, if put on the commerce clause, like *Almy v. California*, it is based on the necessity of the thing legislated upon to foreign or interstate or Indian commerce. As we

have said, trademarks are not necessary to such commerce. But even if they were, our opinion would be unchanged. In the case of Steffens, quoted above, the court said:

"'It is not every species of property, which is the subject of commerce, or which is used or even essential in commerce, which is brought by this clause of the constitution (commerce clause) within the control of congress. The barrels and casks, the bottles and boxes in which alone certain articles of commerce are kept for safety, and by which their contents are transferred from the seller to the buyer, do not thereby become subjects of congressional legislation more than other property.'

"But while we think congress can not so legislate with regard to trademarks under the power 'to regulate commerce with foreign nations, and among the several states and with the Indian tribes' (art. I, sec. 8, constitution), trademarks, in commerce with foreign nations and with the Indian tribes, can be protected under the treaty-making power." [10]

It therefore appears that the Act of 1881 was passed on the theory that it came within the treaty-making power of congress. The present act can not be sustained upon that theory; it must be sustained, if at all, as a regulation of interstate commerce.[11]

§ 164. The advantages of registration.—The local registration statutes of the several states are too numerous and involved to be treated here.[12] The federal courts can not enforce rights created by state registration, at least as to alleged infringements occurring outside the state in which registration was had.[13]

As to federal registration, Judge Hawley has said that "registration under the Act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trademark, or in cases where it is necessary to give jurisdiction to the United States

10—Con. Record, Vol. 10, part 2, p. 1514.

11—See Rossmann v. Garnier, 128 C. C. A. 73; 211 Fed. Rep. 401; Thaddeus Davids Co. v. Davids, 233 U. S. 461; 58 L. Ed. 1046.

12—See Appendix F.

13—Rehbein v. Weaver, 133 Fed. Rep. 607.

courts."[14] As against a citizen of the same state, a registrant under that act had not even the right to sue in a court of the United States, unless it could be shown that both the original and infringing marks were being used in commerce with foreign nations or the Indian tribes.[15]

The certificate of registration is only *prima facie* evidence of ownership of the trademark registered, and is not conclusive or binding upon the courts as to the right of a party to its exclusive use.[16]

No right is created by the registration of a generic name,[17] nor by the registration of a mark unrestricted as to form or color, as "a colored streak applied to or woven in a wire rope."[18]

Obviously, a trademark applied to a patented article during the life of the patent, can not be saved, by registration,

14—Hennessy v. Brauschweiger & Co., 89 Fed. Rep. 664-668. Quoted and followed in Sleepy Eye Milling Co. v. C. F. Blanke Tea & Coffee Co., 85 Off. Gaz. 1905. To the same effect see Einstein v. Sawhill, 65 Off. Gaz. 1918; Sherwood v. Horton, Cato & Co., 84 Off. Gaz. 2018.

15—Ryder v. Holt, 128 U. S. 525; 32 L. Ed. 529; Luyties v. Hollender, 22 Blatchf. 413; Schumacher v. Schwenke, 26 Fed. Rep. 816; Gravely v. Gravely, 42 Fed. Rep. 265; Prince's Metallic Paint Co. v. Prince Mfg. Co., 53 Fed. Rep. 493.

16—Hennessy v. Braunschweiger, *supra;* Brower v. Boulton, 53 Fed. Rep. 389; Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 824-826. In the latter case Judge Wallace observed: "The act of congress makes the registration of the mark only *prima facie* evidence of ownership. § 7. The inquiry is therefore always open as to the validity of the title to a trademark evidenced by the registration. The registration could not confer a title to the trademark upon the complainant if some other corporation or individual had acquired a prior right by adoption and use; nor could it vest defendant with a title as against the complainant's common law title. In this view the only office of a registration is to confer jurisdiction upon the court to protect a trademark when the proprietor has obtained the statutory evidence of title, and the only function of the commissioner of patents is to determine whether an applicant has a presumptive right to the trademark." To the same effect see Deitsch v. Geo. R. Gibson Co., 155 Fed. Rep. 383.

17—Liebig's Extract of Meat Co. v. Walker, 115 Fed. Rep. 822-826.

18—A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 134 Fed. Rep. 571; 67 C. C. A. 418; 201 U. S. 166; 50 L. Ed. 710.

from becoming *publici juris* upon the expiration of the patent.[19]

The certificate of registration is only *prima facie* evidence of an admission on the part of the government that the applicant for registration is the owner of a valid trademark, is not a grant of any right or privilege, and does not, therefore, conclude a third party;[20] but it is conclusive as against the registrant, as limiting and restricting what he can claim as his trademark.[21] Notwithstanding its registration under the act, the trademark of an insolvent will be conveyed by a general assignment for the benefit of creditors,[22] and it has been held under all the various bankruptcy and insolvency laws that all trademarks of the bankrupt or insolvent pass to the trustee or assignee.[23]

§ 165. The disadvantages of registration.—As indicated in the preceding section, registration under the act was held to "operate as evidence tending to show what was really claimed."[24] Judge Acheson has said "it would be a perversion of the right to registration under the Act of Congress, * * * and would amount to a fraud on other traders, to permit the plaintiff now to assert broader rights in the anchor as a trade symbol than his public registry in 1885 disclosed. * * * Sec. 10 gives no countenance to the idea that a person, availing himself of the benefits of the act, may register as his trademark a peculiar representation of a common emblem, exhibiting special and distinguishing features and a particular combination, and yet afterwards claim the emblem pure and simple, without regard to such features or combi-

19—Sternberg Mfg. Co. v. Miller, Du Brul & Peters Mfg. Co., 161 Fed. Rep. 318; 88 C. C. A. 398.

20—United States v. Braun, 39 Fed. Rep. 775.

21—Kohler Mfg. Co. v. Beeshore (2), 59 Fed. Rep. 572; Richter v. Reynolds, 59 Fed. Rep. 577; 8 C. C. A. 220; Adams v. Heisel, 31 Fed. Rep. 279, 281; Kohler Mfg. Co. v. Beeshore (1), 53 Fed. Rep. 262, 264; Richter v. Anchor Remedy Co., 52 Fed. Rep. 455; Pittsburgh Crushed Steel Co. v. Diamond Steel Co., 85 Fed. Rep. 637.

22—Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624.

23—Warren v. Warren Thread Co., 134 Mass. 247; Wilmer v. Thomas, 74 Md. 485; 22 Atl. Rep. 403.

24—Shiras, Circuit Justice, in Kohler Mfg. Co. v. Beeshore, 8 C. C. A. 215; 59 Fed. Rep. 572, 576.

nation. To tolerate this would be to defeat the very purpose of the act."[25]

In a later case, Judge Adams held that by failing to include the letter S as part of a registered mark, the registrant "must be held to have abandoned this feature of its mark, if it had ever employed it, to the public, and thereby, to have disclaimed any exclusive right to it;"[26] and a similar ruling has been made by the Court of Appeals of Kentucky.[27] Judge Reed has very properly held that where certain parts of the mark shown and described in a registration are recited to be essential, the other parts will be held not to be a part of the trademark.[28] It is consequently well established that registry of less than the whole trademark is tantamount to an abandonment of the remainder.[29]

By sec. 28 of the Act of 1905, it is provided, "That it shall be the duty of the registrant to give notice to the public that a trademark is registered, either by affixing thereon the words 'Registered in U. S. Patent Office,' or abbreviated thus, 'Reg. U. S. Pat. Off.,' or when, from the character or size of the trademark, or from its manner of attachment to the article to which it is appropriated, this can not be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; and in any suit for infringement by a party failing so to give notice of registration no damages shall be recovered, except on proof that the defendant was duly notified of infringement, and continued the same after such notice."

This section is directly modeled upon the corresponding section of the patent statute, which is as follows:

> Sec. 4900. "It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under

25—Richter v. Anchor Remedy Co., 52 Fed. Rep. 455, 458; affirmed under the style of Richter v. Reynolds, 8 C. C. A. 220; 59 Fed. Rep. 577.

26—Pittsburg Crushed Steel Co. v. Diamond Steel Co., 85 Fed. Rep. 637, 638.

27—Geo. T. Stagg Co. v. Taylor, 95 Ky. 651; 27 S. W. Rep. 247.

28—L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624, 625.

29—P. C. Weist Co. v. Weeks, 177 Pa. 412; 35 Atl. Rep. 693.

them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word 'patented,' together with the day and year the patent was granted; or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented."

Under the latter section, Mr. Justice Gray has said "one of these two things, marking the articles, or notice to the infringers, is made by the statute a prerequisite to the patentee's right to recover damages against them.

Each is an affirmative fact, and is something to be done by him. * * * By the elementary principles of pleading, therefore, the duty of alleging, and the burden of proving either of these facts is upon the plaintiff."[30]

Therefore, by registration under the Act of 1905, the registrant has this burden imposed upon him.

§ 166. **Interferences.**—The rules established by the decisions of the patent office in relation to interferences under the Act of 1881 are of value in like proceedings under the present Act. Sec. 3 of the Act of 1881 provided that "In an application for registration the commissioner of patents shall decide the presumptive lawfulness of claim to the alleged trademark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases."

§ 167. **Between a registrant and an applicant,** the burden of proof is on the applicant, for the reason that the certificate under sec. 16 of the act is *prima facie* evidence of ownership.[31] In such a case, Allen, commissioner, has held that the applicant must establish "a date of use in the United States

30—Dunlap v. Schofield, 152 U. S. 244, 248; 38 L. Ed. 426, 427.

31—Sherwood v. Horton, Cato & Co., 84 Off. Gaz. 2019; Sibley Soap Co. v. Lambert Pharmacal Co., 103 Off. Gaz. 2172. See § 7, Act of 1905, and Patent Office Rule 44, Appendix E.

prior to the date of the other party's registration,"[32] and that registration by the applicant under the Act of 1870 "amounts to nothing more than a publication."[33]

§ 168. The preliminary statement.—In patent interferences a formal preliminary statement is required from each of the parties. In trademark interferences the statement accompanying the application for registration performs the same functions and is treated as a preliminary statement.

The rule of the Patent Office in relation thereto formerly provided that each applicant and registrant would be held to the date of adoption alleged in the statement filed with his application. But even under that rule Duell, commissioner, held that evidence of use antedating that set up in the application of the party offering it may be considered and such weight given to it as "may be proper under the circumstances of the case."[34] Subsequently, on an application for leave to file an amended statement, Allen, commissioner, in denying the application held that an amendment could be filed after the determination of the question of priority.[35]

Manifestly, however, evidence offered to prove a date earlier than that set up in the statement must be regarded with some suspicion. In the language of Allen, commissioner, "it is to be presumed that this statement filed with the application for registration was made after proper inquiry, and while it is not binding upon the parties to an interference proceeding it is still entitled to considerable weight."[36]

§ 169 The issues in interference, opposition and cancellation proceedings.—The purpose of an interference is to determine the question of priority of adoption and use as between the parties to the interference. Evidence of prior use by a stranger to the interference will not be considered.[37]

32—Broderick & Bascom Rope Co. v. A. Leschen & Sons Rope Co., 100 Off. Gaz. 3011.

33—Auerbach & Sons v. Hall & Hayward Co., 111 Off. Gaz. 806.

34—Manitowoc Mfg. Co. v. Dickerman, 57 Off. Gaz. 1721,

35—Vanden Bergh & Co. v. Belmont Distilling Co., 99 Off. Gaz. 1624.

36—Auerbach & Sons v. Hall & Hayward Co., 111 O. G. 866.

37—Carey v. New Home Sewing Machine Co., 101 Off. Gaz. 448

An interference in fact exists where the marks are so similar as to be calculated to deceive the public, and are used upon classes of goods so closely related that when bearing the same mark one would suppose that they are the product of the same manufacturer.[38]

Cancellation.—Section 13 of the Act of 1905 provides "That where any person shall deem himself injured by the registration of a trademark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof." This provision applies only to registrations under the Act of 1905.[39] The petition for cancellation must show that the petitioner has been injured.[40] The Patent Office has no authority to cancel a certificate of registration except under sec. 13.[41]

Oppositions.—Section 6, Act of 1905, provides that any person who believes he would be damaged by the registration of a mark may oppose that registration. Section 7 provides for notice to the applicant. The notice of opposition must allege facts showing an interest on the part of the opposer from which damage may be inferred.[42] The applicant may plead[43] or demur[44] to the notice of opposition.

38—B. A. Corbin & Son v. Miller, Kolthepp, Griese & Co., 98 Off. Gaz. 1455.

39—Funke v. Baldwin, 127 Off. Gaz. 392.

40—E. McIlhenny's Sons v. New Iberia Co., 133 Off. Gaz. 995.

41—Case v. Quirk, 136 Off. Gaz. 1531. For practice in cancellation proceedings see notes, § 13, Act of 1905, Appendix E, *post*.

42—Underwood Typewriter Co. v. A. B. Dick Co., 163 Off. Gaz. 730.

43—Deitsch v. Loonen, 141 Off. Gaz. 1161.

44—W. A. Gaines & Co. v. Knecht & Son, 120 Off. Gaz. 1163. For practice in opposition proceedings see notes, §§ 6, 7, Act of 1905, Appendix E, *post*.

CHAPTER X.

COURTS, PARTIES AND PROCEDURE.

§ 170. Introductory.—The person who has been injured by trademark infringement or other unfair competition usually has some latitude in the selection of a forum. In some of the states the courts have exhibited a willingness to furnish redress for this species of fraud, in others this indication is lacking. The prospective plaintiff will choose between the state and federal courts, where federal jurisdiction exists, with a view to selecting the one in which the law of the subject is well settled, and in which the *nisi prius* judge has not exercised his inventive genius in devising excuses for fraud.

The plaintiff may be able to invoke the criminal process of the state courts, under a particular statute. A search warrant may be obtainable under such an act, and aid in the preparation of a subsequent civil suit. The nature of the unfair competition may be such as to warrant the filing of information with the Federal Trade Commission.

Where federal jurisdiction exists, by reason of registration of the trademark infringed, or by reason of diversity of citizenship (the amount in controversy being sufficient), the action is usually brought in the federal court, and by bill in equity. Hence this chapter will be devoted largely to a consideration of federal practice and procedure in the class of cases under discussion.

§ 171. Jurisdiction of United States district courts.—Sec. 7 of the Act of 1881 provides that courts of the United States shall have original and appellate jurisdiction in cases involving a registered trademark, without regard to the amount in controversy. It has been held in this connection (prior to the statutes of 1887 and 1888, which raised the "amount in controversy" necessary to federal jurisdiction from $500 to $2,000) that the federal courts were not limited in their trademark jurisdiction to cases in which the defendant's profits had ex-

ceeded five hundred dollars.[1] And a later decision has held that "The statute of 1881, which gives them (*i. e.*, owners of registered trademarks) the right to commence a suit without alleging the amount in controversy, was not repealed by the statutes of 1887 and 1888, which make it necessary, in order to give jurisdiction to the United States Circuit Court, that the amount involved be two thousand dollars."[2] The Judicial Code, sec. 24, made the amount $3,000; the circuit court is abolished.

In cases where there is diverse citizenship it does not appear to be necessary to allege that the plaintiff uses his trademark on goods intended for commerce with foreign nations or with the Indian tribes; but it has been held that the federal courts have no jurisdiction in a trademark action between citizens of the same state unless the pleadings affirmatively show that the complainant uses his trademark on goods intended for commerce with foreign nations or with the Indian tribes.[3] It was necessary, under the Act of 1881, where both parties were citizens of the same state, to aver that the defendant had applied the simulated mark to goods intended to be used in such foreign commerce, or trade with the Indian tribes,[4] although the reasoning of one of the cases tended to show that logically no such averment in the pleadings is necessary.[5] It was not necessary to show that either party had used the mark in commerce with foreign nations or with the Indian tribes where the parties were of diverse citizenship.[6]

Of course, in cases involving the right to an unregistered trademark, jurisdiction can only be acquired by the federal courts because of the diverse citizenship of the parties,[7] and the amount in controversy, which must be over $3,000 exclu-

1—Symonds v. Greene, 28 Fed. Rep. 834.

2—Glotin v. Oswald, 65 Fed. Rep. 151; Garland & Ralston, Federal Practice, § 122; Hennessy v. Herrmann, 89 Fed. Rep. 669.

3—Ryder v. Holt, 128 U. S. 525; 32 L. Ed. 529; Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823; Gravely v. Gravely, 52 Off. Gaz. 1538; 42 Fed. Rep. 265; Schumacher v. Schwenke, 26 Fed. Rep. 818; Luyties v. Hollender, 27 Blatchf. 413.

4—Gravely v. Gravely, 52 Off. Gaz. 1538; 42 Fed. Rep. 265; Warner v. Searle & Hereth Co., 191 U. S. 195; 48 L. Ed. 145.

5—Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823.

6—Hennessy v. Braunschweiger & Co., 89 Fed. Rep. 664.

7—Battle v. Finlay, 50 Fed. Rep.

sive of interest and costs; as to trademarks, their jurisdiction is concurrent with that of the state courts. By virtue of the Act of Congress of March 3, 1887, ch. 373, as corrected by the Act of August 13, 1888, ch. 866, suit can not be brought against a corporation for infringement of a trademark except in the district where it is incorporated.[8]

Where a bill was brought to restrain infringement of a registered trademark and to restrain the defendants from unfair competition in simulating the form, size, color and shape of cough-drops manufactured by the complainants (both parties being citizens of the same state), the United States Circuit Court of Appeals for the Second Circuit held that the fact that the trademark had not been infringed deprived the circuit court of jurisdiction, and that court had therefore erred in granting an injunction to restrain the unfair competition complained of.[9]

In a suit for injunction the "amount in controversy" is the value of the object to be gained by the bill, and not the amount of damages already suffered by the complainant.[10] In actions for infringement of trademark or for unfair competition, therefore, the amount of profits sought to be recovered does not determine this jurisdictional question. In trademark cases it is the value of the trademark that determines and fixes the "amount in controversy."[11]

In a suit for the protection of a tradename, not a trademark, from unfair competition, "it is the value of that name, as measured by the damages to it, not only present but prospective, which determines the amount in controversy."[12]

106; Burt v. Smith, 71 Fed. Rep. 161; Prince's Metallic Paint Co. v. Prince Mfg. Co., 53 Fed. Rep. 493.

8—*In re* Keasbey & Mattison Co., 160 U. S. 221; 40 L. Ed. 402; Garland & Ralston, Federal Practice, § 161.

9—Burt v. Smith, 71 Fed. Rep. 161. To the same effect see Goldstein v. Whelan, 62 Fed. Rep. 124; Luyties v. Hollender, 30 Fed. Rep. 632.

10—Glenwood Light & Water Co. v. Mutual Light Co., 239 U. S. 121; 60 L. Ed. 174; Mississippi & Mo. R. R. Co. v. Ward, 2 Black, 485; Market Co. v. Hoffman, 101 U. S. 112; 25 L. Ed. 782; Symonds v. Greene, 28 Fed. Rep. 834; Whitman v. Hubbell, 30 Fed. Rep. 81.

11—Symonds v. Greene, 28 Fed. Rep. 834; Hennessy v. Herrmann, 89 Fed. Rep. 669.

12—Archbald, J., in Draper v. Skerrett (2), 116 Fed. Rep. 206, 207.

This must be specifically pleaded, because "the requisite value of the matter in controversy is a jurisdictional fact, and it must necessarily be averred in the declaration or bill. There are no presumptions in favor of the jurisdiction of the federal courts, as they are specially constituted with jurisdiction in certain cases; and the facts upon which it rests must appear in some form in the record of all suits prosecuted before them. They have no jurisdiction except such as the statute confers." [13]

Thus where a tradename (not a technical trademark) is alleged to be of a certain value, but there is no averment that the defendant's acts will, unless restrained, tend to destroy it or put its value in jeopardy, the bill is demurrable.[14]

When the parties are citizens of different states, so that the case comes within the general grant of jurisdiction in the first part of the Act of March 3, 1887, the defendant, by entering a general appearance in a suit brought against him in a district of which he is not an inhabitant, waives the right to object that it is brought in the wrong district.[15] But a corporation, by doing business or appointing a general agent in a district other than that in which it is created, does not waive its right, if seasonably availed of, to insist that the suit should have been brought in the latter district.[16]

13—Garland & Ralston, Federal Practice, § 122.

14—"The demurrer raises also a question of jurisdiction. The bill alleges that complainant's tradename, 'Winchester,' is worth in excess of $5,000, but makes no charge as to the amount of present or prospective damage to complainant arising out of defendant's action, excepting the statements that defendant's acts are calculated to deceive and mislead intending purchasers of complainant's product, 'to the great loss, injury and damage' of complainant, and that unless such acts of defendant are checked 'the reputation of the complainant and its rifles will still further suffer great and irreparable damage.' There is no averment that complainant's trade name will be destroyed, nor that it is in jeopardy. The court can not assume, in the absence of allegations to that effect, that the tradename will be destroyed, or that complainant's damages are in excess of $2,000." Kohlsaat, J., in Winchester Repeating Arms Co. v. Butler Bros., 128 Fed. Rep. 976.

15—*In re* Keasbey & Mattison Co., 160 U. S. 221-229; 40 L. Ed. 402.

16—*In re* Keasbey & Mattison Co., 160 U. S. 221-229; 40 L. Ed. 402. This reverses the ruling in Gray v. Taper-Sleeve Pulley Works,

The Court of Appeals of the District of Columbia had no jurisdiction of trademark cases under sec. 3 of the law of 1881.[17]

Federal jurisdiction in cases of unfair competition must of course be predicated upon the general rules fixing the jurisdiction of the federal courts, so that those courts can not entertain such an action arising between citizens of the same state except in so far as the respondent's wrongful acts affect commerce with foreign nations or the Indian tribes; at least that is the express holding of the Circuit Court of Appeals for the Seventh Circuit.[18]

While federal jurisdiction attaches to a suit between citizens of the same state based upon infringement of a trademark registered under the Act of 1905, a charge of unfair competition joined therewith can not be entertained if the case fails as to the trademark, and that part of the bill will be dismissed.[19] But if the jurisdiction thus acquired is not lost by reason of the charge of infringement of the trademark failing, the court will have jurisdiction to enjoin "all wrongful acts in connection with the infringement which augment and aggravate the wrong."[20]

§ 172. Jurisdiction of the state courts.—The state courts have a jurisdiction concurrent with that of the federal courts in trademark cases.[21] It may, at times, be advisable for a

16 Fed. Rep. 436-443, where it was held that the service of an agent of a foreign corporation was binding, the infringement having been perpetrated in the district where the action was instituted.

17—Einstein v. Sawhill, 65 Off. Gaz. 1918.

18—Illinois Watch Case Co. v. Elgin Nat. Watch Co., 94 Fed. Rep. 667, 672; 35 C. C. A. 237; affirmed, 179 U. S. 665; 45 L. Ed. 365.

19—Planten v. Gedney, 140 C. C. A. 1; 224 Fed. Rep. 382, 386; reversing Planten v. Gedney, 211 Fed. Rep. 281; Sprigg v. Fisher, 222 Fed. Rep. 964, 967.

20—Van Valkenburgh, J., in Jacoway v. Young, 228 Fed. Rep. 630, 633

21—Small v. Sanders, 118 Ind. 105; 20 N. E. Rep. 296. It is well settled law that the jurisdiction of state and federal courts over suits for infringement of trademarks is concurrent. The act of March 3, 1881, conferring jurisdiction upon the courts of the United States, in no way impaired the jurisdiction of the state courts. *In re* Keasbey & Mattison Co., 160 U. S. 221; 40 L. Ed. 402; Reesler v. Brodt, (C. P.) 4 Ohio N. P. 265; 6 Ohio Dec. 248.

non-resident plaintiff who has secured state registration for his mark or label to sue in the state court in preference to the federal court; this will be determined by the character of the matter for which state registration has been secured. Several of the states have by statute extended the definition of trademark to include tickets, labels, wrappers, and other wrappings or packages not properly trademark, and frequently it will be a benefit to a complainant to avail himself of such statutory provisions.[22] The courts of every state of the Union have, with the exception of California,[23] always been open to the owners of trademarks seeking redress and protection against piracy, without requiring state registration as a prerequisite.

§ 173. Jurisdiction of the Federal Trade Commission.—In the present work we are interested in the recently formed Federal Trade Commission only to the extent that it is, by its enabling act, given jurisdiction over issues of unfair competition. The term "unfair competition" had been incorporated in our legal vocabulary long before the enactment of the law creating that commission, and had an established meaning among lawyers, definite though elastic. The act referred to condemned "unfair methods of competition in commerce" as unlawful, and empowered the commission "to prevent persons, partnerships, or corporations, except banks and common carriers subject to the acts to regulate commerce, from using unfair methods of competition in commerce."

As to what it meant by the term "unfair methods," congress was silent. Thus far we have no official expression from the commission itself to elucidate its understanding of the term. But the first chairman of the commission has devoted his

22—"The phrase trademark as used in this chapter includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to denote any goods to be imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods of some particular class or description or the designation or name for any mill, hotel, factory or other business." § 366, Penal Code of New York, 1893; Montana Code, 1895, vol. 1, § 3160.

23—Whittier v. Dietz, 66 Cal. 78. This exception to the rule has since been removed by statutory enactment.

report of 1915, written as Commissioner of Corporations, largely to an exhaustive review of how the term "unfair competition" and other similar terms "have been applied by economic writers and by business men," and has stated that the term "unfair methods of competition" is probably incapable of exact definition in brief terms.[24]

The proceedings of the commission are instituted by the commission itself. The action is entitled "Federal Trade Commission v. (the defendant)," and the rules adopted by the commission provide that the party seeking to have a complaint issued shall make an application therefor in writing, containing a short and simple statement of the facts constituting the alleged offense, and giving the names and addresses of the complaining party and the party complained against. The application is not served upon the defendant, who instead is served with the complaint drawn by the commission. The commission is then in the position of a prosecuting officer, who issues the complaint in his own name as complainant, and proceeds to try the cause himself. The rules provide that an answer to the complaint shall be made within thirty days after service, which service may be had either by personal service or by registered mail. It will be noted on examining the rules (printed in the appendix of this book) that the defendant must answer; indeed, a provision for a demurrer would seem to be idle when the complaint is drawn by the same high authority that is to try the issues.

Does this unique tribunal, to act at once as plaintiff, prosecuting officer and trier of the facts, afford the defendant "due process of law?"

The judgments and orders of the commission are ineffective until reviewed by the circuit court of appeals of any circuit where the defendant resides or where "the method of competition in question was used." Its findings of facts may be reversed if not supported by the testimony, and the original order may be modified or set aside. The judgment of the court of appeals is subject to review by the supreme court only upon certiorari, as provided by sec. 240, the Judi-

24—Davies, Trust Laws and Unfair Competition, p. 301.

cial Code. The orders of the commission can be enforced only by the circuit court of appeals.

§ 174. The elements whereon jurisdiction must be predicated.—Lord Chancellor Brady, in the Irish High Court of Chancery, in 1893, speaking of trademark causes, said: "In such suits, in order to found the jurisdiction of this court, there must be established, first, the existence of the trademark; next, the fact of an imitation, whether a direct imitation, or one with such variations that the court must regard them as merely colorable; and thirdly, the fact that the imitations were made without license, or anything that this court could regard as acquiescence in their use."[25] Mr. Sebastian refers to the remark of Vice-Chancellor Bacon, in England, that "the law of Scotland does not in this respect differ from the law of England"[26] (referring to trademarks), as establishing, in conjunction with the above dicta of the learned Irish chancellor, the fact that the jurisdictional principles in the three kingdoms are the same.[27] The Supreme Court of New York has held it error to dismiss a complaint upon the pleadings and the opening of counsel where the complaint showed the ownership of a tobacco sample ticket used in trade by the plaintiffs, and the wrongful use of an imitation thereof by the defendants.[28] For reasons discussed elsewhere, it is not necessary to confer jurisdiction that it be alleged that any one has in fact been misled or deceived by the use of the simulated mark. But the pleadings must be drawn to suit the exigencies of the case; and where the facts plainly showed that the simulated mark did not and could not deceive either the jobber or retailer, and the fraud, if any, was upon the ultimate purchaser, the consumer, it was proper to aver the fact that the infringement was calculated to deceive the consumer,[29] and

25—Kinahan v. Bolton, 15 Ir. Ch. 75-79. See also Thedford Medicine Co. v. Curry, 96 Ga. 89.

26—Singer Mfg. Co. v. Loog (3), L. R. 18 Ch. D. 395-404.

27—Sebastian, Trademarks (4th Ed.), 170.

28—Linde v. Bensel, 22 Hun, (29 N. Y. Sup. Ct.), 601.

29—Drummond Tobacco Co. v. Tinsley Tobacco Co., 52 Mo. App. 10, 25. The court adds: "The consumer of the particular article is to be considered almost exclusively in determining the question of infringement, because, in the case of an attempted deception, he is substantially the only party likely to

it is probably always a better course to aver that the imitation is calculated to deceive the ultimate purchaser.

The real and simulated marks should be submitted with the bill of complaint or accurately described in appropriate terms, the main test of the alleged resemblance being inspection by the court;[30] with the qualification that the resemblance need not be such as to deceive persons seeing the two marks side by side.[31]

§ 175. The parties plaintiff.—The action to protect a trademark may be brought by its owner or a licensee.[32] The better rule appears to be that the owner of the trademark or tradename is a necessary party. Thus the exclusive consignees of goods bearing trademarks belonging to a foreign consignor were held not entitled to maintain suit for infringement without bringing in the consignor as a party plaintiff;[33] although the owner of a tradename which he had assigned the right to use for a term of years was adjudged capable of maintaining an action for injunction against its infringement without joining his assignees.[34] Trusts, constructive, implied or expressed, may arise,[35] in which case the name of the trustee would be necessary in all suits at law affecting the legal title to the trademark, and it would be his duty at all times to protect

be deceived." Citing Sykes v. Sykes, 3 B. & Cr. 541; Farina v. Silverlock, 1 K. & J. 509; Rose v. Loftus, 47 L. J. Ch. 576; Singer Mfg. Co. v. Loog (3), 18 Ch. D. 395-412.

30—Drummond Tobacco Co. v. Tinsley Tobacco Co., 52 Mo. App. 10, 26.

31—McCann v. Anthony, 21 Mo. App. 83; Drummond Tobacco Co. v. Tinsley Tobacco Co., 52 Mo. App. 10.

32—Kidd v. Johnson, 100 U. S. 617; 25 L. Ed. 769; Kidd v. Mills, 5 Off. Gaz. 337. Where there is an exclusive licensee he must be made a party, or no injunction can issue Wallach v. Wigmore, 87 Fed. Rep. 469.

33—Richards v. Butcher, 62 L. T. 867.

34—Warwick Tyre Co. v. New Motor Co. (1910), 1 Ch. 248.

35—*In re* Mitchell, L. R. 28 Ch. D. 666. Thus where the use of a trademark is improperly obtained by one member of a partnership for his own use, he being bound to obtain it for the partnership, he is held to be the trustee of the mark for the benefit of the firm. Weston v. Ketcham. 39 N. Y. Sup. Ct. 54. Compare *Ex parte* Lawrence Bros., 44 L. T. N. S. 98; 29 W. R. 392; *In re* Rust. 29 W. R. 393; *In re* Farina, 29 W. R. 391; The three cases last named are cases in which one partner registered a mark in his own name by mistake.

and defend the title or allow his name to be used for that purpose, under the established principles of law affecting trusts.[36]

It is not necessary that all the parties having an interest in a trademark join as parties plaintiff. Thus, Vice-Chancellor Shadwell held that surviving partners could maintain an action for an infringement of the firm's trademarks, notwithstanding the fact that the personal representatives of a deceased partner might have some interest in them.[37]

Parties having distinct interests in the devices embodied in an infringing label may join as complainants in equity.[38]

Individuals and corporations having a common interest may join as parties complainant in a bill in equity to restrain an unfair competition in trade. Thus in one case we find seven corporations located in the city of Minneapolis joined in a bill to restrain the fraudulent use of names peculiar to their business and locality, by a dealer in Chicago,[39] and the owners of two separate "Blue Lick Water" springs in Kentucky joined in a bill to restrain the use of the words "Blue Lick Water" by a third party who had no right to their use.[40] During the period of administration the personal representative of the deceased owner of a trademark holds the mark, as we have seen, although it has been held in one case that it may pass without administration.[41] Where there is an administrator, it is his duty to defend the trademark from infringement, and he can recover all accrued profits and damages from the infringer, as actions to restrain infringement

36—Perry, Trusts (4th ed.), § 520.

37—Hine v. Lart, 10 Jur. 106; Seb. 80.

38—Jewish Colonization Assn. v. Solomon, 125 Fed. Rep. 994, 995.

39—Pillsbury-Washburn Flour Mills Co. v. Eagle, 30 C. C. A. 386; 86 Fed. Rep. 608. See also Gravel Roofers' Exchange v. Turnbull, 64 Off. Gaz. 441.

40—Northcutt v. Turney, 101 Ky. 314; 41 S. W. Rep. 21. See also Society of Accountants v. Corporation of Accountants, 20 Scot. Sess. Cas. (4th ser.), 750, in which three chartered societies joined in an action to prevent the use of the letters "C. A." (Chartered Accountants) by the defendant, those letters having been used only to designate members of the three complaining societies. See also Pratt's Appeal, 117 Pa. St. 401.

41—Pratt's Appeal, 117 Pa. St. 401. See Steward v. Einstein, 64 Off. Gaz. 1533.

and recover profits and damages are held not to come within the rule *actio personalis moritur cum persona*.[42] The owner of real estate and improvements thereon may have such a right in a trademark used to identify the products of his tenants as to entitle him to prevent his tenants from using the mark after they have removed to other premises.[43] One who has an exclusive right to use a trademark for a limited time may maintain a suit for infringement.[44]

Upon the dissolution of a copartnership, "either member may use the devices or symbols, unless he has divested himself of the right."[45]

Where copartners dissolve partnership, each retaining the right to use the trademarks of the firm, each can assert his right to the exclusive use of such trademarks as to all persons except his associates in ownership.[46] But in all cases where the right to a trademark is vested severally in two or more persons, either of them will be enjoined from advertising or claiming that he is the "sole proprietor,"[47] or that his is the "only genuine" article.[48] And where title is so held, either of the parties entitled to its use may alone maintain a suit in equity against an infringer.[49]

42—Woerner, Administration, § 299; Oakey v. Dalton, L. R. 35 Ch. D. 700; 35 W. R. 709; Hatchard v. Mege, L. R. 18 Q. B. D. 771; Giblett v. Read, 9 Mod. 459; Croft v. Day, 7 Beav. 84.

43—Atlantic Milling Co. v. Robinson, 20 Fed. Rep. 217; Armstrong v. Kleinhaus, 82 Ky. 803; Harper v. Pearson, 3 L. T. N. S. 547; Carmichael v. Latimer, 11 R. I. 395; Motley v. Downman, 3 My. & Cr. 1; Dickson v. McMaster, 18 Ir. Jur. 202.

44—One who has by contract a right to furnish articles bearing a tradename ("Official American League" base ball), may maintain an action for infringement in his own name; the decree of injunction will be limited in duration to the period of the contract. A. J. Reach Co. v. Simmons Hdw. Co., 155 Mo. App. 412; 135 S. W. Rep. 503.

45—Patterson, J., in Baldwin v. Von Micheroux, 25 N. Y. Supp. 857. To the same effect see Huwer v. Dannenhoffer, 82 N. Y. 499; Hazard v. Caswell, 93 N. Y. 259.

46—New York Cement Co. v. Coplay Cement Co., 45 Fed. Rep. 212.

47—International Silver Co. v. Simeon L. & George H. Rogers Co., 110 Fed. Rep. 955.

48—Fish Bros. Wagon Co. v. Fish Bros. Mfg. Co., 87 Fed. Rep. 203.

49—Dent v. Turpin, 30 L. J. Ch. 495; Seb. 196.

§ 176. The parties defendant.—We have seen in a previous chapter that the liability for injunction against infringement extends to the manufacturer of dies from which counterfeits of the mark are to be made; and it may accurately be said that every one who deals with the simulated trademark or the means of producing it will be restrained in equity.

In a case where a temporary injunction had been granted against a person since deceased, without opposition, and the defendant in his life-time had never moved to vacate it, it was held in New York that the cause would not be continued as against the administratrix of the defendant, because it was not shown that the defendant had acquired any rights in the litigation or that any prejudice would result to the estate by not continuing the action.[50]

The question who may be parties defendant involves necessarily a discussion of some of the principles applied by the courts in infringement proceedings.

Where the plaintiff, the sole owner of a mineral spring, leased it to one who adopted a name to indicate its waters, the concessionaire was enjoined at the instance of the owner from applying the name so used to water from another spring;[51] and in a case where the owner of a spring granted concessions to another conveying the selling privileges in certain countries, the concessionaire was enjoined from interfering with the sale in those countries of water from the spring sold through parties other than the concessionaire.[52]

A manufacturer may delegate the right to use his trademark to sales merchants, giving them that right only so long as they buy goods, of the class to which the trademark belongs, from him. Upon their ceasing to so purchase their goods they will be enjoined from the use of the mark.[53]

A firm of shippers of merchandise who applied the name "The Keystone Line" to vessels they did not own, but of which they had the exclusive management in loading and unloading, were held to have acquired such an exclusive right

50—Republic of Peru v. Reeves, 40 N. Y. Sup. Ct. 316.

51—Hill v. Lockwood, 32 Fed. Rep. 389.

52—Apollinaris Co. (Ltd.) v. Scherer, 23 Blatchf. 459; 27 Fed. Rep. 18.

53—*In re* Riviere, 53 L. T. N. S. 237. See also Lavergne v. Hooper, Ind. L. R. 8 Mad. 149.

in the name that the owners of the vessels so used were enjoined from using the name when the shippers transferred their business to other vessels, the property of other ship-owners.[54]

One who is merely a forwarding agent may be enjoined. In an English case a firm of forwarding agents in London received from foreign correspondents several packages of cigars bearing forged brands. They were enjoined, but costs were not assessed against them because they had, prior to suit, given the makers of the brands so counterfeited full information as to the consignees and offered to return the cigars to the consignors or to erase the brands.[55]

The managers of an infringing corporation, who are themselves substantially the corporation, are properly joined as co-defendants with the corporation in a bill to restrain the infringement.[56] The directors of an infringing corporation may be joined as co-defendants with it, where they have personally directed the infringement.[57]

The usual injunction against a corporation runs in terms against the officers, agents, servants and employes as well. Such an injunction is no bar to a subsequent application for injunction against such officers or others as individuals. Upon such an application it has been said: "The theory is that an injunction against the company bound its officers, agents and servants. That is true enough, but it was within the power of the defendants to dissolve the injunction, so far as they were concerned, by resigning, and thus ceasing to be officers, agents or servants of the enjoined company. Against their personal acts there could be no absolute protection except a personal injunction."[58]

Servants, agents, and employes generally, may be joined as defendants; they are personally liable to injunction.[59]

54—Winsor v. Clyde, 9 Phila. 513.

55—Upmann v. Elkan, L. R. 12 Eq. 140; L. R. 7 Ch. Ap. 130.

56—California Fig Syrup Co. v. Improved Fig Syrup Co., 61 Off. Gaz. 155; 51 Fed. Rep. 296.

57—Armstrong & Co. v. Savannah Soap Works, 53 Fed. Rep. 124; 61 Off. Gaz. 1018; Saxlehner v. Eisner, 77 C. C. A. 417; 147 Fed. Rep. 189.

58—Lacombe, J., in Saxlehner v. Eisner, 77 C. C. A. 417; 147 Fed. Rep. 189, 192; affirming Saxlehner v. Eisner, 140 Fed. Rep. 938.

59—Estes v. Worthington (2), 30 Fed. Rep. 465; Sawyer v. Kel-

American agents of foreign houses will be enjoined from selling counterfeit or imitation goods received from their principals.[60] The same rule obtains in regard to English[61] or Australian[62] agents of foreign principals, and in regard to commission merchants.[63]

The principal is, of course, liable for the acts of his servants or agents, whether or not he can be shown to have knowledge of those acts.[64]

Difficulty arises in considering the rights and liabilities of innocent parties through whose hands counterfeit goods pass in transit, who hold them only as bailees and have no actual or imputed knowledge of their fraudulent nature. In the case of wharfingers so situated, who offered to act in regard to falsely marked wine in their possession as the court might direct, but asked to have their charges provided for, the court ruled that they were entitled to a lien upon the wine for their charges; that plaintiffs must pay defendant's costs; and if the plaintiffs had any lien for their own costs as against the wine, it must be subject to the lien of the wharfingers for their charges.[65]

An innocent mortgagee of wines bearing a simulated mark was held to have a valid lien thereon, and it was directed that the spurious marks should be effaced and the wines delivered to him.[66]

In no case, however, will relief in equity stop short of protecting the owner of a trademark of which imitations or counterfeits are found in the hands of a common carrier or ware-

logg (1), 7 Fed. Rep. 721; Sawyer v. Kellogg (2), 9 Fed. Rep. 601.

60—Carbolic Soap Co. v. Thompson, 25 Fed. Rep. 625; Roberts v. Sheldon, 8 Biss. 398; Fed. Case No. 11916.

61—Siegert v. Ehlers, Seb. 432; Siegert v. Findlater, L. R. 7 Ch. D. 801; Farina v. Cathery, L. J. N. C. 1867, p. 134.

62—Siegert v. Lawrence, 11 Vict. L. R. 47.

63—Coats v. Holbrook, 2 Sandf. 586; Cox, 20; Twentsche Stoom Bleekery Goor v. Ellinger, 26 W. R. 70.

64—Low v. Hart, 90 N. Y. 457; Atkinson v. Atkinson, 85 L. T. Jour. 229; Twentsche Stoom Bleekery Goor v. Ellinger, 26 W. R. 70; Tonge v. Ward, 21 L. T. N. S. 480.

65—Moet v. Pickering, L. R. 6 Ch. D. 770; L. R. 8 Ch. D. 372.

66—Ponsardin v. Peto, 33 Beav. 642.

houseman.[67] It is the duty of the bailee so situated to give the owner of the trademark full information in regard to the goods which are or have been in his hands by virtue of the bailment, and where he refuses so to do, even after the goods have gone beyond his control, it has been held that a bill will lie against him to compel discovery.[68]

If, on the other hand, the bailee gives the owner of the mark full information, he will be allowed costs if, notwithstanding his disclosures, proceedings are instituted against him.[69] The wrongs of which this book treats being torts, and all participants in torts being principals, a person who assists in conducting an unfair competition by furnishing fraudulent packages or labels is liable for the injury resulting to the plaintiff from the unfair competition.[70]

§ 177. Forms of action.—The most usual form of civil action to secure redress for trademark piracy in this country is by bill in equity, praying for an injunction, discovery, account of profits, and damages. The remedy at law is by an action on the case, for deceit; that form of action being both the form known to the common law and that prescribed by the Act of March 3, 1881.

An action of deceit may be brought by a purchaser who has been deceived by the vendor of the fraudulent article, but such actions are seldom, if ever, brought, and are practically unheard of.

One action in a federal court will lie for the infringement of a patent and the infringement of a trademark, where the trademark and the patent were both infringed together,[71] and

67—Ponsardin v. Peto, 33 Beav. 642; Hunt v. Maniere, 34 Beav. 157; Del Valle v. Mayer, Seton (4th ed.), 236; Seb. 326; Rivero v. Norris, Seton (4th Ed.), 236; Seb. 299; Moet v. Pickering, L. R. 6 Ch. D. 770; L. R. 8 Ch. D. 372; Upmann v. Elkan, L. R. 12 Eq. 140.

68—Orr v. Diaper, L. R. 4 Ch. D. 92. See also Carver v. Pinto Leite, L. R. 7 Ch. D. 90; 41 L. J. Ch. 92; 25 L. T. N. S. 722; 20 W. R. 134.

69—Upmann v. Currey, 29 Sol. J. 735; Upmann v. Forester, L. R. 24 Ch. D. 231; Moet v. Pickering, L. R. 8 Ch. D. 372; Upmann v. Elkan, L. R. 12 Eq. 140.

70—Hildreth v. Sparks Mfg. Co., 99 Fed. Rep. 484.

71—Jaros Underwear Co. v. Fleece Underwear Co., 60 Fed. Rep. 622. See p. 431, *post*.

the same rule applies where a publication infringes both a trademark and a copyright.[72]

Accordingly a charge of unfair competition may be embraced in a bill for patent infringement,[73] and a single bill of complaint may charge the infringement of a design patent, a mechanical patent, and a trademark or tradename.[74]

72—Harper v. Holman, 84 Fed. Rep. 222.

73—Dunlap v. Willbrandt Surgical Mfg. Co., 80 C. C. A. 575; 151 Fed. Rep. 223; Germer Stove Co. v. Art Stove Co., 80 C. C. A. 9; 150 Fed. Rep. 141; Daniel O'Donnell v. Riseal Mfg. Co., 228 Fed. Rep. 127, 130.

74—Wagner Typewriter Co. v. F. S. Webster Co., 144 Fed. Rep. 405.

CHAPTER XI.

THE CRIMINAL PROSECUTION—FEDERAL AND STATE.

§ 178. **The Act of 1876.**—The prosecutions under which the decision styled the *Trademark Cases*[1] was rendered were instituted under the Act of Congress of 1876. This was a penal act applicable to infringers of trademarks registered under the registration act of 1870. Mr. Justice Miller says, in the conclusion of his opinion: "While we have, in our references in this opinion, had mainly in view the Act of 1870, and the civil remedy which that act provides, it was because the criminal offenses described in the Act of 1876 are, by their express terms, solely referable to frauds, counterfeits, and unlawful use of trademarks which were registered under the provisions of the former act. If that act is unconstitutional, so that the registration under it confers no lawful right, then the criminal enactment intended to protect that right falls with it."[2]

After the enactment of the Act of March 3, 1881, some able lawyers inclined to the belief that the Act of 1876 was by the passage of a valid registration act given new life, or, as stated by one eminent jurist: "This is not an instance of revival; for the penal act was not dead, but simply dormant. Its sleep was ended by the birth of the Act of 1881. No words were required in the latter to set the penal law in motion. That which is implied in a statute is just as much a part of it as that which is expressed. Nor is it repealed by the civil Act of 1881."[3]

This reasoning, however, has not been followed by the courts. The proposition was first submitted to Judge Thayer, but in his opinion he expressly refrained from deciding it, sustaining demurrers to indictments based upon the Act of 1876

1—100 U. S. 82.

2—Trademark Cases, 100 U. S. 82-99; 25 L. Ed. 550, 553.

3—Browne, Trademarks (2d ed.), § 371.

upon other grounds.[4] Subsequently the question was squarely presented to Mr. Justice Brewer, sitting as circuit judge, who said in substance: "While the Act of 1870 was a nullity, it must be assumed as a matter of fact that in framing the Act of 1876 the penalties imposed were with reference to the terms of the Statute of 1870. * * * Again, when the Act of 1881 was passed, if congress had intended that penalty should be imposed for a trespass upon the rights conferred by that statute, or if it had intended that the Act of 1876 should be revivified and operate upon the Act of 1881, it was very easy to say so. Its silence in this respect is cogent evidence that it did not understand or intend that the penal statute should be considered a part of present and valid law. And that assumption is strengthened by the fact that it had before it for consideration this passage from the opinion of the supreme court (quoted above) in which it is broadly stated that the Act of 1876 had fallen with the Act of 1870. Whatever may be true as to the full meaning of that decision, or as to the general power of congress to impose penalties for trespasses upon rights having no existence, it had before it the general affirmance by the court that the law of 1876 had fallen, and it must be assumed that if it meant that it should stand and be vivified, or that any penalties should be imposed for violations of the law of 1881, it would have so stated. These considerations convince me very strongly that the Act of 1876 has, as the supreme court said, fallen with the Act of 1870, and it is as much a dead letter as the Act of 1870, and was not vivified or given operative force by the Act of 1881."[5]

The Act of 1876, then, is no longer of force, and there is no federal relief by criminal prosecution to be had; except that under certain conditions, which we will examine in the next section, the owners of trademarks applied to spirituous liquors and wines may be measurably protected by federal prosecution under the internal revenue laws.

§ 179. **Sec. 3449, Revised Statutes.**—In the last paragraph of sec. 29 of the Act of Congress approved July 13, 1866, and entitled "An act to reduce internal taxation and to amend

4—United States v. Braun, 39 Fed. Rep. 775-777.

5—United States v. Koch, 40 Fed. Rep. 250-252.

an act entitled 'An act to provide internal revenue to support the government, to pay interest on the public debt, and for other purposes,' approved June 30, 1864" (now sec. 3449, Revised Statutes of the United States), it is provided as follows:

"Whenever any person ships, transports, or removes any spirituous or fermented liquors or wines, under any other than the proper name or brand known to the trade as designating the kind and quality of the contents of the casks or packages containing the same, or causes such act to be done, he shall forfeit said liquors or wines, and casks or packages, and be subject to pay a fine of five hundred dollars."

This enactment is constitutional, being within the authority delegated to congress by the first clause of sec. 8 of art. I of the constitution, being to "levy and collect taxes," and "make all laws which shall be necessary and proper for carrying into execution that power." It is no objection to the validity of the act that its enforcement incidentally protects the owners of trademarks. As stated by Mr. Justice Nelson in another connection: "It will not do to say that the exercise of an admitted power of congress conferred by the constitution is to be withheld, if it appears, or can be shown, that the effect and operation of the law may incidentally extend beyond the limitation of the power. Upon any such interpretation the principal object of the framers of the instrument in conferring the power would be sacrificed to the subordinate consequences resulting from its exercise."[6] It has therefore been held constitutional by Judges Lacombe,[7] Thayer, Sanborn, Caldwell[8] and Hawley.[9] Under this section the term "package" includes every box, barrel, or other receptacle into which distilled spirits have been placed for shipment or removal, either in quantity or in separate small packages, as bottles or jugs.[10] The phrase "proper name or brand" does not refer

6—State of Pennsylvania v. Wheeling & Belmont Bridge Co., 59 U. S. 421-433; 15 L. Ed. 435, 438.

7—United States v. Loed, 49 Fed. Rep. 636.

8—United States v. 132 Packages of Spirituous Liquors and Wines, 22 C. C. A. 228; 76 Fed. Rep. 364; reversing same case, 65 Fed. Rep. 980.

9—United States v. Campe, 89 Fed. Rep. 697.

10—United States v. 132 Packages of Spirituous Liquors and

to the trademark or make of a certain distiller, but to a removal under an improper or misleading title, as where the fraud on the government is attempted of removing brandy under the name of whiskey."[11]

What will constitute transportation or removal under the terms of this act is not determined, and will probably depend upon the facts in each particular case. The act includes in its purview any person who ships, transports or removes liquors in violation of its provisions.[12]

This act is capable of protecting to a great extent the owners of trademarks used in the liquor trade.

§ 180. Criminal liability at common law.—The counterfeiter of a trademark is not guilty of forgery.[13] His offense is comprehended under some division of the various fraud acts. Probably it will always be found to fall within the limits of the acts defining the offense of obtaining money under false pretenses.[14] But under the English decisions it is not a forgery, even where the trademark counterfeited consists of a signature.[15] In the United States, however, prosecutions have been very seldom resorted to. The prosecutor in actions sounding in false pretenses should, of course, be the customer who has been defrauded, and as a rule he is little inclined to prosecute.

Wines, 76 Fed. Rep. 364-368; 22 C. C. A. 228.

11—United States v. 132 Packages of Spirituous Liquors and Wines, 76 Fed. Rep. 364-368; 22 C. C. A. 228.

12—United States v. Campe, 89 Fed. Rep. 697-699. That this section is highly penal and must be strictly construed, see U. S. v. Twenty Boxes, 67 C. C. A. 214; 133 Fed. Rep. 910. That fraudulent intent is not involved, see U. S. v. Liquor Dealers' Supply Co., 156 Fed. Rep. 219. The remedy is not exclusive, Blacklock v. U. S., 208 U. S. 75; 52 L. Ed. 396. For former acquittal of criminal charge as a bar, see U. S. v. Seattle Brew. Co., 135 Fed. Rep. 597. For what markings penalty is incurred, see U. S. v. Sandefuhr, 145 Fed. Rep. 49; Woolner v. Rennick, 170 Fed. Rep. 662.

13—White v. Wagar, 185 Ill. 195-202. He may be, where the counterfeit mark contains a guaranty, expressed or implied. White v. Wagar, 83 Ill. App. 592-596.

14—Regina v. Smith, D. & B. 566; 8 Cox, 32.

15—Regina v. Closs, D. & B. 460; 7 Cox, 494; Regina v. Smith, 8 Cox, 37; Regina v. Dundas, 6 Cox, 380; Regina v. Gray, Seh. 183; Regina v. Sutter, 10 Cox, 577.

§ 181. The penal statutes of the several states.—The more important statutes relating to trademark protection are set out in the appendix. It will be noticed, upon examining them, that legislation has largely been for the protection of labor organizations and of particular industries; thus, states having no general registration act, have provisions for the registration and protection of timber marks, or of the packages, such as bottles, or syphons, used by the manufacturers of carbonated waters, or the milk cans of the dairy industry. In the statutes, which have been reproduced in the appendix, are to be found admirable examples of every form of trademark legislation which the necessities of commerce have thus far created. An adequate registration act in each of the states which now has no general statutory provision upon that subject, and greater uniformity of legislation between the states, are greatly to be desired. In the annotations of these cases, it will be noticed that there have been comparatively few reported cases of criminal prosecution under them. The heavy burden of proof imposed upon the state in these cases has served as a deterrent to such prosecution. Thus the Illinois court held that proof that two persons, strangers to the defendant, had told him the mark on the goods he was selling was counterfeit, was not necessarily sufficient to prove his guilty knowledge.[16] This difficulty has been remedied in Massachusetts by the enactment of a provision requiring a defendant charged with the selling of goods bearing a spurious mark to show that he bought them innocently.

It is undoubtedly proper legislation to impose this requirement upon the defendant. In England, proof of fraudulent intent is not required in a prosecution under Merchandise Marks Act of 1887.[17]

16—Vogt v. People, 59 Ill. App. 684.

17—Wood v. Burgess, L. R. 24 Q. B. D. 162. For further rulings see statutes of the several states, in the appendix.

CHAPTER XII.

ACTIONS AT LAW.

§ 182. The form of action.—"The only redress for a trademark infringement was at first by an action in a common law court for damages for deceit.[1] An action at law for damages is prescribed by the Act of 1905, as a proper legal remedy for infringements of trademarks.[2] It is against the policy of the law that the owner of a valid trademark should lose by reason of its infringement. To prevent such a result, the action at law is well adapted, because it measures the plaintiff's recovery by the plaintiff's loss. But it is also against the policy of the law that an infringer should gain by reason of his infringement.

By sec. 7 of the Act of 1881 the action of trespass on the case was specified as the appropriate action at law for trademark infringement.

The history of this form of action has been succinctly described by English jurists. Lord Blackburn said: "The original foundation of the whole law is this: that when one knowing that goods are not made by a particular trader sells them as and for the goods of that trader, he does that which injures that trader. At first it was put upon the ground that he did so when he sold inferior goods as and for the trader's; but it is established (alike at law[3] and in equity[4]) that it is an actionable injury to pass off goods known not to be the plaintiff's as and for the plaintiff's, even though not inferior."[5]

The development of the action on the case, and the manner in which it became adapted to the exigencies of trademark issues, are thus admirably stated by Mellish, L. J.: "In my opinion all actions of this nature must be founded upon false representations. Originally, I apprehend, the right to bring an action in

1—Gaynor, J., in Clinton Metallic Paint Co. v. New York Metallic Paint Co., 50 N. Y. Supp. 437.

2—Act of February 20, 1905, § 16.

3—Blofield v. Payne, 4 B. & Ad. 410.

4—Edelsten v. Edelsten, 1 DeG. J. & S. 185.

5—Singer Mfg. Co. v. Loog, L. R. 8 A. C. 15-29.

respect of the improper use of a trademark arose out of the common law right to bring an action for a false representation, which, of course, must be a false representation made fraudulently. It differed from an ordinary action for false representation in this respect: that an action for false representation is generally brought by the person to whom the false representation is made; but in the case of the improper use of a trademark, the common law courts noticed that the false representation which is made by putting another man's trademark, or the tradename of another manufacturer, on the goods which the wrong-doer sells, is calculated to do an injury, not only to the person to whom the false or fraudulent representation is made, but to the manufacturer whose trademark is imitated; and, therefore, the common law courts held that such a manufacturer had a right of action for the improper use of his trademark. Then the common law courts extended that doctrine one step further; first, if I recollect rightly, in the case of *Sykes v. Sykes*.[6] There it was held that although the representation was perfectly true as between the original vendor and the original purchaser, in this sense, that the original purchaser knew perfectly well who was the real manufacturer of the goods and therefore was not deceived into believing that he had bought goods manufactured by another person, yet if the trademark was put on the goods for the purpose of enabling that purchaser, when he came to resell the goods, to deceive any one of the public into thinking that he was purchasing the goods of the manufacturer to whom the trademark properly belonged, then that was equally a deception, a selling of goods with a false representation, which would give the original user of the trademark a right of action. That was the common law right."[7]

The trademark owner whose rights are infringed has his election between proceeding at law or in equity.[8]

§ 183. The declaration.—The proper parts of a declaration in an action at law are, in their order, as follows:

1. The title of the court.
2. The title of the term.
3. The name.

6—3 B. & Cr. 541.

7—Singer Mfg. Co. v. Wilson, L. 2 Ch. D. 434-453.

8—Hagan & Dodd Co. v. Rigbers, 1 Ga. App. 100; 57 S. E. Rep. 970.

4. The commencement.
5. The statement of the right of action.
6. The conclusion.

The correct title of the United States District Court established in the Northern District of California is "The District Court of the United States for the Northern District of California," and the titles of the various other district courts are the same, except as to the name of the district,[9] to which should be added the name of the division of the district, where the judicial districts are subdivided.

The term in which the declaration should be entitled is the term to which the defendant is summoned.[10] It is unnecessary to entitle a declaration in the name of the case in which it is filed; the style of the case may be indorsed upon the back of the declaration as a matter of convenience.[11]

The venue should be laid in the district where the declaration is filed, regardless of the district or districts wherein the infringement was committed.[12]

The commencement sets forth the names of the parties and the capacity in which they respectively sue or are sued, if it is other than a natural capacity.[13]

A corporation can not be or become a citizen of a state,[14] and therefore an averment of its citizenship is improper. When a corporation is a party the corporate name should be set forth, followed by the averment that the said corporation "is a corporation created under the laws of the state of ——, and having its principal place of business at ——."[15]

The courts of the United States having a limited jurisdiction, the jurisdictional facts must be expressly pleaded in the declara-

9—Revised Statutes, § 608.

10—Chitty, Pleading (15th Am. ed.), p. 263.

11—The title or caption is no part of the pleading. Jackson v. Ashton, 8 Pet. 148; 8 L. Ed. 898. But cf. Jones v. Andrews, 10 Wall. 327; 19 L. Ed. 935.

12—Peyton v. Desmond, 63 C. C. A. 654; 129 Fed. Rep. 1.

13—Boston El. Ry. Co. v. Grace & Hyde Co., 50 C. C. A. 239; 112 Fed. Rep. 279.

14—Paul v. Virginia, 8 Wall. 168; 19 L. Ed. 357; Ducat v. Chicago, 10 Wall. 410; 19 L. Ed. 972.

15—Shiras, Equity Practice (2d ed.), § 34. Citing Lafayette Ins. Co. v. French, 18 How. 404; 15 L. Ed. 451; Railroad Co. v. Harris, 12 Wall. 65; 20 L. Ed. 354; *Ex parte* Schollenberger, 96 U. S. 369; 24 L. Ed. 853; Pennsylvania Co. v. Railroad Co., 118 U. S. 290; 30 L. Ed. 83; Goodlet v. Railroad, 122 U. S. 391; 30 L. Ed. 1230.

tion. Diverse citizenship, if it exists, must be shown. If the trademark involved is registered under the Act of Feb. 20, 1905, that fact must be pleaded, because, first, it establishes a *prima facie* right to the use of the mark, and second, confers jurisdiction upon the federal court regardless of the amount in controversy.[16]

If the action is between citizens of the same state, even though involving a registered trademark, the declaration must aver that the plaintiff uses the trademark and the defendant the infringing mark upon goods intended for commerce with foreign nations or with Indian tribes or in interstate commerce.[17] If the action is based upon a common law trademark, the declaration must set forth the amount in controversy, which is not the amount sought to be recovered, but the value of the trademark, and that value must be not less than three thousand dollars.[18]

Fraud is essential to recovery at law. Lord Westbury said, "Proof of fraud on the part of the defendant is of the essence of the action."[19] Furthermore, at law it is necessary to show, and plead, that an injury has actually been done by the defendant's act of infringement.[20]

The averment of infringement should set forth, then, in what the infringement consisted, and that it was done willfully and with fraudulent intent on the part of the defendant. The statement of the right of action should describe the trademark in exact and appropriate terms, and where possible the real and simulated marks should be reproduced in fac-simile.

16—Act of March 3, 1881, § 7; Act of 1905, §§ 16, 17. Symonds v. Greene, 28 Fed. Rep. 834; Glotin v. Oswald, 65 Fed. Rep. 151; Hennessy v. Herrmann, 89 Fed. Rep. 669; *In re* Keasbey & Mattison Co., 160 U. S. 221-227; 40 L. Ed. 402.

17—Luyties v. Hollender (1), 22 Blatchf. 413; Schumacher v. Schwenke (1), 26 Fed. Rep. 818; Ryder v. Holt, 128 U. S. 525; 32 L. Ed. 529; Gravely v. Gravely, 42 Fed. Rep. 265; Prince's Metallic Paint Co. v. Prince Mfg. Co., 53 Fed. Rep. 493.

18—Symonds v. Greene, 28 Fed. Rep. 834.

19—Edelsten v. Edelsten, 1 DeG. J. & S. 185; to the same effect, Hargraves v. Smith, Seb. 338; Lawson v. Bank of London, 18 C. B. 84; 25 L. J. C. P. 188; 2 Jur. N. S. 716; 27 L. T. 134; 4 W. R. 481; Seb. 140; Rodgers v. Nowill, 6 Hare, 325; 5 C. B. 109; 17 L. J. C. P. 52; 11 Jur. 1039; 10 L. T. 88; Seb. 82; Crawshay v. Thompson, 4 Man. & G. 357; 5 Scott, N. R. 562; 11 L. J. C. P. 301; Seb. 72.

20—Singer Mfg. Co. v. Loog (3), L. R. 8 App. Cas. 15-30.

The conclusion of the declaration should pray for the actual damage sustained by the plaintiff and for punitive damages if the facts justify. Some adjudications in the past have held that there can be no recovery of punitive damages,[21] but such a conclusion is at variance with the fundamental principles of the law of torts. The more wholesome and better reasoned doctrine is to the contrary.[22]

In sec. 16 the Act of 1905 provides in relation to actions at law for damages for the infringement of a registered mark, that "whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, not exceeding three times the amount of such verdict, together with the costs." In a declaration based upon the infringement of a mark registered under the act, the conclusion should pray for the actual damages stated to have been sustained by the plaintiff, together with such additional amount, not exceeding in all three times the amount of such actual damages, as the court may see fit to adjudge, together with the costs.

The conclusion ends with the formal allegation of bringing suit.

It is necessary at common law in drafting the declaration to directly allege that the injury has been committed by continuation from one given time to another or that it was committed on divers days and times. Thus, one pleader alleged in his declaration as follows: "Since the 1st day of November, 1888, knowingly, willfully, and fraudulently offered for sale, and is now selling, glue in packages." Upon the trial, in the Federal Circuit Court for the District of Massachusetts, the complainant was permitted to introduce proof of sales by the defendant of infringing goods between November 1, 1888, and November 30, 1889, amounting to $56,318.24. The circuit court of appeals of the fourth circuit set aside a judgment of $8,000, entered upon the verdict of a jury, saying, by Putnam, J., "There is no *continuando* with reference to the matter of selling; so that, according to the common law, the plaintiff could properly prove only one

21—Taylor v. Carpenter (2), 2 Wood & M. 1; Cox, 32; 9 L. T. 514; Seb. 83.

22—Warner v. Roehr, Fed. Case No. 17189A; Day v. Woodworth, 13 How. 363; 14 L. Ed. 181; Browne, Trademarks (2d Ed.), §§ 519, 520.

actual sale as an independent basis of damages. The defendant insisted at all necessary points on the enforcement of the rule, and exceptions were carefully taken and allowed; so that this court, however much it may regret it, is compelled to meet this issue. There is no doubt that at common law the position of the defendant would be correct on this point, and the Massachusetts statutes relating to pleading have not changed this rule." [23]

§ 184. Defenses.—The defenses to actions for trademark infringement may be divided into two classes. The first class embraces those defenses which attack the plaintiff's right to sue. It may be that the owner of a trademark who sues for infringement has conveyed the right to use the mark to an exclusive licensee for a term of years. In such a case no injunction can issue unless the licensee joins in the action.[24] It may be advisable to set up laches or acquiescence, or that there are facts to justify a plea that whatever rights the complainant once had he has lost by abandonment; which matters have been discussed in a preceding chapter. In an exceptional case the complainant's recovery may be precluded by an estoppel,[25] which should, of course, be pleaded. The complainant's mark may have become invalid because its assignment to him from its former owner has not been sufficiently advertised, and the mark as used tends to mislead the public into a belief that the former owner is still the producer of the goods.[26] The complainant's label may contain misrepresentations of fact,[27] or his alleged trademark may be a word that, once distinctive, has become *publici juris*.[28] It is a good defense to the action at law to show either of these matters. The fact that the complainant's trademark is registered does not deprive the public of the right to use a similar mark which was common to the trade before the registration. Thus, where "La Normandi," was registered as a mark for cigars, but "La Normanda" was already in common use for a like purpose,

23—Le Page Co. v. Russia Cement Co., 2 C. C. A. 555; 51 Fed. Rep. 941-949; 17 L. R. A. 354.

24—Wallach v. Wigmore, 87 Fed. Rep. 469.

25—Lavergne v. Hooper, Ind. L. R. 8 Mad. 149.

26—Alaska Packers' Assn. v. Alaska Imp. Co., 60 Fed. Rep. 103; Siegert v. Abbott (1), 61 Md. 286.

27—Piso Co. v. Voight, 4 Ohio N. P. 347; Krauss v. Jos. R. Peebles' Sons Co., 58 Fed. Rep. 585; Moxie Nerve Food Co. v. Modox Co., 152 Fed. Rep. 493.

28—Siegert v. Abbott (4), 25 N. Y. Supp. 590; 72 Hun, 243.

injunction to restrain the use of the latter was denied.[29] In fact the registration of a trademark does not prevent its being attacked as a word *publici juris*, or as being itself a colorable imitation of another trademark.[30] The English decisions upon this point are in harmony with those of the courts of the United States.[31]

The defendant may plead a license from the owner of the mark. This, of course, presumes that the license was lawful, and that the licensee has not so used the mark as to perpetrate a fraud upon the public.[32] Where two or more persons have an equal right in the use of the mark the defendant may plead a license from either of them.[33]

The second class of defenses that may be interposed are those that deny the infringement—either denying that any infringement has been perpetrated by the defendant, or, if the infringing mark has been handled or dealt with by the defendant, denying that guilty knowledge which the complainant must prove to sustain his suit at law.

In the foregoing portion of this section we have noted the defenses which, if sustained by the proof, will relieve the defendant from liability at law. The action at law is much easier of defense than that in equity, and in another section, after we have considered the action in equity, will be found enumerated a number of defenses which have proved effective in equity, many of which would doubtless be adequate at law.[33a]

29—Stachelberg v. Ponce, 23 Fed. Rep. 430; Price & Steuart, 967; 128 U. S. 686; 32 L. Ed. 569.

30—Moorman v. Hoge, Fed. Case No. 9783; 2 Sawyer, 78; Decker v. Decker, 52 How. Pr. 218; Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823; Cox, Manual, 695; 23 Blatchf. 46; Schumacher v. Schwenke (2), 36 Off. Gaz. 457.

31—*In re* Palmer, L. R. 21 Ch. D. 47; Bodega Co., (Ltd.) v. Owens, 23 L. R. Ir. 371; Wolfe v. Lang, 13 Vict. L. R. 752; Wolfe v. Alsop (2), 12 Vict. L. R. (E.), 421; Lewis v. Klapproth, 11 Vict. L. R. (E.), 214.

32—The goods to which a licensee applies the mark must be equal in quality to the goods to which the licensor applied them. Lawrence Mfg. Co. v. Tennessee Mfg. Co., 31 Fed. Rep. 776; 138 U. S. 537; 34 L. Ed. 997; Oldham v. James, 13 Ir. Ch. 393; 14 *Ibid.* 81; Bloss v. Bloomer, 23 Barb. 604; Cox, 200; Samuel v. Berger, 24 Barb. 163; Cox, 178; Rodgers v. Philp, 1 Off. Gaz. 29; *In re* Tolle, 2 Off. Gaz. 415.

33—Marshall v. Pinkham, 52 Wis. 572; Price & Steuart, 497.

33a—As to actions at law in the federal courts the Act March 3, 1915, 38 Stat. L. 956, provides "that in all actions at law equitable defenses may be interposed."

§ 185. Damages.—The courts of the United States have signally failed to agree upon any fixed rule as to the measure of damages in actions at law for the infringement of trademarks. To the student of the decisions the only apparent cause for this fact lies in two practical reasons. The first, that the remedy offered by equity is more complete. The second is that much of the trademark piracy, of this country at least, is conducted by insolvents, who offer no inducement to the vigilant prosecution which should be visited upon them. In 1846, in the United States Circuit Court for the District of Massachusetts, Woodbury, J., said: "In a case like this (an action of trespass on the case for trademark infringement), if in any, no reason exists for giving greater damages than have actually been sustained or what have been called compensatory. There is nothing peculiarly atrocious in the conduct of the defendant to be punished by damages, and in no other way, as a public example, considering the blamable usages which exist on this subject."[34] In a Missouri case, the St. Louis Court of Appeals, by Lewis, P. J., held that it was error in the trial court to instruct the jury that they might find exemplary damages if from the evidence they believed that the acts of the defendant were willful or malicious. The reasoning of the court is that "If the plaintiffs had demanded an accounting of the profits made by the defendants, on the equitable ground that those profits were made by the use of the plaintiff's property, the instructions might have been substantially applicable."[35]

An eminent text-writer thus states the rule: "The jury are to give actual damages which the plaintiff has sustained—not vindictive or speculative damages, but such as his proof has shown to their satisfaction he has actually sustained by the infringement."[36]

34—Taylor v. Carpenter (2), 2 Wood. & M. 1; Cox, 32; Fed. Case No. 13785. The passage quoted is a mere dictum, uttered in the course of an opinion upon a motion for a new trial where a jury had been directed that they might find punitive damages. The verdict was not disturbed.

35—Addington v. Cullinane, 28 Mo. App. 238-241; followed in Lampert v. Judge & Dolph Drug Co., 119 Mo. App. 693; 100 S. W. Rep. 659; reversed in Lampert v. Judge & Dolph Drug Co., 238 Mo. 409; 141 S. W. Rep. 1095.

36—Sutherland, Damages, (2d ed.), vol. III, § 1202; citing Ransom v. Mayor, 1 Fisher, 252; Parker v. Hulme, 1 Fisher, 44; Addington v. Cullinane, 28 Mo. App. 238.

To the author's mind the better rule is announced in the case of *Warner v. Roehr*, in which the instructions of Judge Blodgett to a jury said in part: "In cases of this character, where you are satisfied from the proof and from the admissions in the case that the fraud—the intention to defraud—is at the bottom of the matter, * * * the jury are not confined to the exact monetary damages, but may give what are known as vindictive or exemplary damages, for the purpose of deterring others from embarking in the same scheme of fraud and deception."[37] It is not to be doubted that this doctrine is more reasonable and just, and better adapted to protect society from the ravages of trademark infringers, than the rule stated in *Taylor v. Carpenter*[38] and *Addington v. Cullinane*.[39] It is difficult to see how the result stated in those cases has been attained.[40] They are wholly without precedent and opposed to the rule of damages which obtained at common law. What that rule was, and is, so far as our federal courts are concerned, is nowhere more clearly stated than by Mr. Justice Grier in an opinion in which he speaks for the federal supreme court. He says:

"It is a well-established principle of the common law that in actions of trespass and all actions on the case for torts a jury may inflict what are called exemplary, punitive or vindictive damages upon a defendant, having in view the enormity of his offense rather than the measure of compensation to the plaintiff. We are aware that the propriety of this doctrine has been questioned by some writers; but if repeated judicial decisions for more than a century are to be received as the best exposition of what the law is, the question will not admit of argument. By the common as well as by statute law men are often punished for aggravated misconduct or lawless acts by means of a civil action, and the damages, inflicted by way of penalty or punishment, given to the party injured. In many civil actions, such as libel, slander, seduction, etc., the wrong done to the plaintiff is incapable of being measured by a money standard; and the

37—Warner v. Roehr, Fed. Case No. 17189A.

38—*Supra*.

39—*Supra*.

40—The language of this text approved. Lampert v. Judge & Dolph Drug Co., 238 Mo. 409, 421; 141 S. W. Rep. 1095, 1099; reversing Lampert v. Judge & Dolph Drug Co., 119 Mo. App. 693; 100 S. W. Rep. 659.

damages assessed depend on the circumstances, showing the degree of moral turpitude or atrocity of the defendant's conduct, and may properly be termed exemplary or vindictive rather than compensatory.

"In actions of trespass where the injury has been wanton and malicious, or gross and outrageous, courts permit juries to add to the measured compensation of the plaintiff which he would have been entitled to recover, had the injury been inflicted without design or intention, something further by way of punishment or example, which has sometimes been called 'smart money.' This has always been left to the discretion of the jury, as the degree of punishment to be thus inflicted must depend on the peculiar circumstances of each case."[41]

Judge Thayer has said: "Punitive damages may be awarded when a wrongful act is done willfully, in a wanton or oppressive manner, or even when it is done recklessly—that is to say, in open disregard of one's civil obligations and of the rights of others."[42]

We find the rule sanctioned and reaffirmed repeatedly by the Supreme Court of the United States.[43] It has been the doctrine adhered to by that court ever since Mr. Justice Story in a case of marine tort spoke of exemplary damages as "the proper punishment which belongs to such lawless misconduct."[44] It is manifest that in a case of deliberate counterfeiting of a trademark there should be a recovery of punitive damages, or at least an opportunity given the jury to assess punitive damages.

As to the award of actual damages at law, it has been held that nominal damages will be awarded where a fraudulent intent is shown, even though no specific injury is pleaded or proven.[45]

41—Day v. Woodworth, 54 U. S. (13 Howard), 363, 371; 14 L. Ed. 181. See Press Pub. Co. v. Monroe, 73 Fed. Rep. 196, 201.

42—Fotheringham v. Express Co., 36 Fed. Rep. 252, 253.

43—Philadelphia R. R. Co. v. Quigley, 62 U. S. (21 Howard), 213; 16 L. Ed. 73; Milwaukee R. R. Co. v. Arms, 91 U. S. 487, 492; 23 L. Ed. 374; Missouri Pacific Railway v. Humes, 115 U. S. 512, 521; 29 L. Ed. 463; Barry v. Edmunds, 116 U. S. 550, 562; 29 L. Ed. 729; Denver Railway v. Harris, 122 U. S. 597, 609; 30 L. Ed. 1146. Exemplary damages may be allowed even where no actual damage is proven. Press Publishing Co. v. Monroe, 73 Fed. Rep. 196, 201.

44—The Amiable Nancy, 16 U. S. (3 Wheat.) 546, 558; 4 L. Ed. 456.

45—Le Page Co. v. Russia Cement Co., 2 C. C. A. 555; 51 Fed. Rep. 941, 949; Taylor v. Carpenter, 11 Paige, 292; 2 Sandf. 603; Cof-

The St. Louis Court of Appeals has said, by Blakewell, J., in an action of deceit based upon trademark infringement: "As to the damages, the facts present a case of fraud on plaintiff and violation of his rights for which the action lies without proof of specific damages And the damage was not confined to the loss of such actual sales as could be specifically shown to be lost, but the jury might make such inferences as to the loss and injury sustained by plaintiff as they might think warranted by the whole evidence in the case."[46] Much to the same effect is the holding of the Massachusetts Supreme Court.[47]

In California the rule of assessing damages would seem to give the plaintiff the profits made by the defendant in his sales of goods bearing the infringing mark.[48]

But it is very doubtful if that course is proper in an action at law. Damages were the appropriate, and indeed the only, remedy at law, while the account of profits was peculiar to courts of equity.[49]

Under the English practice a custom has grown up by which a complainant in equity may pray for an account of profits and an inquiry as to damages (and it has been held in Wisconsin that this is the proper course in pleading)[50] but before any order for discovery can be made he must elect between the accounting of profits and the inquiry of damages. He can not have both.[51] As said by Cotton, L. J., in the English Court of Appeal, in refusing discovery asked by a complainant before he had elected between profits and damages: "At the time when the order was made, the plaintiff had not elected to waive his account of profits. Would it then be right to allow the plaintiff to get a jury to determine what damages he was entitled to before he had made his election betwen damages and profits? Should the jury award

feen v. Brunton, 4 McLean, 516, 520; Fed. Case No. 2946; Blofield v. Payne, 4 Barn. & Ad. 410, 411; Marsh v. Billings, 7 Cushing, 322, 331; Conrad v. Brewing Co., 8 Mo. App. 277, 285; El Modello Cigar Co. v. Gato, 25 Fla. 886, 915; 9 So. Rep. 23.

46—Conrad v. Brewing Co., 8 Mo. App. 277, 285.

47—Marsh v. Billings, 7 Cushing, 322, 332.

48—Graham v. Plate, 40 Cal. 593, 598.

49—Sebastian, Trademarks (4th Ed.), p. 232.

50—Leidersdorf v. Flint (2), 50 Wis. 401.

51—Neilson v. Betts, L. R. 5 H. L. R. 1.

him a large sum for damages, he would probably accept it; but if they gave him a small sum only, then he might say, 'No, I would rather have an account of profits, as I see by the defendant's books that he has made a much larger sum.' "[52]

It would seem that the damages at law must be based upon the injury sustained by the complainant by loss of sales and injury to the reputation of his trademark. Evidence of the extent of the defendant's sales may be proper,[53] but only as proof of injury to the complainant, and not with a view to measuring the plaintiff's damages by the defendant's profits.

Of course the fact that the defendant has discontinued his infringement is no defense to an action of damages,[54] which would be barred only by the operation of the statute of limitations. It is competent to show that plaintiff's sales have fallen off because of the infringement.[55]

A Canadian decision held that damages could not be recovered for the sale of a second-hand stove to which a second manufacturer's name-plate has been added, where the plate was put on by an employe without the employer's knowledge and the purchaser was informed of the real manufacture of the stove.[56]

52—Fennessy v. Clark, L. R. 37 Ch. D. 184, 187.

53—Le Page Co. v. Russia Cement Co., 2 C. C. A. 555; 51 Fed. Rep. 941, 949; 17 L. R. A. 354.

54—Lemoine v. Gauton, 2 E. D. Smith, 343; Cox, 142; Seb. 125.

55—Shaw v. Pilling, 175 Pa. St. 78, 84. It is competent to show that a diminution of plaintiff's sales occurred concurrently with defendant's infringement. Whether the latter is the cause of the former is a question for the jury. *Ibid.*

56—Chapleau v. Laporte, 16 Rap. Jud. Que. C. S. 189.

CHAPTER XIII.

THE ACTION IN EQUITY.

§ 186. The basis of equitable jurisdiction.—Lord Westbury said: "Imposition on the public occasioned by one man selling his goods as the goods of another can not be the ground of private action or suit. In the language of Lord Thurlow in *Webster v. Webster*,[1] 'The fraud upon the public is no ground for the plaintiff coming into court.' It is, indeed, true, that, unless the mark used by the defendant be applied by him to the same kind of goods as the goods of the plaintiff, and be in itself such that it may be and is mistaken in the market for the trademark of the plaintiff, the court can not interfere, because there is no invasion of the plaintiff's right; and thus the mistake of the buyers in the market, under which they, in fact, take the defendant's goods as the goods of the plaintiff, that is to say, imposition on the public, becomes the test of the property in the trademark having been invaded, and not the ground on which the court rests its jurisdiction."[2]

In quoting the extract given above, Vice Chancellor Van Vleet has said: "The rule as thus stated I understand to be the established doctrine now in force on this subject both in this country and in England."[3]

In the early English practice the chancellor had power to refuse or postpone the application of equitable remedies in trademark cases until the title to the trademark had been determined in a court of law. This practice continued until November 1, 1862, when the "Chancery Regulation Act, 1862,"[4] went into

1—3 Swanst. 490.

2—Leather Cloth Co. v. American Leather Cloth Co., 4 DeG. J. & S. 137, 141.

3—Schneider v. Williams, 44 N. J. Eq. 391, 393. To the same effect see Weener v. Brayton, 152 Mass. 101, 103; Avery v. Meikle, 81 Ky. 73, 91; Liggett & Myers Tobacco Co. v. Sam Reid Tobacco Co., 104 Mo. 53, 60; McLean v. Fleming, 96 U. S. 245, 251; 24 L. Ed. 828; Shaver v. Shaver, 54 Iowa, 208, 209; Barrows v. Knight, 6 R. I. 434, 438; Handy v. Commander, 49 La. Ann. 1119.

4—25 and 26 Victoria, c. 42, p. 154.

effect. The first section of that act provides that "In all cases in which any relief or remedy within the jurisdiction of the said courts of chancery respectively is or shall be sought in any cause or matter instituted or pending in either of said courts, and whether the title to such relief or remedy be or be not incident to or dependent upon a legal right, every question of law or fact, cognizable in a court of common law, on the determination of which the title to such relief or remedy depends, shall be determined by or before the same court."

It is important to bear this enactment in mind in examining the earlier English trademark cases, as it explains the many failures of equity to act, or the deferring of relief by injunction until the determination of the right to the use of the trademark by trial at law.

Equity first extended its beneficent protection to the owners of trademarks because of the inadequacy of the remedy at law. This inadequacy arose from the absence of the power in courts of law to act *in personam*—the injunctive power. But there were other reasons why cognizance of trademark causes belonged peculiarly to equity. Prominent among these was the power of the chancellor in granting discovery—the right to discovery being, as Mr. Bispham says, one of the peculiar advantages of a complainant in equity, enjoyed by him in every case in which he was entitled to come into chancery, either for the purpose of asserting an equitable title, or setting up an equitable right or applying an equitable remedy;[5] though the right was always conditioned by the necessary restriction that the person brought in on discovery need not disclose matters tending to incriminate him or expose him to penalty or forfeiture. And there was yet another reason why this litigation found its way to the chancellor. One of the most ancient forms of action at the common law was the action of account. "But," in the words of Mr. Justice Story, "the modes of proceeding in that action, although aided from time to time by statutable provisions, were found so very dilatory, inconvenient and unsatisfactory, that as soon as courts of equity began to assume jurisdiction in matters of account, as they did at a very early period, the remedy at law began to decline; and although some efforts have been made in

5—Bispham, Equity (4th ed.), p. 600, § 557.

modern times to resuscitate it, it has in England fallen into almost total disuse."[6] So, when it became apparent that an account of profits must be sought as, at least, the basis of a proper money judgment against an infringer, the parties litigant were forced to enter the domain of equity. But, above all, there was that power in equity described by Blackstone as the power "to detect latent frauds and concealments, which the process of the courts of law is not adapted to reach."[7] While not exclusive of the courts of law, the courts of equity had original, independent and inherent jurisdiction to relieve against every species of fraud.[8]

The remedy sought governs largely the question of jurisdiction in equity. If a mere accounting is sought for, it is insufficient to vest such jurisdiction, for the account must be incidental to some other equitable relief.[9] Jurisdiction in equity will not attach for discovery simply, except in aid of a suit at law; the party applying must invoke some other distinct equitable ground.[10]

§ 187. The bill in equity.—The new equity rules provide, as to the bill of complaint, as follows:

25.

BILL OF COMPLAINT—CONTENTS.

Hereafter it shall be sufficient that a bill in equity shall contain, in addition to the usual caption:

First, the full name, when known, of each plaintiff and defendant, and the citizenship and residence of each party. If any party be under any disability that fact shall be stated.

Second, a short and plain statement of the grounds upon which the court's jurisdiction depends.

Third, a short and simple statement of the ultimate facts upon which the plaintiff asks relief, omitting any mere statement of evidence.

6—Story, Equity Jurisprudence (13th Ed.), § 442.

7—1 Blackstone, Commentaries, 92.

8—Kerr, Fraud and Mistake (Bump's Ed.), p. 43.

9—Root v. L. S. & M. S. Railway Co., 105 U. S. 189; 26 L. Ed. 975; Van Raalt v. Schneck, 159 Fed. Rep. 248, 251; affirmed in Van Raalt v. Schneck, 95 C. C. A. 672; 170 Fed. Rep. 1021.

10—Lord v. Whitehead & Atherton Machine Co., 24 Fed. Rep. 801.

Fourth, if there are persons other than those named as defendants who appear to be proper parties, the bill should state why they are not made parties—as that they are not within the jurisdiction of the court, or can not be made parties without ousting the jurisdiction.

Fifth, a statement of and prayer for any special relief pending the suit or on final hearing, which may be stated and sought in alternative forms. If special relief pending the suit be desired the bill should be verified by the oath of the plaintiff, or someone having knowledge of the facts upon which such relief is asked.[11]

11—A new rule, taking the place of former Rules 20, 21, 22, 23 and 24.

The salutation of former Rule 20 is abolished. The anticipatory matter to avoid matters expected to be pleaded by way of defense in the answer, provided for by former Rule 21, is not referred to, but obviously may still be pleaded.

The "short and simple statement of the ultimate facts" provided for in the present rule is apt to prove an uncertain guide to the bar. The paragraph embodies what has long been recognized as the fundamental rule of equity pleading in this country; but it makes no provision for those recitals of conditions precedent that have been held essential to the sufficiency of bills for patent infringement, and the like. Does the third paragraph of Rule 25 mean to dispense with such recitals? It is by no means clear. It would have been clear and unequivocal had the rule been drawn as suggested by the Bar Committee appointed by the Circuit Court of Appeals for the Sixth Circuit, which reads as follows:

"Provide that it shall be sufficient in pleading a judgment or other determination of a court, or of an officer of special jurisdiction, or a patent, or other public grant, to allege that it was duly made or issued; that in pleading the performance of conditions precedent in a contract, it shall be sufficient to state that the party duly performed all the conditions on his part; and that it shall not be sufficient in any case herein mentioned to deny the allegation generally, but the facts relied upon must be specifically stated.

"This rule is suggested, because it has been held on the circuit that it is not sufficient, in a bill for the infringement of a patent, to allege that the patent was duly issued, but that it is necessary to aver all the facts on which authority to issue the patent depends. The result is that bills in such cases are unnecessarily prolix."

This provision of Rule 25 has its inadequacy demonstrated by a reference to the English rule, Order XIX, Rule 14:

"Any condition precedent, the performance or occurrence of which is intended to be contested, shall be distinctly specified in his pleading by the plaintiff or defendant

The bill should show: (1) The ownership of the trademark, describing it and the mode of its application to merchandise. (2) The registration of that trademark under the act (if registered), and the value of the trademark. (3) The facts in relation to the infringement of the trademark by the respondent. This part of the bill differs from the corresponding part of the declaration at law in this, that it need not be averred that the defendant had guilty knowledge,[12] although that fact should be averred where it is true. Where profits are sought to be recovered there should be a direct averment that such profits have been realized by the defendant on account of the infringement.

In every case where the value of the complainant's trademark is over three thousand dollars, that fact should be pleaded,[13] as a jurisdictional safeguard, independent of the fact of registration under the act of congress. A matter of paramount importance where the parties are citizens of the same state is an

(as the case may be); and, subject thereto, an averment of the performance or occurrence of all conditions precedent necessary for the case of the plaintiff or defendant shall be implied in his pleading."

As it has been repeatedly held that the recital of conditions precedent is not a "mere statement of evidence," and as the rule of stating ultimate facts has always obtained, it is the writer's opinion that the third paragraph of Rule 21 does not relieve the pleader of the necessity of pleading such conditions precedent, precisely as heretofore.

The fourth paragraph embodies the substance of former Rule 22.

The fifth papagraph makes no reference to the prayer for process of subpœna, specified in former Rule 23; the clerk is now required by Rule 12 to issue the subpœna as of course, rendering the prayer therefor unnecessary.

That the bill need state only the ultimate facts, see Wilson v. American Ice Co., 206 Fed. Rep. 736. That this rule prescribes what shall be sufficient to sustain a bill, but is not an absolute direction as to what the bill shall contain, see Pittsburgh Water Heater Co. v. Beler Water Heater Co., 222 Fed. Rep. 950. As to stating more than one cause of action, while avoiding repetition by cross-referencing, see Maxwell Steel Vault Co. v. National Casket Co., 205 Fed. Rep. 515. That no prayer for process is necessary, or waiver of answer under oath, see Pittsburgh Water Heater Co. v. Beler Water Heater Co., *supra*.

12—McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828.

13—Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823. A bill is sufficient in this regard which recites that "the amount in controversy exceeds the sum of $3000." Griggs, Cooper & Co. v. Erie Preserving Co., 131 Fed. Rep. 359, 360.

averment that the complainant uses his trademark in interstate commerce or commerce with foreign nations or with the Indian tribes,[14] and under the Act of 1881 it had to be averred and proven in such a case that the defendant had used the infringement in commerce with foreign nations or with the Indian tribes.[15] Where the parties are of diverse citizenship no such averment is necessary.[16] Whatever allegations are essential must be made positively and not on information and belief.[17]

"On divers days and at divers places" has been held to be a sufficient allegation as to time and place of infringement, the bill alleging both to have been within the jurisdiction of the court.[18]

In a bill for unfair competition it has been held that to charge the defendant's acts as being "calculated to deceive" is insufficient, failing to charge him with intent to deceive, and rendering the bill demurrable.[19]

The prayer for relief should be both special and general, under the directions given in the twenty-fifth federal equity court. The special portion of the prayer should ask for a preliminary injunction (if it is desired), a perpetual injunction, for an account of the defendant's profits, and for an assessment of the damages sustained by the complainant by reason of the injuries he has sustained through the loss of reputation of his trademark or otherwise. A bill is not demurrable on the ground that it prays for damages in addition to profits, because both can be recovered where fraudulent intent is established.[20] But punitive or exemplary damages should not be prayed for, as they can not be

14—Ryder v. Holt, 128 U. S. 525; 32 L. Ed. 529; Luyties v. Hollender (1), 21 Fed. Rep. 281 22 Blatchf. 413; Schumacher v. Schwenke (1), 26 Fed. Rep. 818; Schumacher v. Schwenke (2), 36 Off. Gaz. 457; Gravely v. Gravely, 42 Fed. Rep. 265.

15—Gravely v. Gravely, 42 Fed. Rep. 265; 52 Off. Gaz. 1538; Warner v. Searle & Hereth Co., 191 U. S. 195; 48 L. Ed. 145.

16—Hennessy v. Braunschweiger & Co., 89 Fed. Rep. 669.

17—Gaines & Co. v. Sroufe, 117 Fed. Rep. 965.

18—Charles E. Hires Co. v. Simpkins, 179 Fed. Rep. 1012.

19—Industrial Press v. W. R. C. Smith Pub. Co., 164 Fed. Rep. 842; 90 C. C. A. 604.

20—El Modello Cigar Co. v. Gato, 25 Fla. 886, 915; 7 So. Rep. 23; Benkert v. Feder, 34 Fed. Rep. 534. Under the Kentucky practice a plaintiff was compelled to elect between profits and damages. E. H. Taylor, Jr., & Sons Co. v. Taylor, 27 Ky. L. Rep. 625; 85 S. W. Rep. 1085.

assessed in equity.[21] Where the bill charges the infringement of a registered mark the prayer should ask for an increase of the actual damages found, as provided in sec. 19 of the Act of 1905.

The prayer for general relief should be in the form usual in equity pleading.[22]

Unless a preliminary injunction is prayed for the bill need not be verified.[23]

21—Hennessy v. Wilmerding-Loewe Co., 103 Fed. Rep. 90.

22—*A bill to enjoin unfair competition* must expressly charge that the defendant has attempted or intended to practice fraud upon the public. Lamont v. Leedy, 88 Fed. Rep. 72, 74. But this rule is hardly broad enough. The better doctrine would seem to be that the bill need only charge that the defendant's merchandise is calculated to deceive the public. Judge Lacombe, referring to the practice of the federal courts in cases of unfair trade, has said: "Nor do these courts require specific proof of purchases by individuals actually deceived, when the labels themselves show an attempt at deception which appears to be well calculated to deceive." Collinsplatt v. Finlayson, 88 Fed. Rep. 693. And the same learned court indicates the same rule in Burnett v. Hahn, 88 Fed. Rep. 694.

A bill to enjoin the manufacturer or vendor of spurious labels must contain an express charge that the defendant is actually engaged in assisting third persons to palm off their goods upon the public as the goods of the complainant, or a substantially equivalent averment. De Kuyper v. Witteman, 23 Fed. Rep. 871; Hennessy v. Herrmann, 89 Fed. Rep. 669.

A bill to enjoin the infringement of a technical trademark must set up facts showing an exclusive right to the use of the mark in the plaintiff. He "must recover upon the strength of his own title, and not upon the weakness of the defendant's." Brown, J., in O'Rourke v. Central City Soap Co., 26 Fed. Rep. 576-579.

Improper joinder of causes of action.—A bill is multifarious that joins with a charge of unfair competition by the use of a trade-name a claim for damages under the Sherman anti-trust act of July 2, 1890. Block v. Standard Distilling & Distributing Co., 95 Fed. Rep. 978.

A bill is multifarious that joins with a charge of unfair competition (by passing off the defendant's goods in unmarked packages as and for plaintiff's goods) a charge of patent infringement. Ball & Socket Fastener Co. v. Cohn, 90 Fed. Rep. 664.

Averment of ownership.—A bill for trademark infringement failing to aver ownership of the trademark is fatally defective. Pennell v. Lothrop, 191 Mass. 357; 77 N. E. Rep. 842.

23—Hughes v. Northern Pacific Ry. Co., 18 Fed. Rep. 106, 110; Black v. Allen, 42 Fed. Rep. 618, 623.

These suggestions for the most part relate to bills in the federal courts. The decisions of those courts are so harmonious that the great bulk of the trademark litigation is before them. As to the state courts, reference must necessarily be had to the local forms of action (or absence of such forms) created by legislative enactment.

As to the joinder of causes of action the new rules provide as follows:

26.

JOINDER OF CAUSES OF ACTION.

The plaintiff may join in one bill as many cases of action, cognizable in equity, as he may have against the defendant. But when there are more than on plaintiff, the causes of action joined must be joint, and if there be more than one defendant the liability must be one asserted against all of the material defendants, or sufficient grounds must appear for uniting the causes of action in order to promote the convenient administration of justice. If it appear that any such causes of action can not be conveniently disposed of together, the court may order separate trials.[24]

24—A new rule, based upon the English rule:

"Subject to the following rules of this order, the plaintiff may unite in the same action several causes of action, but if it appear to the court or a judge that any such causes of action can not be conveniently tried or disposed of together, the court or judge may order separate trials of any of such causes of action to be had, or may make such other order as may be necessary or expedient for the separate disposal thereof." (Order XVIII., Rule 1.)

An illustration of the operation of this rule is found in a case in which the plaintiff alleged the infringement of twenty-three patents. Application was made to limit the action (under Order XVIII, Rules 8 and 9, and Order XIX, Rule 27), upon which application the court of appeal held that plaintiff was not entitled to unite the twenty-three patents in one suit, but should be directed to select a group of his patents, not exceeding three, as being "such of the causes of action as may be conveniently disposed of together" (this being the language of Order XVIII, Rule 8). Saccharin Corp. v. Wild (1903), 1 Ch. 410.

That this rule does not compel the joinder of dissimilar actions, or of causes which would require various kinds of relief or various accountings, see Marconi Wireless Tel. Co. v. National Elec. Signaling Co., 206 Fed. Rep. 295. That it does not authorize the joinder of a suit in equity and an action at

A bill for unfair competition will not be held bad on motion to dismiss upon the ground that the words and phrases charged to be used by the defendant might lawfully and properly be used by him separately, where it is apparent that by their conjoint use he has been competing unfairly.[25]

§ 188. Presenting the defenses.—The methods of attacking the bill have been radically changed as to form by the new equity rules.

29.

DEFENSES—HOW PRESENTED.

Demurrers and pleas are abolished. Every defense in point of law arising upon the face of the bill, whether for misjoinder, nonjoinder, or insufficiency of fact to constitute a valid cause of action in equity, which might heretofore have been made by demurrer or plea, shall be made by motion to dismiss or in the answer; and every such point of law going to the whole or a material part of the cause or causes of action stated in the bill may be called up and disposed of before final hearing at the discretion of the court. Every defense heretofore presentable by plea in bar or abatement shall be made in the answer and may be separately heard nd disposed of before the trail of the principal case in the discretion of the court. If the defendant move to dismiss the bill or any part thereof, the motion may be set down for hearing by either party upon five days' notice, and, if it be denied, answer shall be filed within five days thereafter or a decree *pro confesso* entered.[26]

law, see Bueyrus Co. v. McArthur, 219 Fed. Rep. 266. That the nature of one cause of action stated in the bill, of itself creating jurisdiction, can not give the court jurisdiction over a joined cause of action over which jurisdiction is dependent upon amount in controversy and diverse citizenship, see Vose v. Roebuck, etc. Co., 210 Fed. Rep. 687.

25—Holeproof Hosiery Co. v. Richmond Hosiery Mills, 167 Fed. Rep. 381.

26—Demurrers were abolished in the English practice by the following rule:

"No demurrer shall be allowed (Order XXV, Rule 1).

Order XV provides, as indicated in its title, "Proceedings in Lieu of Demurrer," and of this order the court of appeal has said that it "abolished demurrers and substituted a more summary process for getting rid of pleadings which show no reasonable cause of action or de-

§ 189. The answer.—The provision of the new rules as to the answer is as follows:

30.

ANSWER—CONTENTS—COUNTER-CLAIM

The defendant in his answer shall in short and simple terms set out his defense to each claim asserted by the bill, omitting any mere statement of evidence and avoiding any general denial of the averments of the bill, but specifically admitting or denying or explaining the facts upon which the plaintiff relies, unless the defendant is without knowledge, in which case he shall so state, such statement operating as a denial. Averments other than of value or amount of damage, if not denied, shall be deemed confessed, except as against an infant, lunatic or other person *non compos* and not under guardianship, but the answer may be amended, by leave of the court or judge, upon reasonable notice, so as to put any averment in issue, when justice requires it. The answer may state as many defenses, in the alternative, regardless of consistency, as the defendant deems essential to his defense.

The answer must state in short and simple form any counter-claim arising out of the transaction which is the sub-

fense. Two courses are open to a defendant who wishes to raise the question whether, assuming a statement of claim to be proved, it entitles the plaintiff to relief. One method is to raise the question of law as directed by Order XXV, Rule 2; the other is to apply to strike out the statement of claim under Order XXV, Rule 4. The first method is appropriate to cases requiring argument and careful consideration. The second and more summary procedure is only appropriate to cases which are plain and obvious, so that any master or judge can say at once that the statement of claim as it stands is insufficient, even if proved, to entitle the plaintiff to what he asks." Hubback v. Wilkinson (1899), 1 Q. B. 90, 91.

Pleas in abatement were expressly abolished in England by Order XXI, Rule 20—"No plea or defense shall be pleaded in abatement."

Motions to dismiss.—That such motion will be denied unless it appears that upon the ground of the motion the bill would have to be dismissed at final hearing, see Ralston Steel Car Co. v. National Dump Car Co., 222 Fed. Rep. 590. That such motion raises such questions as could be raised by demurrer under the old rules, see Hyams v. Old Dominion Co., 204 Fed. Rep. 681; Fordham v. Hicks 224 Fed. Rep. 810.

ject-matter of the suit, and may, without cross-bill, set out any set-off or counter-claim, against the plaintiff which might be the subject of an independent suit in equity against him, and such set-off or counter-claim, so set up, shall have the same effect as a cross-suit so as to enable the court to pronounce a final judgment in the same suit both on the original and cross-claims.[27]

§ 190. Particulars.—The new equity rules provide for particulars as follows:

20.

FURTHER AND PARTICULAR STATEMFNT IN PLEADING MAY BE REQUIRED.

A further and better statement of the nature of the claim or defense, or further and better particulars of any matter

27—A new rule, largely based on the English practice; but so radically different from that practice that the English decisions will be of small benefit to the American practitioner. See Order XIX, Rules 2 and 3.

At common law a defendant who had a claim against the plaintiff could not assert it by way of set-off or counter-claim, save that, when sued for the purchase price of merchandise, he could set up breach of warranty, express or implied. Street v. Blay (1831), 2 Barn. & Ad. 456.

The statute of 2 Geo. II, c. 22, permitted the defendant to plead a set-off in certain cases; but in courts of law only legal liabilities could be off-set, while in courts of equity, equitable claims for liquidated amounts, created between the same parties and in the same right could be so off-set. Cavendish v. Greaves, 24 Beav. 163. Under the modern practice in England the defendant may acquire and set off a debt owing by the plaintiff to a stranger to the litigation, Bennett v. White, W. N. (1910), 167.

A set-off is still a defense to the plaintiff's claim; while a counter-claim is a cross-action, which need not have any connection, however remote, with the plaintiff's cause of action. It need not be "an action of the same nature as the original action." Beddall v. Maitland, 17 C. D. 181. The net result of the revised procedure in England is that a legal counter-claim may be interposed in chancery, and an equitable claim in an action at law. Fleming v. Lee (1901), 2 Ch. 594.

As to the purpose and intent of the rule in simplifying the answer, see Coulston v. Francke Steel Range Co., 221 Fed. Rep. 669; Pittsburgh Water Heater Co. v. Beler Water Heater Co., 222 Fed. Rep. 950. As to comparison with the working of the English rules, see Terry Steam Turbine Co. v. B. F. Sturtevant Co., 204 Fed. Rep. 103; Buffalo Specialty Co. v. Vancleef, 217 Fed. Rep. 91. That the rule does not permit a strictly legal demand to

stated in any pleading, may in any case be ordered, upon such terms, as to costs and otherwise, as may be just.[29]

§ 191. Scandal and impertinence.—The provisions of the new equity rules are as follows:

be counter-claimed, see Motion Picture Patents Co. v. Eclair Film Co., 208 Fed. Rep. 416.

28—This is a new rule, based upon the English rule (Order XIX, Rule 7), which reads:

"A further and better statement of the nature of the claim or defense, or further and better particulars of any matter stated in any pleading, notice, or written proceeding requiring particulars, may in all cases be ordered, upon such terms as to costs and otherwise, as may be just."

The words "upon such terms" have been held to authorize an order that if proper particulars be not delivered within a time fixed in the order, the action shall stand dismissed. Davey v. Bentinck (1893), 1 Q. B. 185.

"The object of particulars is to enable the party asking for them to know what case he has to meet at the trial, and so to save unnecessary expense, and avoid allowing parties to be taken by surprise." Cotton, L. J., in Spedding v. Fitzpatrick, 38 C. D. p. 413.

"Sometimes particulars have been allowed in order that there might not be a surprise at the trial. Sometimes they have been allowed as limitations of the claim, to limit the extent of the evidence to be given at the trial. Under the Judicature Act particulars are really supplemental to the pleadings. They are in fact amendments of the pleadings." Vaughn Williams, L. J., in Milbank v. Milbank (1900), 1 Ch. 385.

On account of this rule, it is sound policy to plead fully the facts relied upon (but not the evidence proving those facts), in order to avoid the motion for particulars. Maxwell Steel Vault Co. v. National Casket Co., 205 Fed. Rep. 515; Williams v. Pope, 215 Fed. Rep. 1000. In applying the rule the court will deny a motion for the disclosure of the names of witnesses to the facts of unfair competition pleaded in the bill, for the reasons stated by Judge Chatfield as follows:

"In so far as the motion is merely an attempt to secure the names of witnesses or the details of the plaintiff's evidence, it should be denied. But, apart from this, the knowledge of where, to whom, and under what conditions, sales have been made by the defendant at wholesale prices, are matters known to the defendant much better than to the plaintiff. In the trial of a suit in equity, even under the present rules, no hardship would seem to be involved in refusing to give to the defendant information of just when, where and how it has dealt with its own customers. The opportunity for fair hearing and cross-examination can be amply protected. Curtis v. Phelps (D.C.), 209 Fed. 261." United Lace & Braid Mfg. Co. v. Barthels Mfg. Co., 213 Fed. Rep. 535.

21.

SCANDAL AND IMPERTINENCE.

The right to except to bills, answers, and other proceedings for scandal or impertinence shall not obtain, but the court may, upon motion of its own initiative, order any redundant, impertinent or scandalous matter striken out, upon such terms as the court shall think fit.[29]

§ 192. The defenses in equity.—All defenses good in the action at law are good in the action in equity except that of the innocence of the defendant of wrongful intent. In a case where both parties have the right to use the trademark, the defendant will be enjoined from using the words "the only genuine" in connection with the trademark.[30] The plaintiff must, of course, be actually entitled to use the trademark having applied it commercially. Thus Sir James Clark's application to restrain one Freeman from advertising or selling pills under the name of "Sir J. Clark's Consumption Pills" was denied because the plaintiff was not engaged in the sale of pills.[31] The plaintiff

29—This is a new rule, abolishing the old practice as to exceptions for scandal and impertinence. See former Rules 26 and 27.

The English Rule.—"The court or a judge may at any stage of the proceedings order to be struck out or amended, any matter in any indorsement or pleading which may be unnecessary or scandalous, or which may tend to prejudice, embarrass or delay the fair trial of the action; and may in any such case, if they or he shall think fit, order the costs of the application to be paid as between solicitor and client." (Order XIX, Rule 27.)

The application must be made promptly or the court may decline to exercise its jurisdiction. Cross v. Howe, 62 L. J. Ch. 342.

It will be noted that the English rule uses the word "unnecessary" where Rule 12 refers to "redundant" matter. It is, therefore, important to note that in the English practice, if the matter is otherwise harmless, it will not be struck out merely because it is unnecessary. Rock v. Pursell, 84 L. T. Jo. 45.

Scandalous matter, in England, may be expunged by the court from any part of the record, and even from a bill of costs. *In re* Miller, 54 L. J. Ch. 205. "Nothing can be scandalous which is relevant." Cotton, L. J., in Fisher v. Owen, 8 C. D., p. 653.

For an application of this rule, see Williams v. Pope, 215 Fed. Rep. 1000.

30—James v. James, L. R. 13 Eq. Cas. 421; Cocks v. Chandler, L. R. 11 Eq. Cas. 446.

31—Clark v. Freeman, 11 Beav. 112. This decision is criticised in Maxwell v. Hogg, L. R. 2 Ch. App. 307; but it is manifestly correct

may not be entitled to recover because of his not having an exclusive right to the mark; or because he has, without authority, used the words "patent" or "patented" in connection with or as a part of what he claims as his trademark. Or he may have made fraudulent representations in connection with his trademark which will prevent his recovering the relief sought for. A single act done at the suggestion of the plaintiff's agent will not be treated as an infringement.[32]

It is a good defense that the defendant is merely reselling goods made in conformity with a decree of injunction entered in a former suit against the manufacturer.[33] It is obviously a good defense that the plaintiff's mark is an infringement of another's mark.[34]

It often happens that the defendant may plead by way of mitigation of damages or so as to avoid his liability for an accounting or for costs.[35] Thus, in an English case, the defendants purchased five hundred cigarettes, worth only 17s. 6d., and which bore a mark which was an infringement of the plaintiff's. The court granted the application for injunction, but refused to order the defendants to pay costs, saying by Sterling, J.: "I confess I think this is not a sort of action that ought to be encouraged. If persons find a trademark is being pirated, surely it is not the small retailers who ought to be punished. * * * I can not think that it is the duty of the court in every case in

in principle, considered as a trade-name case. Lord Justice Cairns says (L. R. 2 Ch. App. 310): "It has always appeared to me that Clark v. Freeman might have been decided in favor of the plaintiff on the ground that he had a property in his own name," *i. e.*, a right of privacy, which involves a discussion which it would be aside from our purpose to enter upon here. Lord Chancellor Selborne has criticised Clark v. Freeman, from another standpoint, saying: "That case has been seldom cited but to be disapproved. Could not a professional man be injured in his profession by having his name associated with a quack medicine?" *In re* Riviere's Trademark, L. R. 26 Ch. D. 53.

32—Hennessy v. Kennett, Seb. 556; Gorham Mfg. Co. v. Emery-Bird-Thayer Co., 92 Fed. Rep. 774; Hostetter Co. v. Brunn, 107 Fed. Rep. 707.

33—Societe Anonyme Benedictine v. Hygrade Wine Co., 173 Fed. Rep. 796.

34—Ubeda v. Zialcita, 226 U. S. 452; 57 L. Ed. 296.

35—Guilhon v. Lindo, 9 Bos. 605; Cox' American Trademark Cases, 295.

which a small dealer who has innocently happened to purchase a small quantity of the spurious goods, to fix him with the costs of an action."[36] A defendant who was printing labels for a third party did not know that the labels bore counterfeits of plaintiff's trademarks. On being notified of the fact of infringement, defendant offered to surrender the lithograph stone and promised to desist from further printing the counterfeit labels. The court adopted the same course as that taken by the English court in the last named case—granted an injunction but at complainant's costs.[37] This case shows that it is not wise to notify a defendant before suing. It has been expressly and repeatedly held that the defendant is not entitled to notice,[38] and it is related by Chitty, J., that when that very learned jurist, the late Sir G. Jessel, master of the rolls, was at the bar, it was his custom to advise his clients in trademark actions not to give any notice but to move at once.[39]

These suggestions are given here to call the attention of the practitioner whose duty is to defend the alleged infringer to the very serious question of avoiding costs.

It may be possible to defend successfully on the ground that, although the plaintiff has applied his trademark in commerce he has not applied it to the same character or class of merchandise as that to which the defendant is applying it. We have touched upon this question before, but a more extended consideration of it may be advisable. To answer the question of whether the defendant's use of the complainant's trademark is such an unlawful use that it should be restrained, "the extent of the owner's property in a trademark, and the character of the act which is held to injuriously affect his property rights, and to call for the interposition of a court of equity, must be ascertained. * * * The deceit of the public and the subsequent

36—American Tobacco Co. v. Guest, 9 R. P. C. 218; L. R. (1892) 1 Ch. D. 630; 61 L. J. Ch. 242; 66 L. T. 257; 40 W. R. 364; Cartmell, 45.

37—Bass v. Guggenheimer, 69 Fed. Rep. 271.

38—Upmann v. Forester, L. R. 24 Ch. D. 231; 52 L. J. Ch. 946; 49 L. T. 122; 32 W. R. 28.

39—Upmann v. Forester, L. R. 24 Ch. D. 231-235. The following cases illustrate the danger of giving notice before suit. G. W. Cole v. Cole's Oil Co., 147 Fed. Rep. 930; Dwinell-Wright Co. v. Co-operative Supply Co., 148 Fed. Rep. 242.

injury to it are as much to be regarded by a court of equity as an injury to a plaintiff's business. It therefore follows that the right of an owner of a trademark is not a right to its exclusive use everywhere and under all circumstances."[40] Thus, an iron manufacturer using a lion's head as his trademark can not enjoin a linen manufacturer from using a lion's head as his mark.[41] It was held that "Fruit Salt" as a trademark for an effervescing drink, a registered mark, might be interfered with by the words "Fruit Salt" designating a baking powder. In this case it was shown that the "Fruit Salt" used in producing the effervescing drink had been used as a baking powder, in exceptional cases; but the court remarked that if it were proposed to so employ the words "Fruit Salt" that "no reasonable person could suppose that they had reference to the appellant's preparation, such a use would be perfectly unobjectionable. For example, I can not conceive any one imagining that a "Fruit Salt Umbrella" was in any way connected with the article manufactured by Mr. Eno (the effervescing drink)."[42] So it has been held in this country that the word "Celluloid" is a valid trademark as applied to articles actually composed of celluloid,[43] but that the use of the word "Celluloid" to designate a starch is not an infringement, because celluloid had never been used in making starch and there was no testimony to show that the plaintiff had intended ever to use it in making starch. There was expert testimony to the effect that it was highly probable that a method might be devised by which celluloid could be converted into a starch-like body fit for use as a substitute for starch, but the court held this statement of probabilities "too indefinite to be the foundation of an injunction."[44] The whole question depends upon how closely related are the classes of goods to which the complainant and respondent apply the mark.[45]

40—Shipman, J., in Celluloid Mfg. Co. v. Read, 47 Fed. Rep. 712-714.

41—Ainsworth v. Walmsley, 35 L. J. Ch. 352.

42—Lord Herschell in Eno v. Dunn, L. R. 15 App. Cas. 252, 260.

43—Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94.

44—Celluloid Mfg. Co. v. Read, 47 Fed. Rep. 712, 716.

45—Collins Co. v. Ames, 20 Blatchf. 542; 18 Fed. Rep. 561; Amoskeag Mfg. Co. v. Garner, 54 How. Pr. 297; Carroll v. Ertheiler,

The ordinary rules as to the effect of former adjudication necessarily apply to cases of the kind under consideration. A final decree of dismissal in a state court is a bar to a subsequent suit in a federal court by the same complainant against a party in privity with the defendant in the former suit,[46] and the entire record in the former suit is admissible to show identity of subject-matter.[47]

The other defenses, besides those thus far indicated, such as license from the owner or his co-proprietor in the mark, delay, acquiescence or abandonment, have been treated in connection with the defenses at law. But it is proper to note here that where the complainant has been guilty of serious laches his relief will be limited to the injunction, and an accounting will be refused.[48]

Affirmative proof of laches may not exist, yet laches be found as inferable from the circumstances. "The many years' failure to prosecute suggests laches. On the face of things, it would seem that complainant must have known, or should have known, of the infringement if substantial in character; and, if unsubstantial, no accounting is needed." [49]

Where the defendant undertakes to defend by attacking the complainant's title to the mark and fails, the Supreme Court of Louisiana has held that he should be treated as a wanton trespasser.[50]

Where the bill of complaint makes profert of the plaintiff's trademark and exhibits the alleged infringement, a demurrer will be sustained if an inspection of the exhibits satisfies the court that there is no infringement.[51]

1 Fed. Rep. 688; Hecht v. Porter, 9 Pac. C. L. J. 569; Osgood v. Rockwood, Fed. Case No. 10605; 11 Blatchf. 310; Smith v. Reynolds, Fed. Case No. 13098; 10 Blatchf. 100; 13 Blatchf. 458; Swift & Co. v. Groff, 114 Fed. Rep. 605.

46—Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co., 65 Fed. Rep. 424.

47—Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co., 65 Fed. Rep. 424; Adams v. Tannage Pat. Co., 81 Fed. Rep. 179; 26 C. C. A. 326; Kahn v. W. A. Gaines & Co., 161 Fed. Rep. 495, 501; 26 C. C. A. 326.

48—Holt v. Menendez, 23 Fed. Rep. 869, 871; N. K. Fairbank Co. v. Luckel, King & Cake Soap Co., 106 Fed. Rep. 498.

49—Knappen, J., in Devoe Snuff Co. v. Wolff, 124 C. C. A. 302; 206 Fed. Rep. 420, 424.

50—Handy v. Commander, 49 La. Ann. 1119; 22 So. Rep. 230.

51—Collins Chemical Co. v. Capital City Mfg. Co., 42 Fed. Rep. 64; J. C. Hubinger Bros. Co. v. Eddy, 74 Fed. Rep. 551.

But the courts are not inclined to sustain demurrers upon the ground that the plaintiff's mark is not a valid technical trade-mark, where the bill contains the specific charge that the defendant has, by its conduct in the premises, deceived and misled the public into buying its goods as and for the plaintiff's goods.[52] A defect upon the face of the bill, such as a failure to show title to the mark in a complainant, must be met by demurrer and can not be raised by a plea.[53]

Where affirmative relief is sought by the defendant it should be prayed for by cross-bill.[54]

The defense of non-infringement is not properly interposed by a plea, and should be presented by an answer.[55]

A bill may be dismissed because of fraudulent representations made by the complainant in connection with his use of a mark, even though the fact is not pleaded by the defendant. "If it appears from the record, it will be given effect notwithstanding it has not been pleaded. The theory upon which this is done is that in reality it is not a matter of defense. It is given effect to, not on defendant's account, but because of the public."[56]

The sufficiency of the plea is tested by setting it down for argument under Equity Rule 33 on which argument the averments of the plea are taken as true.[57]

There are a number of lines of defense which have been ineffective. Among them are to be particularly noted the following:

1. Infancy.[58]
2. The registration of defendant's mark, because registration is only *prima facie* evidence of ownership.[59]

52—Putnam Nail Co. v. Bennett, 43 Fed. Rep. 800; Lowe Bros. Co. v. Toledo Varnish Co., 168 Fed. Rep. 627; 94 C. C. A. 83.

53—Hostetter Co. v. E. G. Lyons Co., 99 Fed. Rep. 734.

54—Corbin v. E. Taussig & Co., 132 Fed. Rep. 662; Hygienic Fleeced Underwear Co. v. Way, 133 Fed. Rep. 245.

55—G. & C. Merriam Co. v. Straus, 136 Fed. Rep. 477.

56—Memphis Keeley Institute v. Leslie E. Keeley Co., 84 C. C. A. 112; 155 Fed. Rep. 964, 974.

57—W. A. Gaines & Co. v. Rock Springs Dis. Co., 179 Fed. Rep. 544.

58—Chubb v. Griffiths, 35 Beav. 127.

59—Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 823; 23 Blatchf. 46; Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206, 209, 212.

3. Laches or delay, except in unusual cases.[60]
4. Showing that defendant always placed his own address upon his goods, in conjunction with the infringing mark.[61]
5. Showing that defendant has always used his own name or initials in conjunction with the infringing mark. This is not, of itself, a good defense.[62]
6. Showing that defendant has always used the word "Improved" in addition to the alleged infringing words.[63]
7. Showing that the defendant's goods are not inferior in quality to the complainants.[64]
8. Showing that the goods sold are goods made by the complainant, if they are goods to which the complainant did not intend the mark to be applied.[65]
9. Showing that the defendant did not intend to sell the goods bearing the infringing mark.[66]

60—McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828; Lee v. Haley, L. R. 5 Ch. App. 155. See *ante*, § 89.

61—Gray v. Taper-Sleeve Pulley Works, 16 Fed. Rep. 436-442.

62—Menendez v. Holt, 128 U. S. 521; 32 L. Ed. 526; Battle v. Finlay, 50 Fed. Rep. 106; N. K. Fairbank Co. v. Central Lard Co., 70 Off. Gaz. 635; 64 Fed. Rep. 133; Boardman v. Meriden Britannia Co., 35 Conn. 402; Hier v. Abrahams, 82 N. Y. 519; Fleischmann v. Schuckmann, 62 How. Pr. 92; Lea v. Wolff, 15 Abb. Pr. N. S. 1; Carroll v. Ertheiler, 1 Fed. Rep. 388; Hegeman v. O'Byrne, 9 Daly, 264; Pratt's Appeal, 117 Pa. St. 401; Walter Baker & Co. v. Baker, 87 Fed. Rep. 209; Bass, Ratcliff & Gretton (Ltd.) v. Feigenspan, 96 Fed. Rep. 206-210; Leonard v. White's Golden Lubricator Co., 38 Fed. Rep. 922; Gillott v. Esterbrook, 47 Barb. 455; Dunlap & Co. v. Young, 74 N. Y. Supp. 184.

63—Russia Cement Co. v. LePage, 147 Mass. 206; 17 N. E. Rep. 304; Gage v. Canada Pub. Co., 11 Can. S. C. R. 306; Improved Fig Syrup Co. v. California Fig Syrup Co., 54 Fed. Rep. 175; 4 C. C. A. 264.

64—Cleveland Stone Co. v. Wallace, 52 Fed. Rep. 431-436; Taylor v. Carpenter (3), 11 Paige, 292; Coats v. Holbrook, 2 Sandf. Ch. 586; Partridge v. Menck, 2 Sandf. Ch. 622; Cook v. Starkweather, 13 Abb. Pr. N. S. 392; Shaver v. Shaver, 54 Iowa, 208; Colleen v. Brunton, 5 McLean, 256; Gillott v. Esterbrook, 47 Barb. 455; 48 N. Y. 374; Singer Mfg. Co. v. Loog (3), L. R. 8 App. Cas. 15; Edelsten v. Edelsten, 1 DeG. J. & S. 185; Blofield v. Payne, 4 B. & Ad. 410.

65—Krauss v. Jos. R. Peebles' Sons Co., 58 Fed. Rep. 585; Hennessy v. White, 6 W. W. & A'B. Eq. 216; Hennessy v. Hogan, 6 W. W. & A'B. Eq. 225; Gillott v. Kettle, 3 Duer, 624; Hennessy v. Kennett, Seb. 556.

66—Upmann v. Forester, L. R. 24 Ch. D. 231; Upmann v. Curry, 29 Sol. J. 735.

10. Showing that the complainant's mark has been used by others without his knowledge, consent or acquiescence,[67] for "a trespasser can not justify upon the ground that others have committed like trespasses."[68]
11. Showing that the same mark has been used by others on goods of another class.[69]
12. Showing that a third person used the trademark prior to its appropriation by the complainant, when that third person has been refused relief in equity against infringers, because of fraudulent representations made by him in using the mark.[70]
13. Showing that the infringing act was done by the defendant's servants, agents or employes without his knowledge.[71]
14. Showing that defendant partners have incorporated after the institution of the suit.[72]
15. Showing that the complainant gave the defendant no notice of his intention to bring suit.[73]

67—Cuervo v. Jacob Henkell Co., 50 Fed. Rep. 471; Filley v. Fassett, 44 Mo. 173; Cox, 530; Taylor v. Carpenter (1), 3 Story, 458; Cox. 14; Seb. 78; Ford v. Foster, L. R. 7 Ch. App. 611.

68—Actiengesellschaft Vereinigte Ultramarin-Fabriken v. Amberg, 48 C. C. A. 264; 109 Fed. Rep. 151. Reversing same v. same, 102 Fed. Rep. 551.

69—Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94; Colman v. Crump, 70 N. Y. 573; Hegeman v. O'Byrne, 9 Daly, 264; Somerville v. Schembri, L. R. 12 App. Cas. 453-457; Ainsworth v. Walmsley, L. R. 1 Eq. 518; Hall v. Barrows, 4 DeG. J. & S. 150; George v. Smith, 52 Fed. Rep. 830.

70—Parlett v. Guggenheimer, 67 Md. 542-544. The rights of the third party had been so adjudicated in Palmer v. Harris, 60 Pa. St. 156.

71—Low v. Hart, 90 N. Y. 457; Twentsche Stoom Bleekery Goor v. Ellinger, 26 W. R. 70; Tonge v. Ward, 21 L. T. N. S. 480; Atkinson v. Atkinson, 85 L. T. Jour. 229. But see Leahy v. Glover, 10 R. P. C. 141, where a single sale by defendant's clerk was held insufficient to warrant injunction.

72—American Fibre Chamois Co. v. De Lee, 67 Fed. Rep. 329.

73—Coats v. Holbrook, 2 Sandf. Ch. 586; Cox, 20; Sawyer v. Kellogg, 9 Fed. Rep. 601-602; Upmann v. Forester, L. R. 24 Ch. D. 231-235; Cartmell, 331; Upmann v. Elkan, L. R. 12 Eq. 140; L. R. 7 Ch. App. 130; Burgess v. Hately, 26 Beav. 249; Seb. 169; Field v. Lewis, Seton (4th ed.), 237; Seb. 280; *In re* Kuhn, 53 L. J. Ch. 238; Barrett v. Goom, 74 L. T. Jour. 388; Fennessy v. Day, 55 L. T. N. S. 161; Siegert v. Lawrence, 11 Vic. L. R. 47. See, *contra*, Wallis v. Wallis,

16. Showing that a proper name alleged to be an infringement is the name of a person connected with defendant's business, when in fact such person has only given defendant permission to use his name as a means of attracting trade from the complainant, in pursuance of defendant's scheme to fraudulently take away complainant's business.[74]
17. Showing that plaintiff has added words, figures or designs, such as a coat-of-arms, to the trademark as registered.[75]
18. Showing that the complainant's trademark or package is only partially copied or imitated in defendant's mark or package.[76]

As by the use of but one of several words composing the plaintiff's mark.[77]

"The reports are full of cases where bills have been sustained for the infringement of one of several words of a trademark."[78]

19. Showing that complainant has been guilty of misrepresentation in connection with his use of the trade mark,

4 Dr. 458; Twentsche Stoom Bleekery Goor v. Ellinger, 26 W. R. 70; Chappell v. Davidson, 2 K. & J. 123; Williams v. Osborne, 13 L. T. N. S. 498; Gorham Mfg. Co. v. Emery-Bird-Thayer Dry Goods Co., 92 Fed. Rep. 774-778.

74—Sawyer v. Kellogg, 7 Fed. Rep. 720; Price & Stenart, 493; 9 Fed. Rep. 601; Rogers Mfg. Co. v. Rogers Mfg. Co., 11 Fed. Rep. 495; Williams v. Brooks, 50 Conn. 278; Meriden Britannia Co. v. Parker, 39 Conn. 450; 12 Am. Rep. 401; Garrett v. T. H. Garrett & Co., 24 C. C. A. 173; 78 Fed. Rep. 472; Phalon v. Wright, 5 Phila. 464; Cox, 307; Wolfe v. Barnett, 24 La. Ann. 97; 13 Am. Rep. 111; Melachrino v. Melachrino Cigarette Co., 4 R. P. C. 215; Cartmell, 223; Perks v. Hall, W. N. 1881, p. 111; Williams v. Johnson, 2 Bos. 1.

75—Melachrino v. Melachrino Cigarette Co., 4 R. P. C. 215; Cartmell, 223; Newman v. Pinto, 4 R. P. C. 508; 57 L. T. N. S. 31; Cartmell, 242; Carroll v. Ertheiler, 1 Fed. Rep. 688-691.

76—McCann v. Anthony, 21 Mo. App. 83; Enoch Morgan's Sons Co. v. Elder, Cox, Manual, 714; Taendsticksfabriks Aktiebolaget Vulcan v. Myers, 139 N. Y. 364; Pillsbury v. Pillsbury-Washburn Mills Co., 12 C. C. A. 432; 64 Fed. Rep. 841; Centaur Co. v. Killenberger, 87 Fed. Rep. 725.

77—Saxlehner v. Eisner & Mendelson Co. (3), 179 U. S. 19-33; 45 L. Ed. 60.

78—Mr. Justice Brown in Saxlehner v. Eisner & Mendelson Co., 179 U. S. 19, 33; 45 L. Ed. 60; citing Shrimpton v. Laight, 18 Beav. 164; Clement v. Maddick, 1 Giff. 98; Hostetter v. Vowinkle, 1 Dill. 329; Fed. Cas. No. 6,714; Morse v. Worrell, 10 Phila. 168; 9 Am. L. Rev. 368; Grillon v. Guenin, Weekly Notes (1877), 14; American Grocer Pub.

where that misrepresentation consists only in harmless exaggeration of the merits of his product (puffing);[79] or in purely collateral representation, as by newspaper advertising;[80] or in regard to the size of packages used by him, where the sizes of those packages are the ordinary sizes known to the trade, the capacity of which is generally understood.[81]

"Mere extravagance in advertising is not such fraud as deprives a complainant of all remedy."[82]

Generally, as to the defense that the complainant has been guilty of misrepresentation, Judge Sanborn has said "the principle 'that he who comes into equity must do so with clean hands' is familiar and indisputable. But it does not repel all sinners from courts of equity, nor does it disqualify any complainant from obtaining relief there who has not dealt unjustly in the very transaction concerning which he complains. The iniquity which will repel him must have an immediate and necessary relation to the equity for which he sues."[83] Thus, the use of the word "copyright" in connection with a tradename when no copyright actually exists, has been held not to disentitle the owner from relief in equity,[84] and so of statements of opinion concerning the curative properties of a medicinal compound to which the trademark is applied.[85] But the statement on the label of a small-pox remedy, "cures the worst cases without marking," is sufficient to disentitle the complainant from relief.[86]

Asso. v. Grocer Pub. Co., 25 Hun, 398.

79—Comstock v. White, 18 How. Pr. 421; Cox, 232; Metzler v. Wood, L. R. 8 Ch. D. 606; Seb. 587; Holloway v. Holloway, 13 Beav. 209; Seb. 106; Ellis v. Zeilen, 42 Ga. 91; Johnson & Johnson v. Seabury & Johnson, 71 N. J. Eq. 750; 67 Atl. Rep. 36.

80—Curtis v. Bryan, 36 How. Pr. 33; 2 Daly, 212; Cox, 434; Seb. 291.

81—Hennessy v. Wheeler, 51 How. Pr. 457; 69 N. Y. 271; 15 Alb. L. J. 454; Seb. 483.

82—Ray, J., in E. & J. Burke v. Bishop, 175 Fed. Rep. 167, 175.

83—Shaver v. Heller & Merz Co., 48 C. C. A. 48; 108 Fed. Rep. 821, 834. Citing Dering v. Earl of Winchelsea, 1 Cox, Ch. 318, 319; Lewis and Nelson's Appeal, 67 Pa. 153, 166; Bateman v. Fargason, 4 Fed. Rep. 32, 33. To the same effect see Frazier v. Dowling, 18 Ky. L. Rep. 1109; 39 S. W. Rep. 45.

84—Wormser v. Shayne, 11 Ill. App. 556.

85—Newbro v. Undeland, 69 Neb. 821; 96 N. W. Rep. 635.

86—Houchens v. Houchens, 95 Md. 37; 51 Atl. Rep. 822.

In a late case Judge Brown has said "the defense of unclean hands, to avail, must be based upon conditions existing at the time when the party applies for equitable relief;" and held that a discontinuance of the misrepresentations formerly contained in a label was an answer to the defense of unclean hands.[87] A false copyright imprint in an almanac has been held not to disentitle its publisher from relief in equity,[88] as has also been held of the representation "made by us," though not true in fact.[89]

So where complainant had been a manufacturer under an expired patent, and was the owner of a subsisting patent, it was guilty of "unclean hands" in marking the date of the later patent upon devices made under the expired patent, and that such marking was done under the advice of counsel was immaterial.[90]

For a creamery butter company to permit a customer to use its wrappers on a spurious butter is fraud disentitling it to relief in equity.[91] The misrepresentation may be in the name claimed as trademark itself.[92]

Unclean hands.—The general equity doctrine as to unclean hands is thus stated in the leading case: "When the owner of a trademark applies for an injunction to restrain the defendant from injuring his property by making false representations to the public, it is essential that the plaintiff should not, in his trademark or in his advertisements and business, be himself guilty of any false or misleading representation, and if he makes any material false statement in connection with the property which he seeks to protect, he loses his right to claim the assistance of a court of equity."[93] But where the mis-

87—Moxie Nerve Food Co. v. Modox Co. (2), 153 Fed. Rep. 487, 489. To the same effect see Johnson & Johnson v. Seabury & Johnson, 61 Atl. Rep. 5; 69 N. J. Eq. 696; s. c., 67 Atl. Rep. 36; 71 N. J. Eq. 750; Beecham v. Jacobs, 159 Fed. Rep. 129; 86 C. C. A. 623.

88—Gruber Almanack Co. v. Swingley, 103 Md. 362; 63 Atl. Rep. 884.

89—Regent Shoe Mfg. Co. v. Hooker, 75 Nebr. 426; 106 N. W. Rep. 595.

90—Greene, Tweed & Co. v. Manufacturers' Belt Hook Co., 158 Fed. Rep. 640.

91—Castroville Co-operative Creamery Co. v. Col, 6 Cal. App. 533; 92 Pac. Rep. 648.

92—New York & New Jersey Lubricant Co. v. Young, 77 N. J. Eq. 321; 77 Atl. 314.

93—Mr. Justice Shiras in Worden

representation is not a part of the mark itself, but is contained solely in the plaintiff's advertising, although that matter be adjudged so untrue or misleading as to require the bill to be dismissed, the better practice now obtaining is to give the plaintiff a *locus penitentiae* by making the decree of dismissal without prejudice to the plaintiff's right to file a new bill when he can show that he has abandoned the untruthful advertising.[93a]

Misrepresentations of producer's identity or locality as "unclean hands."—As we have seen elsewhere (*ante*, § 39), what is or is not such a misrepresentation as will disentitle the party making it from relief in equity is sometimes difficult of decision. One who continues to represent the dead founder of his business as living is under the ban of the rule,[94] as is one who uses the expression "manufactured in Ireland, by H. M. Royal Letters Patent" concerning his club soda made by unpatented machinery.[95] The expression "the old and original firm," used by one who bought the business of the bankrupt concern from its liquidator, led Farwell, J., to say: "That appears to me to be a material misrepresentation * * * sufficient to disentitle (plaintiff) to any injunction."[96]

Use of the word "trademark" as a misrepresentation disentitling the user from relief in equity.—That a mark used upon an unpatented article and accompanied by the words "patent" or "patented" is thereby deprived of trademark quality was determined by the United States Supreme Court in a case in which it laid down the general doctrine; "a symbol or label claimed as a trademark, so constituted or worded as to make or contain a distinct assertion which is false, will not be recognized, nor can any right to its exclusive use be maintained."[97]

v. California Fig Syrup Co., 187 U. S. 516; 47 L. Ed. 282; followed in Channell Chem. Co. v. E. W. Hayden Co., 222 Fed. Rep. 162.

93*a*—W. A. Gaines & Co. v. Turner-Looker Co., 123 C. C. A. 79; 204 Fed. Rep. 533; Diamond Crystal Salt Co. v. Worcester Salt Co., 137 C. C. A. 16, 17; 221 Fed. Rep. 66, 67.

94—Siegert v. Abbott, 61 Md. 276; Hazlett v. Pollack Stogie Co., 115 C. C. A. 30; 195 Fed. Rep. 28.

95—Cochrane v. MacNish & Son, 13 R. P. C. 100.

96—Cropper Minerva Machines Co. (Ltd.) v. Cropper, Charlton & Co., 23 R. P. C. 388, 394.

97—Holzapfel's Co. v. Rahtjen's Co., 183 U. S. 1; 46 L. Ed. 49; 22 Sup. Ct. 6.

Where a trademark as registered consisted of a design without wording, and in use the word "Notaseme" was placed thereon—"Notaseme" having been refused registration by the Patent Office on account of its alleged descriptive character—and the words "Trade-Mark" imprinted upon the design, with the statutory imprint "Reg. U. S. Pat. Off." underneath the design, Judge Hazel dismissed a bill for infringement and unfair competition, saying "to merely display the word "Notaseme" on the face of the design would not disentitle the complainant to relief, but the addition of the words "Trade-Mark," printed on the flourished ending of the script, was, I think, a material misrepresentation."[98]

20. Showing that the infringement has ceased.[99]
21. Showing that the complainant has made a third party his licensee for the territory in which the infringement was committed.[1]
22. Showing that the defendant has made no sales of goods bearing the infringing mark, where it appears that he would have done so had the suit not been instituted.[2]

"Proof of injury is unnecessary if the evidence establish the fact that injury will result unless such use (of the infring-

98—Notaseme Hosiery Co. v. Straus, 231 Fed. Rep. 243, 245; affirmed in Straus v. Notaseme Hosiery Co., 240 U. S. 179; 60 L. Ed. —; 36 Sup. Ct. 288. For the intermediate proceedings see 201 Fed. Rep. 99; 119 C. C. A. 134; 209 Fed. Rep. 495; 215 Fed. Rep. 361; 131 C. C. A. 503.

99—Frese v. Bachof, Fed. Case No. 5110; 13 Blatchf. 234; Burnett v. Hahn, 88 Fed. Rep. 694; Hutchinson v. Blumberg, 51 Fed. Rep. 829-831; Clark Thread Co. v. Wm. Clark Co. (1), 55 N. J. Eq. 658; 37 Atl. Rep. 599. *Contra*, see Brennan v. Emery-Bird-Thayer Dry Goods Co., 99 Fed. Rep. 971, which can not be regarded as of authority. For a very proper exception to the rule, under peculiar facts, see Van Raalt v. Schneck, 159 Fed. Rep. 248. Thomas G. Plant Co. v. May Merc. Co., 153 Fed. Rep. 229.

Discontinuance by the defendant, two years before the bill was filed, of the simulated markings, was held in the eighth circuit to be ground for refusing injunction, in a case not involving a technical trademark. Ferguson-McKinney Dry Goods Co. v. J. A. Scriven Co., 165 Fed. Rep. 655; 91 C. C. A. 491. To the same effect, G. W. J. Murphy Co. v. Metal Stamping Co., 214 Fed. Rep. 382.

1—Moxie Nerve Food Co. v. Baumbach, 32 Fed. Rep. 205.

2—Cuervo v. Landauer, 63 Fed. Rep. 1003; McLean v. Fleming 96 U. S. 252; 24 L. Ed. 828.

ing mark) will be restrained."[3] "The infringement of a trademark implies injury."[4]

23. Showing that the defendant is merely a dealer who has purchased from the originator of the infringement,[5] or merely the agent of another in the sale of the infringing goods.[6]

Although a dealer may escape injunction where it would be granted against the manufacturer, in exceptional cases.[7]

24. Showing that the defendant once held a license from the plaintiff, permitting the use of the mark, when that license has been revoked for failure to pay royalties and other breaches of the licensing contract.[8]

25. Showing that there has been an adjudication against the plaintiff in a court of a foreign country. The subject-matter, in cases of the classes treated in this work, is a tort. Such subjects are not concluded by foreign adjudications, even when the acts referred to are the same identical acts.[9]

26. Showing that the defendant was insane at the time of the commission of the infringing acts.[10]

27. Showing the defendant's innocence of guilty knowledge or fraudulent intent.[11]

28. Showing that defendant has used plaintiff's mark only in connection with matter explanatory of its use (as where the plaintiff marked his goods "Akron Dental

3—Maddox, J., in Brown v. Braunstein, 83 N. Y. Supp. 1096.

4—Thomas, J., in Lanahan v. John Kissel & Son., 135 Fed. Rep. 899

5—Burnett v. Hahn 88 Fed. Rep. 694.

6—Walter Baker & Co. v. Sanders, 80 Fed. Rep. 889; 26 C. C. A. 220.

7—Billiken Co. v. Baker & Bennet Co., 174 Fed. Rep. 829.

8—Martha Washington Creamery Buttered Flour Co. v. Martien, 44 Fed. Rep. 473.

9—Hohner v. Gratz, 50 Fed. Rep. 369; City of Carlsbad v. Kutnow, 68 Fed. Rep. 794.

10—Avery v. Wilson, 20 Fed. Rep. 856.

11—Saxlehner v. Siegel-Cooper Co., 179 U. S. 42; 45 L. Ed. 77; Colman v. Crump, 70 N. Y. 573; Taendsticks-fabriks Aktiebolaget Vulcan v. Myers, 139 N. Y. 364; 34 N. E. Rep. 904; Regis v. J. A. Jaynes & Co., 185 Mass. 458; 70 N. E. Rep. 480; affirmed, 191 Mass. 245; 77 N. E. Rep. 774; Day v. Webster, 49 N. Y. Supp. 314; 23 App. Div. 601; E. P. Dutton & Co. v. Cupples, 102 N. Y. Supp. 309; Eagle White Lead Co. v. Pflugh, 180 Fed. Rep. 579, 583.

Rubber" and defendant marked his as "Non-Secret Dental Vulcanite, made according to our analysis of the Akron Dental Rubber," the words "Akron Dental Rubber" being printed in red, from large type), where the added matter is a mere evasive attempt to hide the similarity.[12]

29. Showing that the plaintiff is a party to a combination in restraint of trade.[13] "It does not tend to foster monopoly to sustain the right, if one has acquired it, to the exclusive use of a trademark."[14]
30. Showing that the plaintiff is a foreign corporation which has failed to comply with the foreign corporation law of the state in which the infringement occurred.[15]
31. Showing that defendant did the alleged infringing acts under the advice of counsel. This would appear self-evident. Such a defense was disposed of by the Massachusetts Supreme Judicial Court as ineffective where it appeared that all the material facts had not been disclosed to counsel.[16]
32. Showing, in the case of a mark composed of single letters, that the peculiar arrangement of the complainant is not followed by the defendant. Thus [MF] has been held to be infringed by M. F. H.[17]
33. Showing that the mark is used upon a medicine which is harmful, where it appears that it is injurious only if taken in excessive quantities.[18]
34. Showing that there has been no actual conflict of trade and so no present injury, if there is a threat or certainty of future injury.[19]

12—Keller v. B. F. Goodrich Co., 117 Ind. 556; 19 N. E. Rep. 196.

13—General Electric Co. v. Renew Lamp Co., 128 Fed. Rep. 154, 156; R. J. Reynolds Tobacco Co. v. Allen Bros. Tobacco Co., 151 Fed. Rep. 819.

14—Gray, J., in Independent Baking Powder Co. v. Boorman, 130 Fed. Rep. 726; Northwestern Consl. Mill Co. v. Wm. Callan & Son, 177 Fed. Rep. 786; Fontipia Limited v. Bradley, 171 Fed. Rep. 951, 959.

15—Consolidated Ice Co. v. Hygeia Distilled Water Co., 80 C. C. A. 506; 151 Fed. Rep. 10.

16—Nelson v. J. H. Winchell & Co., 203 Mass. 75; 89 N. E. Rep. 180, 187.

17—American Tin Plate Co. v. Licking Roller Mill Co., 158 Fed. Rep. 690.

18—Theodore Rectanus Co. v. United Drug Co., 141 C. C. A. 301; 226 Fed. Rep. 545, 548.

19—*Ibid*, at p. 549.

35. Showing that defendant's product is hand-made, where the plaintiff's is machine-made.[20]

§ 193. The relief in equity.—In regard to making an application for a preliminary injunction in cases of unfair trade or trademark infringement, it should be remembered that wherever there is any doubt as to the plaintiff's right or the defendant's infringement, the application *pendente lite* will be denied.[21] Accordingly, the courts have refused to grant the preliminary injunction where it appeared probable that the plaintiff had never acquired the exclusive right to use the mark,[22] but held it as a tenant in common with another;[23] where there existed a doubt whether the words claimed as trademarks by the plaintiff ("Pile Leclancha" and "Disque," applied to electric batteries) were or were not merely descriptive words;[24] where the facts indicated that the com-

20—German-American Button Co. v. Heymsfeld, Inc., 156 N. Y. S. 223.

21—"An interlocutory injunction operates somewhat in the nature of judgment and execution before trial. Without question it is at times an appropriate remedy in the prevention of great wrong, but to authorize its issuance there must exist a pressing necessity. The right to it must be clear, and the apprehended injury must be grievous, and generally, where the injury may be measured in money, the alleged wrong-doer should be shown to be unable pecuniarily to respond." Jenkins, J., in American Cereal Co. v. Eli Pettijohn Cereal Co. (2), 22 C. C. A. 236; 76 Fed. Rep. 372-374. To the same effect, see Smith-Dixon Co. v. Stevens, 100 Md. 110; 59 Atl. Rep. 401; E. T. Fairbanks & Co. v. Des Moines Scale & Mfg. Co., 96 Fed. Rep. 972.

In refusing to grant a preliminary injunction Mr. Justice Bradley, on circuit, said: "My great reluctance to grant a preliminary injunction for suppressing the use of a business name or trademark, in any case in which the matter in issue is a subject for fair discussion, induces me to withhold the order." Celluloid Mfg. Co. v. Cellonite Mfg. Co., 32 Fed. Rep. 94-102. And to the same effect see Van Camp Packing Co. v. Cruikshanks Bros. Co., 90 Fed. Rep. 814; 33 C. C. A. 280; Charles E. Hires Co. v. Consumers' Co., 41 C. C. A. 71; 100 Fed. Rep. 809, 813; Goldstein v. Whelan, 62 Fed. Rep. 124.

22—Societe des Huiles D'Olive de Nice v. Rorke, 31 N. Y. Supp. 51.

23—American Cereal Co. v. Eli Pettijohn Cereal Co., 76 Fed. Rep. 372; 22 C. C. A. 236.

24—Laclancha Battery Co. v. Western Electric Co., 21 Fed. Rep. 538. Same of "air-cell" and "fire-board" applied to fire-proofing material. New York Asbestos Mfg. Co. v. Amber Asbestos Air-cell Covering Co., 99 Fed. Rep. 85, affirmed 43 C. C. A. 46; 102 Fed. Rep. 890.

plainant was possibly guilty of laches;[25] and where the defendant's affidavits created a doubt in the mind of the court as to whether the plaintiff had been the exclusive user of the symbols claimed by him as his trademark.[26] A preliminary injunction will not be awarded on *ex parte* affidavits unless in a clear case,[27] particularly where the defendant is financially able to respond for damages,[28] or where there is a probability that the complainant has been guilty of misrepresentations which would disentitle him to relief in equity.[29] A mandatory injunction pending the suit is not granted except in extreme cases where the right thereto is clearly established and it appears that irreparable injury will follow from its refusal.[30]

So when the court has reason to doubt that the defendant has been guilty of acts amounting to an invasion of the plaintiff's trade rights, a preliminary injunction will not be issued.[31] But while refusing the interlocutory injunction, the court may, in its discretion, require the defendant to keep an account, pending the suit, of all his dealings in goods bearing the alleged infringing mark; as Judge Treat said in making such an order: "It will not hurt him to keep an account."[32]

On a motion for preliminary injunction it is no defense to show misrepresentation on the part of the plaintiff; in asserting this rule, it has been said that "the refusal by a court

25—Estes v. Worthington, 22 Fed. Rep. 822.

26—French v. Alter & Julian Co,. 74 Fed. Rep. 788; Leclancha Battery Co. v. Western Electric Co., 21 Fed. Rep. 538; Portuondo v. Monne, 28 Fed. Rep. 16; Davis v. Davis, 27 Fed. Rep. 490.

27—New York Asbestos Mfg. Co., v. Amber Asbestos Air-cell Covering Co., 99 Fed. Rep. 85; Lare v. Harper & Bros., 86 Fed. Rep. 481; 30 C. C. A. 373; Anargyros & Co. v. Anargyros, 167 Fed. Rep. 753, 769; 93 C. C. A. 241.

28—H. Mueller Mfg. Co. v. A. Y. McDonaly & Morrison Mfg. Co., 132 Fed. Rep. 585, 588; Baglin v. Cusenier Co., 72 C. C. A. 555; 141 Fed. Rep. 497; reversing s. c., 156 Fed. Rep. 1015.

29—National Starch Co. v. Koster, 146 Fed. Rep. 259.

30—Hagen v. Beth, 118 Cal. 330.

31—Goodyear Rubber Co. v. Day, 22 Fed. Rep. 44; Whiting Mfg. Co. v. Jos. H. Bauhud Co., 56 N. Y. Supp. 114.

32—Goodyear Rubber Co. v. Day, 22 Fed. Rep. 44. For a similar order, see Cantrell & Cochrane, Ltd. v. Wittemann, 109 Fed. Rep. 82.

of equity of relief to those who come with unclean hands is not for the benefit of those whose hands are also unclean."[33]

A preliminary injunction will not be granted as between alleged conflicting labels where it is not clear that "anybody would mistake one for the other."[34] So the injunction will be denied where the mark is used as the name of a newspaper supplement by the plaintiff, and the name of a magazine by the defendant,[35] or where the defendant shows uses in the trade by third parties of a substantially similar mark, prior to plaintiff's alleged date of first use.[36]

It is sufficient to sustain the application for the preliminary injunction (so far as the plaintiff's title to the mark is concerned) if he has established his right to the trademark in a former proceeding.[37] While the decision in such former proceeding is not conclusive and binding upon the court in the later case, it is persuasive and of great weight, and on the motion for a preliminary injunction, especially where it sustains the impression of the court upon the hearing, is decisive.[38] Where a demurrer is interposed to the bill, upon the application for preliminary injunction, the allegations of fraud in the bill are confessed thereby; and if the demurrer is overruled the complainant is entitled to the preliminary injunction.[39]

Upon granting a preliminary injunction bond may be required of the complainant.

Where such a bond was given, conditioned for "the payment of all damages and costs to be awarded against the complainant and in favor of the defendant upon the trial or final hearing," a demurrer was sustained to a declaration setting forth the obligee's claim to damage, because no dam-

33—Moxie Nerve Food Co. v. Holland, 141 Fed. Rep. 202, 205. To the contrary see Greene, Tweed & Co. v. Manufacturers' Belt Hook Co., 158 Fed. Rep. 640.

34—Philadelphia Nov. Co. v. Blakesley Nov. Co., 37 Fed. Rep. 365.

35—Star Co. v. Colver Pub. House, 141 Fed. Rep. 129.

36—Benjamin Moore & Co. v. Auwell, 158 Fed. Rep. 462; affirmed 178 Fed. Rep. 543; 102 C. C. A. 53.

37—Symonds v. Greene, 28 Fed. Rep. 834, 835; Moxie Nerve Food Co. v. Beach, 33 Fed. Rep. 248; Carmel Wine Co. v. Palestine Hebrew Wine Co., 161 Fed. Rep. 654.

38—Price Baking Powder Co. v. Fyfe, 45 Fed. Rep. 799.

39—Enoch Morgan's Sons Co. v. Hunkele, 16 Off. Gaz. 1092, 1093.

ages were awarded on the final hearing.[40] The supreme court has commended, as a proper condition of such bonds, one which ran "to answer all damages which the defendant in that suit might sustain in consequence of said injunction being granted, should the same be thereafter dissolved."[41]

A preliminary injunction may be enlarged in its scope by a further preliminary injunction to cover a changed form of label adopted by the defendant.[42]

It is a general rule in the law of unfair trade, as well as in patent law, that where the infringement is admitted or proven the plaintiff is entitled to a reference for an accounting as a matter of right.[43] But "cases frequently arise where a court of equity will refuse the prayer of the complainant for an account of gains and profits, on the ground of delay in asserting his rights, even when the facts proved render it proper to grant an injunction to prevent future infringement."[44]

An accounting will also be refused "when it is manifest that the cost to the plaintiff of a hearing would be much more than the damages which he seeks to recover. An order of reference, under such conditions, would be inequitable."[45]

40—Cuervo v. Owl Cigar Co., 68 Fed. Rep. 541.

41—Beakin v. Stanton, 3 Fed. Rep. 435. In his opinion Judge Blodgett calls attention to the wide conflict of authority in the decisions of the courts of the several states upon this subject, and cites Bein v. Heath, 12 How. 168, as controlling his decision.

42—Bein v. Heath, 12 Howard, 168-177; 13 L. Ed. 939.

43—Oakes v. Tonsmierre, 49 Fed. Rep. 447-453; Campbell Printing Press Co. v. Manhattan R. Co., 49 Fed. Rep. 930-932; Fisk v. Mahler, 54 Fed. Rep. 528; Standard Cigar Co. v. Goldsmith, 58 Pa. Super. Ct. 33.

44—Mr. Justice Clifford in McLean v. Fleming, 96 U. S. 245-257, 24 L. Ed. 828. To the same effect see Low v. Fels, 35 Fed. Rep. 361-363.

45—Knowlton, J., in Giragosian v. Chutjian, 194 Mass. 504; 80 N. E. Rep. 647. To the same effect, see American Box Co. v. Crosman, 57 Fed. Rep. 1021, 1029; Bradford v. Belknap Co., 105 Fed. Rep. 63, 66; Ludington Novelty Co. v. Leonard, 127 Fed. Rep. 155, 157; 62 C. C. A. 269; Julious Kessler & Co. v. Goldstrom, 177 Fed. Rep. 392, 394; 101 C. C. A. 476; Keystone Type Foundry Co. v. Portland Pub. Co., 180 Fed. Rep. 301; National Distilling Co. v. Century Liquor Co., 105 C. C. A. 638; 183 Fed. Rep. 206; DeVoe Snuff Co. v. Wolff, 124 C. C. A. 302; 206 Fed. Rep. 420, 424.

It will always be refused where it appears the profits realized by the defendant were insignificant.[46]

In a case of unfair competition, though the facts justify injunction, there can be no money judgment for damages unless the defendant has been found guilty of fraudulent intent.[47]

"In England the rule is stringent in trademark cases that lack of diligence in suing deprives the complainant in equity of the right either to an injunction or an account. Our courts are more liberal in this respect. A long lapse of time will not deprive the owner of a trademark of an injunction against an infringer, but a reasonable diligence is required of a complainant in asserting his rights, if he would hold a wrongdoer to an account for profits and damages. This rule, however, applies only to those cases where there has been an acquiescence after a knowledge is brought home to the complainant."[48]

It is now the rule in England, as we have seen in our discussion of the question of damages at law, that upon the injunction being entered in the action in equity the complainant is compelled to elect between profits and damages; he can not have both. If he elects to take his damages, the issue is sent to the King's Bench Division to be tried by a jury.[49] In our federal courts, however, there is no provision for transferring the case from the equity side to the law side after the entry of an interlocutory decree, nor any other provision for submitting the issue of damages, in an equity case, to a jury. The plaintiff is not compelled to elect between profits and damages, but the reference is made to the master in chancery to take an account of the defendant's profits and to make an assessment of the damages sustained by the plaintiff.[50] In

46—Regis v. Jaynes, 191 Mass. 245; 77 N. E. Rep. 774; S. Howes Co. v. Howes Grain Cleaner Co., 24 Misc. Rep. 83; 52 N. Y. Supp. 468.

47—N. K. Fairbank Co v. Windsor, 61 C. C. A. 233; 124 Fed. Rep. 200, 202.

48—Nixon, J., in Sawyer v. Kellogg, 9 Fed. Rep. 601.

49—Fennessy v. Rabbits, 56 L. T. 138; Cartmell, 125.

50—The Collins Co. v. Oliver Ames & Sons Corporation, 18 Fed. Rep. 561-571; Benkert v. Feder, 34 Fed. Rep. 534, 535; Sawyer v. Kellogg, 9 Fed. Rep. 601, 602; Sawyer v. Horn, 1 Fed. Rep. 24-39. To the same effect see Clark Thread Co. v. William Clark Co. (2), 56 N. J. Eq. 739; 40 Atl. Rep. 686.

assessing damages the master will consider the extent to which plaintiff's sales have fallen off, if the defendant's acts are the cause of such falling off.[51]

It was held in one case that the profits due to the use of the trademark only were the subject of inquiry.[52] But this was clear error, and the court laying down this rule cited in support of it only one precedent and that a patent case.[53] This question was considered very carefully by the Supreme Court of California, and its conclusion is as follows: "Every consideration of reason, justice and sound policy demands that one who fraudulently uses the trademark of another should not be allowed to shield himself from liability for the profit he has made by the use of the trademark, on the plea that it is impossible to determine how much of the profit is due to the trademark, and how much to the intrinsic value of the commodity." The supreme court held, therefore, that the trial court had not erred in awarding the plaintiff the whole profit made by the defendant.[54] In treating the same subject, Judge Sawyer said: "To adopt as the measure of compensation for such injuries the difference between the price for which the spurious goods would sell without the trademark and for which they would sell with it imprinted thereon, would be a mockery of justice. In my judgment the infringer should at least account for the entire profits made upon the goods wrongfully sold with the trademark impressed upon them."[55] This now appears to be the accepted rule.[56]

"The same rule is applied to cases of unfair competition merely, as well as to cases of the infringement of a trademark properly so called."[57]

51—Hostetter v. Vowinkle, Fed. Case No. 6714; 1 Dill. 329; Cox, Manual, No. 207.

52—Atlantic Milling Co. v. Rowland, 27 Fed. Rep. 24.

53—Garretson v. Clark, 111 U. S. 120; 28 L. Ed. 371.

54—Graham v. Plate, 40 Cal. 593-599. Approved in Hamilton-Brown Shoe Co. v. Wolf Bros. & Co., 240 U. S. 251; 60 L. Ed. —.

55—Benkert v. Feder, 34 Fed. Rep. 534.

56—Saxlehner v. Eisner & Mendelson Co. (4), 138 Fed. Rep. 22; 70 C. C. A. 452; Reading Stove Works v. S. M. Howes Co., 201 Mass. 437; 87 N. E. Rep. 751; Regis v. Jaynes & Co., 191 Mass. 245, 249, 250; 77 N. E. Rep. 774.

57—Sheldon, J., in Regis v. Jaynes, 191 Mass. 245; 77 N. E.

Upon accounting, it is not incumbent on the complainant to prove the exact "proportion of the infringer's gains attributable to his infringement;" but the whole profit is recoverable.[58]

The defendant can not show before the master that the complainant should not recover profits because of his abandonment of the mark; the interlocutory decree is conclusive as to that,[59] and even if complainant has abandoned the mark and defendant is not at liberty to palm off his goods as those of the complainant.[60]

Counsel fees expended by plaintiff in the cause are not an element of damage, and can not be considered in assessing damages in equity.[61]

The court will refuse to decree an accounting where it is manifestly impossible to segregate the profits arising from the infringement.[62]

In jurisdictions where the master is permitted to assess damages, he may do so even in the absence of any direct proof of loss of profit.[63] As all participants in torts are principals, one

Rep. 774. Citing N. K. Fairbank Co. v. Windsor, 118 Fed. Rep. 96 (overruled as to some points in 124 Fed. Rep. 200; 61 C. C. A. 233); Walter Baker Co. v. Slack, 130 Fed. Rep. 514; 65 C. C. A. 138; Williams v. Mitchell, 106 Fed. Rep. 168; 45 C. C. A. 265; Lewis v. Goodwin, 36 Ch. D. 1.

Compare the Kentucky rule: "In the action for fraudulent simulation of the plaintiff's goods there can be no accounting of profits in equity. The remedy is by the common law action for damages." Hobson, J., in E. H. Taylor & Sons Co. v. Taylor, 85 S. W. Rep. 1085; 27 Ky. L. Rep. 625.

58—Saxlehner v. Eisner & Mendelson Co. (4), 138 Fed. Rep. 22, 24; 70 C. C. A. 452.

59—DeLong Hook & Eye Co. v. Francis Hook & Eye & Fastener Co., 159 Fed. Rep. 292.

60—Saxlehner v. Eisner & Mendelson Co., 179 U. S. 19, 31; 45 L. Ed. 60; De Long Hook & Eye Co. v. Francis Hook & Eye Fastener Co., 159 Fed. Rep. 292.

61—Burnett v. Phalon (1), 21 How. Pr. 100; Cox' American Trademark Cases 292.

62—Ludington Novelty Co. v. Leonard, 62 C. C. A. 269, 127 Fed. Rep. 155.

63—Thus in a chancery case in New Zealand the court said: "First as to damages, I am of opinion that there has been no direct proof of loss of profit by Messrs. Littlejohn & Son, consequent upon the sale of the watches which improperly have their name inscribed upon them, but, as I have intimated during the course of the argument, it appears to me that, apart from any direct proof of loss of profit, there arises in cases of this class an inference of possible damage to the manufacturer whose name is improperly used—damage to his well-established

who participates in unfair trade by furnishing fraudulent labels is liable in equity to the party injured for the whole damage resulting from the unfair competition.[64]

Whether or not a technical trademark is involved, the successful complainant in an action for unfair competition is entitled to an account.[65] A bill for a naked account of profits can not be sustained;[66] the accounting will only be granted as an incident to the award of injunctive relief.[67]

In rare cases the court will decree the destruction of the goods bearing the infringing mark.[68]

The defense of laches can not be raised for the first time before the master,[69] and the same is true as to the defense that the plaintiff's goods were withdrawn from the market before the infringement commenced.[70]

§ 194. The decree in unfair competition cases as to the accounting.—It has been held that where the defendant's unfair competition was not willful or fraudulent, the accounting would be limited to the damages sustained by the plaintiff, and would not extend to the defendant's profits.[71] While the general rule has been stated to be that the defendant will be held to account for profits,[72] it is clearly for the court to determine

reputation. It is impossible that the quantum of damage in cases of this class can be mathematically ascertained; no account can possibly reach such a matter. It must always be a matter of discretion for the court and jury." Littlejohn v. Mulligan, 3 New Zealand Rep. 446.

64—Hildreth v. Sparks Mfg. Co., 99 Fed. Rep. 484.

65—Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 204; 41 L. Ed. 118; Worcester Brewing Corp. v. Reuter & Co., 84 C. C. A. 665; 157 Fed. Rep. 217.

66—Root v. L. S. & M. S. Ry. Co., 105 U. S. 189; 26 L. Ed. 975.

67—Van Raalt v. Schneck, 159 Fed. Rep. 248, 251.

68—Peerless Rubber Mfg. Co. v. Nichol, 187 Fed. Rep. 238.

69—DeLong Hook & Eye Co. v. Francis Hook & Eye & F. Co., 168 Fed. Rep. 898; 94 C. C. A. 310.

70—*Ibid.*

71—"I do not think (plaintiff) is entitled to an accounting for profits, because I can not find that the unfair competition was so 'willful and fraudulent' as to justify the imposition of profits as a 'punitive addition to the ordinary decree of compensatory damages.'" Haight, J., in Rubber & Celluloid H. T. Co. v. F. W. Devoe & C. T. Reynolds Co., 233 Fed. Rep. 150, 160.

72—"The general rule undoubtedly is that, on such a reference in a case of unfair competition, it is the

whether the account shall include damages only, profits only, or both. A decree reading as follows:

> "That the complainant recover of the defendant damages sustained by said complainant from the unlawful acts of the defendant herein adjudged, in its use of said two labels recited in paragraphs 2 and 3 hereof, in the packaging and sale of Neufchatel cheese, together with its costs of suit in this behalf expended, with leave to complainant to apply hereafter for a reference to a master to ascertain and assess said damages, should it be so advised,"

does not authorize an accounting as to profits.[73]

duty of the master to fairly take an account of profits realized by the defendant upon all articles or goods manufactured or sold by him under the conditions of unfair competition, as established by the decree of the court." Rowley v. Rowley, 113 C. C. A. 386; 193 Fed. Rep. 390 (C. C. A. 3).

73—P. E. Sharpless Co. v. Lawrence, 130 C. C. A. 59; 213 Fed. Rep. 423. "In theory, a technical trademark, like a patent right, is a species of property, and when it is invaded or appropriated, the owner thereof is entitled, not only to protection from further trespass, but, to the recovery of the profits issuing therefrom, as incident to and a part of his property right. In suits for unfair competition, on the other hand, the complaint is not of an appropriation of a property right, but of a tort committed by the defendant, in that his conduct has been unlawful by reason of the consequential injury to the plaintiff. In such a case, it is contended the recovery should be for damages actually suffered by the plaintiff, and for those only, the wrong complained of being somewhat analogous to that which would be the basis of an action on the case at common law.

"It is true, however, as contended by the plaintiffs below, that courts of equity, in granting injunctive relief in cases of unfair competition, have sometimes decreed that the plaintiffs should recover of defendant, not only damages, but the profits, gains and advantages that have accrued to the defendant by reason of his unfair competition. Such an enlargement of the scope of the decree is generally made on the ground that the unfair competition is adjudged to have been willful and fraudulent, and the recovery of profits in such cases is a punitive addition to the ordinary decree of compensatory damages. A number of cases have been cited in the brief of plaintiffs below, where, under these circumstances, an accounting of profits has been allowed in cases of unfair competition. We have examined all of them, and it is to be observed that in almost every case the recovery of such profits was included in the decree in addition to the recovery of damages, and in none of them was the precise question here presented discussed. The distinction between the

§ 195. Forbidding publication of the decree.—Everyone who has experience in the use of decrees by way of unfair competition is aware of the damage that may be inflicted thereby. A decree of injunction, however carefully drawn, is apt to convey to the public an entirely erroneous impression of its scope and effect, as well as of the facts which occasioned it. Where the defendant has not been guilty of intentional fraud, the plaintiff may be required to abstain from harmful use of the injunction as a condition to the injunction remaining in effect.[74]

§ 196. Restraining misrepresentations concerning the decree.—A defendant who circulates false statements regarding an interim order made in the cause may be restrained in the cause, on motion, from further circulation of the false statements, and the costs of the motion may be assessed against him.[75]

§ 197. Punitive damages in equity.—"The question of the true measure of damages in cases of this sort is an interesting one. The injured party is entitled to full compensation for the injury, but how shall that be measured? Manifestly, the profits which the infringer has made would not in all cases be compensation to the injured. The latter's loss in part inheres in the failure to acquire a just and deserved gain; also in the injury to the reputation of his product by reason of the substitution of the spurious article. The latter element is difficult, if not im-

recovery of damages and profits was thus recognized.

"What we conclude from the cases cited is, that courts of equity in cases of unfair competition may upon what seems to them sufficient grounds, include in their decrees an accounting of profits as well as an award of damages. We think, however, that the distinction between a decree for the recovery of damages and one for the recovery of profits, should not be lost sight of, and in general is not lost sight of, and that the latter is not included in the former." Gray, J., in P. E. Sharpless Co. v. Lawrence, *supra*, 213 Fed. Rep. at p. 426.

74—"I see no reason why the plaintiff should advertise its decree in any way. There is nothing unfair in the defendant's prior advertising to correct, and, when that is the case, neither side should be allowed to scare off customers by the flourish of a decree. The plaintiff will therefore refrain from any advertisement at the peril of losing its decree." Learned Hand, J., in Champion Spark Plug Co. v. A. R. Mosler & Co., 233 Fed. Rep. 112, 118.

75—Gillette Safety Razor, Ltd. v. Pellett, Ltd., 26 R. P. C. 588. English authority, but equally applicable here.

possible of accurate admeasurement. It can only be approximately compensated by an allowance in the nature of punitory damages, resting largely in discretion."[76] This happens to be merely a *dictum,* as the issue was not before the court. But it is the statement of a sound principle, though one difficult of practical application, and is flatly opposed to *Hennessy v. Wilmerding-Loewe Co.,*[77] which denies the right to recover punitive damages in equity in this class of cases.

§ 198. Increase of damages in equity.—Sec. 19 of the Act of 1905 provides that: "Upon a decree being rendered in any such case for wrongful use of a trademark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby. * * * The court shall have the same power to increase such damages, in its discretion, as is given by section sixteen of this act for increasing damages found by verdict in actions of law."

This provision was doubtless intended to enable the trial court, having regard to the questions of fraudulent intent and guilty knowledge of the defendant, to assess damages by way of punishment, in addition to those damages found by the master to have been actually sustained by the complainant.

§ 199. The defendant's credits upon accounting.—Sec. 19 of the Act of 1905 provides that "In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed."

These provisions are evidentiary, shifting the burden of proof upon the defendant, after the complainant has proven the extent of sales, to establish such credits or off-sets as he may be entitled to.

Where the defendant carried on the infringing traffic in connection with his regular business, it has been held, the master in chancery will not make any deduction for the general expenses

76—Jenkins, J., in Walter Baker & Co. v. Slack, 130 Fed. Rep. 514, 519; 65 C. C. A. 138.

77—103 Fed. Rep. 90.

in taking the account of profits;[78] other cases hold directly to the contrary.[79]

As to losses from bad debts, the rule appears to be to treat such sales "as if they had not been made at all—neither increasing the amount of profits by reason of such sales nor diminishing that amount on account of the loss caused thereby."[80]

§ 200. Label designing as a judicial function.—The willingness of courts of equity to aid in maintaining fairness in competition has been evidenced by a label designed by Judge Coxe and exhibited with his opinion in a case involving the word "Carlsbad" as applied to mineral water, with the statement that "in order that there may be no misunderstanding upon the settlement of the decree, the court has applied a copy of a label which, it is thought, the defendant may use with impunity as truthfully representing the water sold by him."[81]

In another case, Judge Lacombe, in offering alternative forms of decree for the choice of a defendant, said "the mandate will, if defendant prefers, direct a modification of the interlocutory decree solely by requiring the affixing upon every package sold, in type as prominent as the title, of the statement that 'W. H. Baker is distinct from and has no connection with the old chocolate manufactory of Walter Baker & Co.'"[82] The Court of Appeals of the Seventh Circuit has criticised this practice, Judge Jenkins observing that, "The court below, upon holding that the changed label of the defendant infringed the complainant's right, caused to be submitted for its approval another form of label, which it approved, and authorized the defendant to use upon bottles of the same form as those used by the complainant. We greatly doubt the propriety of such action. When

78—Societe Anonyme v. Western Distilling Co., 46 Fed. Rep. 921; Regis v. Jaynes & Co., 191 Mass. 245, 251, 252; 77 N. E. Rep. 774; Nelson v. J. H. Winchell & Co., 203 Mass. 75; 89 N. E. Rep. 180, 187.

79—Walter Baker & Co. v. Slack, 65 C. C. A. 138; 130 Fed. Rep. 514, 520; Saxlehner v. Eisner & Mendelson Co., 138 Fed. Rep. 22.

80—Sheldon, J., in Nelson v. J. H. Winchell & Co., 203 Mass. 75; 89 N. E. Rep. 180, 187; following Edelsten v. Edelsten, 10 L. T. N. S. 780.

81—City of Carlsbad v. Schultz, 78 Fed. Rep. 469, 472.

82—Walter Baker & Co. v. Sanders, 80 Fed. Rep. 889, 895; 26 C. C. A. 220.

an infringement has been found, it should be restrained. A court of equity does not sit as an arbiter to determine in advance upon other and changed labels which the infringer may adopt to avoid the condemnation of the court. Whether such changed forms do in fact infringe is matter of fact to be determined by the court in its usual course of procedure upon complaint lodged by the party damnified. The duty of the court below was to determine whether the labels complained of in the bill infringed the complainant's right. That duty was fully performed when the court had so determined. It is not called upon to decide whether a new label proposed for adoption would infringe. This is especially so here, where the infringement was deliberate and designed. In such case the court ought not to say how near the infringer may lawfully approximate the label of the complainant, but should cast the burden upon the guilty party of deciding for himself how near he may with safety drive to the edge of the precipice, and whether it be not better for him to keep as far from it as possible;" [83] and in a later case, quoting from the foregoing opinion, the same court, *per curiam,* remarks, "it will be time enough for the court to determine the question upon issues properly framed and the evidence taken thereunder." [84]

Where the complainant's counsel has stated that he saw no objection to a proposed new label submitted to him by defendant, the fact was held conclusive against an application for a preliminary injunction to restrain its use.[85]

In enjoining unfair competition by the use of geographical and descriptive words ("Spanish tile" and "cohesive tile" as applied to arches) the alternative was offered by Judge Hand by "adding as a suffix substantially the following: 'not made by Guastavino, the original maker of such arches'—or by abandoning the phrases altogether." [86]

Generally, decrees will be so drawn as to protect any substantial right of the complainant against unfair competition;

83—Charles E. Hires Co. v. Consumers' Co., 100 Fed. Rep. 809, 813; 41 C. C. A. 71.

84—Williams v. Mitchell, 45 C. C. A. 265; 106 Fed. Rep. 168, 172; to the same effect see Sterling Remedy Co. v. Spermine Medical Co., 50 C. C. A. 657; 112 Fed. Rep. 1000.

85—Weber Medical Tea Co. v. Weber, 102 Fed. Rep. 156.

86—R. Guastavino Co. v. Comerma, 184 Fed. Rep. 549.

with the result at times, of narrowing the injunction to a point near zero.[87]

§ 201. Appeals.—Sec. 17 of the Act of 1905 provides that, "The Circuit Courts of Appeals of the United States and the Court of Appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trademarks registered in accordance with the provisions of this act, arising under the present act, without regard to the amount in controversy."

Section 129 of the Judicial Code, following the Act of March 3, 1891 (26 Stat. 826, c. 517) establishing the circuit court of appeals as amended by the Act of February 18, 1895 (28 Stat. 666, c. 96), provides:

"Where upon a hearing in equity in a district court, or by a judge thereof in vacation, an injunction shall be granted, continued, refused, or dissolved by an interlocutory order or decree, or an application to dissolve an injunction shall be refused, or an interlocutory order or decree shall be made appointing a receiver, an appeal may be taken from such interlocutory order or decree granting, continuing, refusing, dissolving, or refusing to dissolve, an injunction, or appointing a receiver to the circuit court of appeals, notwithstanding an appeal in such case might, upon final decree under the statutes regulating the same, be taken directly to the supreme court; *Provided*, That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed unless otherwise ordered by that court, or the appellate court, or a judge thereof, during the pendency of such appeal; *Provided, however*, That the court below may, in its discretion, require as a condition of the appeal an additional bond."

A decree which adjudges unfair competition, awards an injunction, and directs that the defendant deliver up for destruction any of the imitative articles on hand, and also orders an account-

87—See Holeproof Hosiery Co. v. Wallach Bros., 172 Fed. Rep. 859; 97 C. C. A. 263; modifying the decree in Holeproof Hosiery Co. v. Wallach Bros., 167 Fed. Rep. 373. See also Holeproof Hosiery Co. v. Wallach Bros., 112 C. C. A. 655; 192 Fed. Rep. 534.

ing of profits and damages is an interlocutory decree and must be appealed from within thirty days, or the appeal will be dismissed upon motion.[88]

Under this section, an appeal from a decree made after final hearing on the merits, declaring infringement of a trademark, awarding a perpetual injunction and referring the cause to a master for an accounting, is not an appealable final decree but is interlocutory, and such an appeal, to be effectual must be taken within thirty days from entry of the interlocutory decree.[89]

A decree dismissing one branch of the issues raised, leaving other substantial issues undetermined, is not a final decree, and is not appealable.[90]

The United States Circuit Courts of Appeals will review the action of the district courts in granting or refusing preliminary injunctions for the purpose of reviewing the discretion of the court below and correcting error in its exercise. In a proper case it will enlarge the scope of a preliminary injunction which falls short of protecting the complainant's rights.[91]

Where such a preliminary injunctive order is appealed from, however, "the question for consideration is whether the court below improperly exercised its discretionary power in respect of issuing an injunction *pendente lite*. Unless it clearly appears that it has so done, the order should be affirmed."[92]

§ 202. Certiorari.—Sec. 18 of the Act of 1905 provides as follows:

"That writs of *certiorari* may be granted by the Supreme Court of the United States for the review of cases arising under this act in the same manner as provided for in patent cases by the act creating the circuit court of appeals."

88—Puritan Cordage Mills v. Sampson Cordage Works, 232 Fed. Rep. 138 (C. C. A. 6).

89—Raymond v. Royal Baking Powder Co., 76 Fed. Rep. 465; 22 C. C. A. 278.

90—Memphis Keeley Institute v. Leslie E. Keeley Co., 75 C. C. A. 430; 144 Fed. Rep. 628, 631.

91—Charles E. Hires Co. v. Consumers' Co., 100 Fed. Rep. 809-813; 41 C. C. A. 71.

92—Chickering v. Chickering & Sons, 120 Fed. Rep. 69, 73; 56 C. C. A. 475; Pfeiffer v. Wilde, 46 C. C. A. 415; 107 Fed. Rep. 456; affirming Pfeiffer v. Wilde, 102 Fed. Rep. 658.

The act referred to is known as the Judiciary Act of 1891, sec. 6 of which act provides, "That in any such case as is hereinbefore made final in the circuit court of appeals, it shall be competent for the supreme court to require by *certiorari* or otherwise, any such case to be certified to the supreme court for its review and determination with the same power and authority in the case as if it had been carried by appeal or writ of error to the supreme court." Section 716 of the United States Revised Statutes has been held to authorize the use of writs of *certiorari* by the supreme court in all proper cases.[93]

The general rule concerning the issuance of a writ of *certiorari* by the supreme court is that it rests within the discretion of the court. Mr. Chief Justice Fuller has said that: "When sought as between private persons, the general rule is that the writ of *certiorari* will be granted or denied, in the sound discretion of the court, on special cause or ground shown; and will be refused where there is a plain and equally adequate remedy by appeal or otherwise."[94]

Under sec. 18 of the Trademark Act of 1905, the final decision of a circuit court of appeals is not appealable to the supreme court, and can be reviewed only upon *certiorari*.[95]

93—*In re* Tampa Suburban R. Co., 168 U. S. 583; 42 L. Ed. 589.

94—*In re* Tampa Suburban R. Co., 168 U. S. 583; 42 L. Ed. 589.

95—Hutchinson, Pierce & Co. v. Loewy, 217 U. S. 457; 54 L. Ed. 838; Street & Smith v. Atlas Mfg. Co., 231 U. S. 348; 58 L. Ed. 262; G. & C. Merriam Co. v. Syndicate Pub. Co., 237 U. S. 618; 59 L. Ed. 1148.

CHAPTER XIV.

MATTERS OF PRACTICE AND EVIDENCE.

§ 203. Matters of which courts will take judicial notice.—This subject is of practical importance in the trial of trademark causes. The courts of the United States will take judicial notice of the statutes of the several states,[1] and of the decisions of the state courts upon the constitutionality of such statutes.[2] All courts will take judicial notice of treaties or conventions with a foreign government or power.[3] It has been expressly held that judicial notice will be taken of the convention concerning trademarks, of April 16, 1869, between the United States and France.[4] As in other classes of cases, the courts take judicial notice of political facts, legal facts, official facts, public history, natural history and the vernacular language, and all matters of common and ordinary knowledge, including matters of scien

§ 204. Expert and other evidence on the question of infringement.—Inspection by the court is the main, and indeed the final test of the alleged resemblance in trademark cases.[5] The courts, as a rule, give little weight to expert testimony on questions of similitude.[6]

1—*In re* Jordan, 49 Fed. Rep. 238; Gormley v. Bunyan, 138 U. S. 623; 34 L. Ed. 1086.

2—Knox v. Columbia Liberty Iron Co., 42 Fed. Rep. 378.

3—*Ex parte* McCabe, 46 Fed. Rep. 363.

4—La Croix v. Sarrazzin, 15 Fed. Rep. 489.

5—Von Mumm v. Frash, 56 Fed. Rep. 830-838; Filley v. Fassett, 44 Mo. 173; Gail v. Wackerbarth, 28 Fed. Rep. 286; Drummond v. Addison-Tinsley Tob. Co., 52 Mo. App. 10; Collins Chemical Co. v. Capitol City Mfg. Co., 42 Fed. Rep. 64; Liggett & Myer Tob. Co. v. Hynes, 20 Fed. Rep. 883; Joseph Dixon Crucible Co. v. Benham, 4 Fed. Rep. 527.

6—Cook v. Starkweather, 13 Abb. Pr. N. S. 392; Popham v. Wilcox, 66 N. Y. 69; *In re* Jelley, Son & Jones, 51 L. J. Ch. 639; Radam v. Destroyer Co., 81 Texas, 122; 16 S. W. Rep. 990; P. Lorillard Co. v. Peper, 86 Fed. Rep. 956; Monopol Tobacco Works v. Genisor, 66 N. Y. Supp. 155. Lord Esher, Master of the Rolls, has tersely said: "If a man was to come and tell me that a horse was like a cat, he

Testimony of skilled witnesses to the effect that in their opinion the public is likely to be deceived by the similarity of two trademarks, although valuable in a doubtful case,[7] is not of itself sufficient evidence of infringement.[8] When technical trade or scientific questions are involved, however, expert evidence is highly desirable,[9] and especially when the probability of the ultimate consumer being deceived by the defendant's goods rests on the character and habits of the people who use the product,[10] or the manner in which the goods are usually sold or exhibited by the retailer.[11]

Where the defendant was charged with refilling "A. V. H." gin bottles, evidence of an expert gauger showing a variance in alcoholic proof between the genuine gin and that sold by defendant in the trademarked packages, was admitted.[12]

Where the complainant's case rested on the testimony of hired witnesses that they had drunk bitters sold them by the defendant in his saloon as being complainant's bitters and that said bitters were imitation, the bill was dismissed on the conflicting testimony offered in defense, the court remarking that hired witnesses are not disinterested and their testimony for that reason should be scrutinized with unusual caution.[13] In dismissing a bill in which a defendant was charged with refilling genuine

might swear it, and you might get fifty persons to swear it, but I should not act on such evidence, because it is pure nonsense." *In re* Christiansen, 3 R. P. C. 54-61.

7—Celluloid Mfg. Co. v. Read, 47 Fed. Rep. 712-716.

8—Columbia Mill Co. v. Alcorn, 40 Fed. Rep. 676; Cope v. Evans, L. R. 18 Eq. 138. But in one case such evidence was admitted and approved (Williams v. Brooks, 50 Conn. 278; 47 Am. Rep. 642), while in another its propriety was questioned (Radam v. Capital Microbe Destroyer Co., 81 Texas, 122; 26 Am. St. Rep. 783).

9—Mitchell v. Henry, L. R. 15 Ch. D. 181; 43 L. T. 186; Cartmell, 227; *In re* Worthington, 14 Ch. D. 8; 49 L. J. Ch. 646; Cartmell, 351; *In re* Christiansen, 3 R. P. C. 54; Cartmell, 95; Gorham Co. v. White, 14 Wall. 511; 20 L. Ed. 731; Williams v. Brooks, 50 Conn. 278; Price & Steuart, 654; Celluloid Mfg. Co. v. Read, 47 Fed. Rep. 712-716.

10—Drummond v. Addison-Tinsley Tob. Co., 52 Mo. App. 10; Sperry v. Percival Milling Co., 81 Cal. 252-260.

11—*In re* Worthington, L. R. 14 Ch. D. 8.

12—Van Hoboken v. Mohns & Kaltenbach, 112 Fed. Rep. 528.

13—Hostetter Co. v. Bower, 74 Fed. Rep. 235. The quantity of proof adduced, and its weight, necessarily must be fixed by the attendant circumstances of each case. Thus, in one case it was held that a single sale of the infringing article by the defendant's clerk was insufficient to warrant injunc-

packages, where the evidence was conflicting, Judge Coxe remarked that "the burden is strongly upon the complainant to prove fraud by a fair preponderance of evidence."[14]

Where proof is offered to show that the complainant's business has increased steadily during the period of the alleged unfair competition, and there is no evidence of injury, such facts will be considered in determining the complainant's right to relief.[15] Where the only evidence of deception came from purchasers who were not misled, it was held that the facts constituted a case of substitution on the part of the retailer, and not unfair competition.[16]

Expert testimony on other issues.—While the question of the likelihood of the defendant's acts to cause deception is one on which opinion evidence is inadmissible,[17] it is competent to prove by witnesses familiar with the trade the customs of the trade, the class of customers, and any other matters of fact which may be useful in aiding the court to reach an opinion on the question of probability of deception.[18]

tion. Leahy v. Glover, 10 R. P. C. 141. And in a patent case it was held that a single sale was not *per se* an infringement. Byam v. Bullard, 1 Curt. 100; Fed. Case No. 2262. But evidence of a single sale "may, in connection with other proof, be persuasive evidence of other sales, and convincing proof of an intention to sell whenever the opportunity of doing so without detection is presented." Lacombe, J., in Lever Bros. (Ltd.) v. Pasfield, 88 Fed. Rep. 484. Citing De Florez v. Raynolds, 14 Blatchf. 505. "That fraud may not be presumed does not imply that it may not be proved by circumstances, since it may be apparent from the intrinsic nature and subject of the transaction itself. *In re* Walden Bros. Clothing Co., 199 Fed. Rep. 315; Lumpkin v. Foley, 204 Fed. Rep. 372, 122 C. C. A. 542. Direct evidence is not necessary to prove fraud, provided the circumstances relied on are convincing, and inconsistent with a presumption of honesty. Crowder v. Allen-West Commission Co., 213 Fed. Rep. 177; 129 C. C. A. 521; Goodman v. Curtis, 174 Fed. Rep. 644; 98 C. C. A. 398." Toulmin, J., *In re* Brincat, 233 Fed. Rep. 811, 816.

14—Hostetter Co. v. Comerford, 97 Fed. Rep. 585.

15—Stevens Linen Works v. William & John Don & Co., 121 Fed. Rep. 171.

16—Bickmore Gall Cure Co. v. Karns Mfg. Co., 126 Fed. Rep. 573.

17—Payton v. Snelling, 17 R. P. C. 635; Alaska Packers' Assn. v. Crooks & Co., 18 R. P. C. 135; Hennessy & Co. v. Dompe, 19 R. P. C. 333, 339; Hennessy & Co. v. Keating, 25 R. P. C. 125, 361.

18—Payton v. Snelling, (1901) A. C. 308; Bourne v. Swan & Edgar, (1903) 1 Ch. 211; Royal Ins. Co. v. Midland Ins. Co., 25 R. P. C. 728; St. Mungo Co. v. Viper Co., 27 R. P. C. 420.

A witness familiar with the trade may testify to the catchword or other peculiar designation by which an article is known to the trade,[19] or to consumers;[20] and of course other witnesses similarly qualified may testify to the contrary.[21]

Testimony of witnesses properly qualified is admissible to show that owing to the defendant's infringement, plaintiff's sales have fallen off; this is true both at law[22] and in equity.[23] In the action at law it is competent for the plaintiff's proof to show that his sales fell off concurrently with the defendant's infringement, from which the jury may infer that the falling off was the result of the defendant's acts.[24]

Evidence of defendant's good faith.—The relief resting upon the charge of fraud, the fact that a defendant has transacted his alleged infringement openly, by extensive advertising of his package will be considered as bearing on the question of intent, where a technical trademark is not involved.[25]

§ 205. Successive changes, approach to plaintiff's dress.—Where the defendant is shown to have gradually adopted labels, forms of package, and other distinctive features of the plaintiff's goods, from a beginning in which his goods bore no resemblance to those of the plaintiff, that fact is strong evidence of fraudulent motive.[26] Similarly, the defendant's first infringement may be so flagrant that copying is manifest, and a later changed and modified label may show he was anticipating prosecution.[27]

§ 206. Exhibits.—It is particularly desirable that the conflicting marks be at all times easily accessible to the court, and that they be filed as exhibits whenever possible. The practice of the courts of several states does not permit exhibits, other than documentary, to be filed, as no provision has been made

19—Pollen v. LeRoy, 30 N. Y. 549-561.

20—Johnson & Johnson v. Bauer & Black, 27 C. C. A. 374; 82 Fed. Rep. 662; Read v. Richardson, 45 L. T. N. S. 54; Cox, Manual, No. 698.

21—Wilkinson v. Greely, Fed. Case No. 17671; 1 Curt. 63.

22—Shaw v. Pilling, 175 Pa. St. 78-84; 34 Atl. Rep. 446.

23—Hostetter v. Vowinkle, Fed. Case, No. 6714; 1 Dill. 329; Cox, Manual, No. 207.

24—Shaw v. Pilling, *supra*.

25—T. B. Dunn Co. v. Trix Mfg. Co., 63 N. Y. Supp. 33.

26—Carmel Wine Co. v. Palestine Hebrew Wine Co., 161 Fed. Rep. 654.

27—Franck v. Frank Chicory Co., 95 Fed. Rep. 818.

for their accommodation and safe-keeping. In Missouri, where this condition prevails, the St. Louis Court of Appeals has recommended the preservation of the brands or labels as a part of the record on appeal.[28]

The federal courts, however, afford every facility required for the care of exhibits and the following rule is in effect in all the federal circuit courts of appeals:

"1. Models, diagrams and exhibits of material forming part of the evidence taken in the court below, in any case pending in this court on writ of error or appeal, shall be placed in the custody of the marshal of this court at least ten days before the case is heard or submitted.

"2. All models, diagrams and exhibits of material placed in the custody of the marshal for the inspection of the court on the hearing of a case must be taken away by the parties within one month after the case is decided. When this is not done, it shall be the duty of the marshal to notify the counsel in the case, by mail or otherwise, of the requirements of this rule, and, if the articles are not removed within a reasonable time after notice is given, he shall destroy them or make such other disposition of them as to him may seem best." [29]

It is frequently expedient to annex to the order of injunction specimens of the marks used by the defendant.[30]

§ 207. Discovery.—The resistance of discovery is usually met with by complainants in trademark causes.

Lord Romilly compelled a defendant to make a full discovery of all his sales, the prices, profits realized and the names of the purchasers, notwithstanding the objection of the defendant that he would thereby disclose his business secrets;[31] and full discovery has been compelled in other cases.[32] The power to compel

28—Alden v. Gross, 25 Mo. App. 123. And in this connection see Mahler v. Sanche, 223 Ills. 136; 79 N. E. Rep. 9, reversed because of insufficient facts in the record as to similarity of instruments dealt in by the respective parties. The facts are embodied in Sanche v. Mahler, 219 Ills. 349; 76 N. E. Rep. 485.

29—The above rule is numbered rule 34 in each court of appeals but that of the seventh circuit, where it is numbered rule 32.

30—Hansen v. Siegel-Cooper Co. (1), 106 Fed. Rep. 690, 691.

31—Howe v. McKernan, 30 Beav. 547.

32—Leather Cloth Co. v. Hirschfeld (2), 1 H. & M. 295; Seb. 224, Orr v. Diaper, L. R. 4 Ch. D. 92; 46 L. J. Ch. 41; Seb. 519.

discovery is inherent in equity, but is not vested in courts of law in the absence of statutory enactment.[33]

"Equitable jurisdiction will not attach for discovery simply, except in aid of a suit at law."[34]

In actions at law production of books and papers is fully provided for, in federal practice, by sec. 724 of the Revised Statutes. It has been held that inspection of books or writings may be ordered to be made before the trial.[35] Its provisions, when affording an adequate remedy, preclude resorting to equity to compel discovery,[36] and render the issuance of a *subpœna duces tecum* unnecessary.[37]

In equitable proceedings discovery will not be enforced when it may tend to incriminate the person against whom discovery is sought,[38] or to disclose trade secrets,[39] and the same rule applies to the enforced production of books and papers by such persons.[40]

Subject to these restrictions, discovery of material facts will be compelled.[41]

When a defendant professes to answer, he must answer fully. If he desires protection against discovery, he must seek such protection by plea.[42]

§ 208. Evidence of recognition by others of plaintiff's right to the mark.—The rule is well settled that a former adjudication establishing a trademark, where there has been an adjudication after a *bona fide* contest on the merits, and the same issues

33—Colgate v. Compagnie Française, 23 Fed. Rep. 82-85.

34—Colt, J., in Lord v. Whitehead & Atherton Machine Co., 24 Fed. Rep. 801. Discovery is now provided for by new equity rule 30, which see, *post*, § 211.

35—Lucker v. Phœnix Assurance Co., 67 Fed. Rep. 18; Exchange Bank v. Wichita Cattle Co., 61 Fed. Rep. 190; United States v. National Lead Co., 75 Fed. Rep. 94.

36—Washburn & Moen Mfg. Co. v. Freeman Wire Co., 41 Fed. Rep. 410; Paton v. Majors, 46 Fed. Rep. 210. But see Colgate v. Compagnie Française, 23 Fed. Rep. 82.

37—Kirkpatrick v. Pope Mfg. Co., 61 Fed. Rep. 46.

38—Byass v. Sullivan, 21 How. Pr. 50; Cox, 278.

39—See *ante*, Chapter VII. and Dobson v. Graham, 49 Fed. Rep. 17.

40—*Ibid.* See also Union Paper Collar Co. v. Metropolitan Collar Co. (Ltd.), 3 Daly, 171.

41—Benbow v. Low, L. R. 16 Ch. D. 93; Byass v. Sullivan, 21 How. Pr. 50; Cox, 278.

42—Howe v. McKernan, 30 Beav. 547; Slater v. Banwell, 50 Fed. Rep. 150.

were presented as in the later suit, is of persuasive if not binding force in a later case.[43] But a mere showing that the claimant of the trademark has by threats of legal prosecution compelled or induced others to enter into undertakings to desist from the use of the name, or that others have submitted to injunctions without a contest, is very slight, if any, evidence of the plaintiff's right to use the mark. In a recent case before the House of Lords, Lord Davey said in regard to evidence of cases in which other persons had submitted to injunctions and had paid the costs: "That does not appear to me to be very strong evidence in favor of the pursuers. Of course, a shop-keeper or a person in that position would hesitate a long time before he incurred the expense, which in the case of a trademark or in a patent case is not slight, of defending an action of this character; probably the value to him of the trade he would lose would not in any way compensate for the risk he would incur. Therefore, as evidence of the fact, I do not attach much importance to those cases."[44] An interlocutory decree of one court appears to be entitled to but little weight in a proceeding before another.[45]

§ 209. Contempts.—It is provided by sec. 725 of the United States Revised Statutes that the courts of the United States shall have the power to punish, "by fine or imprisonment, at the discretion of the court, contempt of their authority; provided, that such power to punish contempts shall not be construed to extend to any cases except the misbehavior of any person in their presence, or so near thereto as to obstruct the administration of justice, the misbehavior of any of the officers of said courts in their official transactions, and the disobedience or resistance by any such officer, or by any party, juror, witness, or other person,

43—Moxie Nerve Food Co. v. Beach, 33 Fed. Rep. 248; Symonds v. Greene, 28 Fed. Rep. 834; La Republique Francaise v. Saratoga Vichy Springs Co., 99 Fed. Rep. 733. But a decision of the English high court of chancery adverse to the claimant of a mark is not a bar to a suit for infringement of the mark brought in the United States. City of Carlsbad v. Kutnow, 68 Fed. Rep. 794. And to the same effect see Hohner v. Gratz, 50 Fed. Rep. 369.

44—Cellular Clothing Co. v. Maxton, L. R. (1899) A. C. 326-346.

45—Walter Baker & Co. v. Sanders, 80 Fed. Rep. 889; 26 C. C. A. 220.

to any lawful writ, process, order, rule, decree, or command of said courts."

Contempt of court is a specific criminal offense.[46] Imposition of a fine for contempt is a judgment in a criminal case.[47] It has been held that a plaintiff who circulates matter prejudicial to the defense of a pending action for trademark infringement is guilty of a contempt,[48] as has also been held of a plaintiff who published a false and perverted construction of the purpose and effect of an injunction.[49]

By far the greater number of applications to commit for contempt in the class of cases under consideration are based upon the failure of the party enjoined to comply with the injunctive decree. Where no attempt has been made toward compliance with the decretal order, the respondent is, of course, in contempt and liable to commitment, like any other contemnor.[50] But where some effort has been made to comply with the order, but to an extent not satisfactory to the complainant, an issue of fact is raised for the determination of the trial court, and as a rule its findings and judgment will not be reviewed on appeal;[51] and where the contempt proceedings are referred, the court is reluctant to disturb the findings of fact made by the referee.[52]

It is a contempt, after decree, to offer the infringing goods for sale, even though no sale is actually effected;[53] nor does it exempt the defendant from commitment to show that he intended to comply with the decree, if in fact he has not complied with it.[54] But wherever the court determines that the defendant has so altered his marks or packages that there is no longer any danger of the public mistaking his goods for those of the plain-

46—Fischer v. Hayes, 6 Fed. Rep. 63-68.

47—New Orleans v. Steamship Co., 20 Wall. 387-392; 22 L. Ed. 354; Butler v. Fayerweather, 91 Fed. Rep. 458; 33 C. C. A. 625; 63 U. S. App. 123.

48—Coats v. Chadwick, L. R. (1894) 1 Ch. D. 347.

49—Gorham Mfg. Co. v. Emery-Bird-Thayer Dry Goods Co., 92 Fed. Rep. 774-779.

50—Rodgers v. Nowill (2), Cox, Manual, No. 115; 3 DeG. M. & G. 614.

51—Devlin v. Devlin, 69 N. Y. 212; Cox, Manual, No. 463.

52—Hennessy v. Budde, 82 Fed. Rep. 541.

53—Marcovitch v. Bramble, Wilkins & Co., Cox, Manual, No. 595.

54—Devlin v. Devlin, 69 N. Y. 212; Cox, Manual, No. 463.

tiff, he will be discharged.[55] Where, however, the change is only sufficient to avoid the letter of the decree, and the defendant's mark or package is still calculated to promote deception, under the English practice the injunction may be enlarged upon the hearing of the contempt proceedings so as to cover the new fraud, even though the motion to commit must be refused.[56] The rulings of the courts in this regard have taken a wide range. There have been cases in which the court has declined to commit upon the defendant making an offer to devise such changes in his mark as would meet with the approval of the court,[57] and others where the court has directed the defendant to make such changes with the alternative of being committed.[58] Where an injunction is in part mandatory and in part prohibitive, and the mandatory portion is suspended by an appeal, the court can not punish the defendant for contempt for the violation of such mandatory portion, although his act is a joint violation of both portions.[59]

And a defendant who sells a stock of bottles, labels and wrappers to a third party, after a decree enjoining him from dealing in an infringing liquor put up in the bottles, under the labels and enclosed in the wrappers, under circumstances indicating that it was for the purpose of enabling the purchaser to supply defendant's former customers with the infringing goods, is guilty of contempt.[60] One who is enjoined from preparing, putting up, selling, offering or advertising for sale, any medicinal beverage made from fermented milk under the name of "Matzoon" is guilty of contempt if he aids another in doing the forbidden acts, as the agent or servant of the other.[61] Where the injunctive order runs against agents, servants and employes "there is no restraint laid upon the agent, servant, or employe personally, but merely as the agent, servant, or employe of the enjoined defendant."[62] One enjoined from using a firm name, who con-

55—Swift v. Dey, 4 Robertson, 611; Cox, 319.

56—Cartier v. May, Cox, Manual, No. 200.

57—Croft v. Day (2), Cox, Manual, No. 77.

58—Rodgers v. Nowill (2), Cox, Manual, No. 115; 3 DeG. M. & G. 614.

59—Schwarz v. Superior Court, 111 Cal. 106.

60—Societe Anonyme v. Western Distilling Co., 42 Fed. Rep. 96.

61—Dadirrian v. Gullian, 79 Fed. Rep. 784.

62—*Ibid;* citing Slater v. Merritt, 75 N. Y. 268.

tinues to use stationery bearing the name, left legible through having ink spread over it, is guilty of contempt,[63] as is one who publishes a circular reflecting upon the decree under which he is enjoined.[64]

The foregoing rulings have been made in unfair trade cases. It would be foreign to our purpose to go into an extended discussion of the law governing contempts, which applies to this as to all other classes of cases. It is well to note, however, that in the federal courts, at least, while proceedings in contempt are not reviewable on error or appeal, they may be reached by *certiorari*.[65]

§ 210. Affidavits.—Applications for restraining orders and preliminary injunctions are usually founded upon and resisted by affidavits. A preliminary injunction will not be awarded on *ex parte* affidavits unless in a clear case.[66] The complainant's affidavits in chief must show all the facts necessary to establish a *prima facie* right to the injunction sought.[67] The defendant's affidavits may be by way of traverse, in which case no counter affidavits can be offered by the complainant; or they may set up matter by way of confession and avoidance, in which case the complainant may produce affidavits in reply. But where such affidavits are offered by the complainant in reply, no further affidavits can be offered by the defendant by way of rejoinder.[68]

All affidavits so used must be entitled in the cause; otherwise they are mere extra-judicial oaths, perjury could not be assigned upon them, and they can not be considered as evidence.[69] The

63—Hildreth v. McCaul, 74 N. Y. Supp. 1075.

64—Janney v. Pan-Coast Ventilator & Mfg. Co. (2), 131 Fed. Rep. 143.

65—*In re* Chetwood, 165 U. S. 443-462; 41 L. Ed. 782; Schwartz v. Superior Court, 111 Cal. 106. Compare Butler v. Fayerweather, 91 Fed. Rep. 458; 33 C. C. A. 625; 63 U. S. App. 123; holding that writ of error will lie to review an order committing for contempt a witness, not a party to the cause, for his refusal to answer questions.

66—Lare v. Harper & Bros., 86 Fed. Rep. 481; 30 C. C. A. 373; New York Asbestos Mfg. Co. v. Ambler Asbestos Air-cell Covering Co., 99 Fed. Rep. 85; Diamond Match Co. v. Safe Harbor Match Co., 109 Fed. Rep. 154.

67—Leclanche Battery Co. v. Western Electric Co., 21 Fed. Rep. 538.

68—Day v. New England Car Spring Co., 3 Blatch. 154-159, Fed. Case No. 3,686.

69—Hawley v. Donnelly, 8 Paige, 415; Buerk v. Imhaeuser, Fed. Case No. 2107*a*; 10 Off. Gaz. 907;

moving affidavits in contempt proceedings must directly charge the acts of violation of the decree; if on information and belief they are insufficient.[70]

§ 211. The taking of testimony.—In actions at law depositions may be taken on due notice at any time subsequent to the filing of the petition, and it is immaterial whether the cause is at issue or not. The Act of March 9, 1892, c. 14, 27 Stat. at L. 7, U. S. Comp. St. 1901, p. 664, permits depositions of witnesses in cases pending in the courts of the United States to be taken in the mode prescribed by the laws of the state in which the courts are held. For practical orders made under this section the case cited in the note will furnish illustrations.[71]

The new equity rules, as promulgated by the supreme court at the October term, 1912, regulate the taking of testimony in equity causes in the federal courts, as follows:

46.

TRIAL—TESTIMONY USUALLY TAKEN IN OPEN COURT —RULINGS ON OBJECTIONS TO EVIDENCE.

In all trials in equity the testimony of witnesses shall be taken orally in open court, except as otherwise provided by statute or these rules. The court shall pass upon the admissibility of all evidence offered as in actions at law. When evidence is offered and excluded, and the party against whom the ruling is made excepts thereto at the time, the court shall take and report so much thereof, or make such a statement respecting it, as will clearly show the character of the evidence, the form in which it was offered, the objection made, the ruling, and the exception. If the appellate court shall be of opinion that the evidence should have been admitted, it shall not reverse the decree unless it be clearly of opinion that material prejudice will result from an affirmance, in which event it shall direct such further steps as justice may require.[72]

Goldstein v. Whelan, 62 Fed. Rep. 124. To the contrary see Shook v. Rankin, 6 Biss. 477, 480, 481, Fed. Case 12, 804; Modox Co. v. Moxie Nerve Food Co., 162 Fed. Rep. 649, 651; 89 C. C. A. 441.

70—Davidson v. Mussey, 29 Utah 181; 80 Pac. Rep. 743.

71—Wallace v. D. Appleton & C 161 Fed. Rep. 884.

72—A new rule, abolishing practice of former rule 67 as

47.

DEPOSITIONS—TO BE TAKEN IN EXCEPTIONAL INSTANCES.

The court, upon application of either party, when allowed by statute, or for good and exceptional cause for departing from the general rule, to be shown by affidavit, may permit the deposition of named witnesses, to be used before the court or upon a reference to a master, to be taken before an examiner or other named officer, upon the notice and terms specified in the order. All depositions taken under a statute, or under any such order of the court, shall be taken and filed as follows, unless otherwise ordered by the court or judge for good cause shown: Those of the plaintiff within sixty days from the time the cause is at issue; those of the defendant within thirty days from the expiration of the time for the filing of plaintiff's depositions; and rebutting depositions by either party within twenty days after the time for taking original depositions expires.[73]

48.

TESTIMONY OF EXPERT WITNESSES IN PATENT AND TRADEMARK CASES.

In a case involving the validity or scope of a patent or trademark, the district court may, upon petition, order that the testimony in chief of expert witnesses, whose testimony is directed

adopting the English practice of oral testimony in open court save where special cause exists for taking the testimony otherwise. For the English practice, see Order XXXVII, Rules 5 to 25, both inclusive.

By empowering the trial court to pass upon the admissibility of the evidence, and providing for appellate review of questions of evidence, the rule restores the practice as it existed prior to 1842, as explained in Blease v. Garlington, 92 U. S. 1; 23 L. Ed. 521.

For a discussion of the reasons which led to the adoption of this rule, see North v. Herrick, 203 Fed. Rep. 591.

73—A new rule, supplementary to Rule 46, next preceding.

This rule does not vary, abrogate or limit the application of § 863, R. S. U. S., and depositions taken under that statute need not be taken by leave of court, or within the time limited by Rule 47. Iowa Washing Mach. Co. v. Montgomery Ward & Co., 227 Fed. Rep. at p. 1007 (S. Dist. N. Y., Mayer, Hough, A. N. Hand and Learned Hand, JJ.).

to matters of opinions, be set forth in affidavits and filed as follows: Those of the plaintiff within forty days after the cause is at issue; those of the defendant within twenty days after plaintiff's time has expired; and rebutting affidavits within fifteen days after the expiration of the time for filing original affidavits. Should the opposite party desire the production of any affiant for cross-examination, the court or judge shall, on motion, direct that said cross-examination and any re-examination take place before the court upon the trial, and unless the affiant is produced and submits to cross-examination in compliance with such direction, his affidavit shall not be used as evidence in the cause.[74]

74—A new rule, supplementary to the two rules next preceding.

The provisions as to affidavits in the English practice are to be found in Order XXXVII, Rules 20 and 24; Order XXXVIII, Rules 25, 26, 27 and 28.

It is not clear why Rule 48 should distinguish between opinion witnesses in patent or trademark cases, and other cases. No such distinction obtains in England, where the rule is that: "Affidavits shall be confined to such facts as the witness is able of his own knowledge to prove, except on interlocutory motions, on which statements as to his belief, with the grounds thereof, may be admitted" (Order XXXVIII, Rule 3).

It is particularly obscure why trademark cases should be specified in the rule, as practically no opinion witnesses are employed in such cases, in view of the repeated rulings that the best tests of resemblance (the point upon which expert testimony was formerly occasionally introduced) are proof of actual instances of substitution, and visual inspection by the court.

Is this Rule in Contravention of Statute?—In sec. 917 it is enacted that the supreme court shall have power "to prescribe * * * in any manner *not inconsistent with any law of the United States* * * * the modes * * * of taking and obtaining evidence." So, also, in sec. 913, Revised Statutes of the United States, it is provided that the forms and modes of proceeding in suits of equity are subject to regulation by the supreme court by rules prescribed not inconsistent with the laws of the United States. See *Ex parte* Phenix Ins. Co., 118 U. S. 610; 30 L. Ed. 274. In the Judiciary Act of 1789, 1 Stat. at L. 88, sec. 30, it was provided that the mode of proof by oral testimony and examinations of witnesses in open court should be the same in all the courts of the United States, as well in the trial of causes in equity as of actions at common law; and this provision remained in force until the adoption of the Revised Statutes, of which sec. 862 repealed it. Blease v. Garlington, 92 U. S. 1; 23 L. Ed. 521.

It is provided by sec. 862 that "the mode of proof in causes of equity * * * shall be according to rules now or hereafter prescribed

by the supreme court, except as herein specially provided." As to such special provisions as are thereby excepted from the power of the supreme court to make rules, that court has said "when the statutes of the United States make special provisions as to the competency or admissibility of testimony, they must be followed in the courts of the United States." Mr. Chief Justice Waite, in Whitford v. County of Clark, 119 U. S. 522; 30 L. Ed. 500.

Section 863 contains the following provision: "The testimony of any witness may be taken in any civil cause depending in a district or circuit court by deposition *de bene esse*, when the witness lives at a greater distance from the place of trial than one hundred miles, or is bound on a voyage to sea, or is about to go out of the United States, or out of the district in which the case is to be tried, and to a greater distance than one hundred miles from the place of trial, before the time of trial, or when he is ancient and infirm." Of sec. 863, Mr. Justice Miller has said, "No one can examine these provisions for procuring testimony to be used in the courts of the United States, and have any reasonable doubt, so far as they apply, they were intended to govern the practice, in that respect, in those courts. They are, in the first place, too complete, too far-reaching, and too minute to admit of any other conclusion. But we have not only this inference from the character of the legislation, but it is enforced by the express language of the law in providing a defined mode of proof in those courts, and in specifying the only exceptions to that mode which shall be admitted." *Ex parte* Fisk, 113 U. S. 713; 28 L. Ed. 1117; followed in Hanks Dental Assn. v. International Tooth Crown Co., 194 U. S. 303; 48 L. Ed. 989.

We see, therefore, that sec. 863 does not distinguish between classes of witnesses. The question therefore arises whether the supreme court has any authority to withdraw from the operation of sec. 863 opinion witnesses as a class. Does the promulgation of Rule 48 have the effect of depriving a party litigant of the absolute right to take the testimony of an expert or opinion witness, where that witness resides at a greater distance from the place of trial than one hundred miles, or the other statutory causes for taking his deposition under sec. 863 exist? Have the district courts authority by a local rule to require a notice to take depositions under sec. 863 to specify whether the witnesses are expert or fact witnesses? Conceding the validity of the rule as to witnesses resident within the 100-mile radius from the place of trial, it is difficult to see how a district court may on petition make an order in the terms of Rule 48 which will be of any force as against a party who may see fit to use the testimony of an expert witness under circumstances entitling that party to take the testimony of the witness under sec. 863. It then seems that Rule 48 must be construed to mean that a party may, under its provisions, offer his own expert testimony in affidavit form; not that he can deprive the opposite party of the right to take expert testimony by deposition under sec. 863.

For an illustration of the application of this rule see, P. M. Co. v.

49.

EVIDENCE TAKEN BEFORE EXAMINERS, ETC.

All evidence offered before an examiner or like officer, together with any objections, shall be saved and returned into the court. Depositions, whether upon oral examination before an examiner or like officer or otherwise, shall be taken upon questions and answers reduced to writing, or in the form of narrative, and the witness shall be subject to cross and re-examination.[75]

50.

STENOGRAPHER—APPOINTMENT—FEES.

When deemed necessary by the court or officer taking testimony, a stenographer may be appointed who shall take down testimony in shorthand, and, if required, transcribe the same. His fee shall be fixed by the court and taxed ultimately as costs. The expense of taking a deposition, or the cost of a transcript, shall be advanced by the party calling the witness or ordering the transcript.[76]

51.

EVIDENCE TAKEN BEFORE EXAMINERS, ETC.

Objections to the evidence, before an examiner or like officer, shall be in short form, stating the grounds of objection relied upon, but no transcript filed by such officer shall include argument or debate. The testimony of each witness, after being reduced to writing, shall be read over to or by him, and shall be signed by him in the presence of the officer; provided, that if the witness shall refuse to sign his deposition so taken, the officer shall sign the same, stating upon the record the reasons, if any, assigned by the witness for such refusal. Objection to any question or questions shall be noted by the officer upon the deposition, but he shall not have power to decide on the competency or materiality or relevancy of the questions. The court

Ajax Rail Anchor Co., 216 Fed. Rep. 634. That the rule furnishes the means of preventing a plaintiff from being taken by surprise at the trial, see Todd v. Whitaker, 217 Fed. Rep. 319.

75—A new rule, based upon provisions of former Rule 67.

76—A new rule, based upon similar provisions of former Rule 67.

shall have power, and it shall be its duty, to deal with the costs of incompetent and immaterial or irrelevant depositions, or parts of them, as may be just.[77]

52.

ATTENDANCE OF WITNESSES BEFORE COMMISSIONER, MASTER OR EXAMINER.

Witnesses who live within the district, and whose testimony may be taken out of court by these rules, may be summoned to appear before a commissioner appointed to take testimony, or before a master or examiner appointed in any cause, by subpoena in the usual form, which may be issued by the clerk in blank and filled up by the party praying the same, or by the commissioner, master, or examiner, requiring the attendance of the witnesses at the time and place specified, who shall be allowed for attendance the same compensation as for attendance in court; and if any witness shall refuse to appear or give evidence it shall be deemed a contempt of the court, which being certified to the clerk's office by the commissioner, master, or examiner, an attachment may issue thereupon by order of the court or of any judge thereof, in the same manner as if the contempt were for not attending, or for refusing to give testimony in, the court.

In case of refusal of witnesses to attend or be sworn or to answer any question put by the commissioner, master or examiner, or by counsel or solicitor, the same practice shall be adopted as is now practiced with respect to witnesses to be produced on examination before an examiner of said court on written interrogatories.[78]

53.

NOTICE OF TAKING TESTIMONY BEFORE EXAMINER, ETC.

Notice shall be given by the respective counsel or parties to the opposite counsel or parties of the time and place of exam-

77—A new rule, containing some of the provisions of former Rule 67. The provision that argument and debate shall be omitted from the transcript was made imperative by the abuse of the old rule.

78—A new rule embracing part of former Rule 67.

ination before an examiner or like officer for such reasonable time as the court or officer may fix by order in each case.[79]

54.

DEPOSITION UNDER REV. STAT. §§ 863, 865, 866, 867—CROSS-EXAMINATION.

After a cause is at issue, depositions may be taken as provided by secs. 863, 865, 866 and 867, Revised Statutes. But if in any case no notice has been given the opposite party of the time and place of taking the deposition, he shall, upon application and notice, be entitled to have the witness examined orally before the court, or to a cross-examination before an examiner or like officer, or a new deposition taken with notice, as the court or judge under all the circumstances shall order.[80]

79—A new rule; a paraphrase of a paragraph in former Rule 67.

80—Substantially former Rule 68. *Statutory provisions.*—Section 863, Revised Statutes of the United States: "The testimony of any witness may be taken in any civil cause depending in a district or circuit court by deposition *de bene esse*, when the witness lives at a greater distance from the place of trial than one hundred miles, or is bound on a voyage to sea, or is about to go out of the United States, or out of the district in which the case is to be tried, and to a greater distance than one hundred miles from the place of trial, before the time of trial, or when he is ancient and infirm. The depositions may be taken before any judge of any court of the United States, or any commissioner of a circuit court, or any clerk of a district or circuit court, or any chancellor, justice or judge of a supreme or superior court, mayor or chief magistrate of a city, judge of a county court or court of common pleas of any of the United States, or any notary public, not being of counsel or attorney to either of the parties, nor interested in the event of the cause. Reasonable notice must first be given in writing by the party or his attorney proposing to take such deposition, to the opposite party or his attorney of record, as either may be nearest, which notice shall state the name of the witness and the time and place of the taking of his deposition; and in all cases *in rem*, the person having the agency or possession of the property at the time of seizure shall be deemed the adverse party, until a claim shall have been put in; and whenever, by reason of the absence from the district and want of an attorney of record or other reason, the giving of the notice herein required shall be impracticable, it shall be lawful to take such depositions as there shall be urgent necessity for taking, upon such notice as any judge authorized to hold courts in such circuit or district shall think

reasonable and direct. Any person may be compelled to appear and depose as provided by this section, in the same manner as witnesses may be compelled to appear and testify in court."

Section 863 always applied to equity as well as common law causes. Stegner v. Blake, 36 Fed. Rep. 183, 184. Depositions may be taken under sec. 863 outside the district in which the case is to be tried (Patapsco Ins. Co. v. Southgate, 5 Peters, 604, 616; 8 L. Ed. 243, 248), and outside the circuit containing that district. Thum v. Andrews, 53 Fed. Rep. 84, 85. No order of court is necessary under sec. 863. "The right to take (the deposition) upon notice merely, in the manner prescribed, is given absolutely to the party by act of congress." Lacombe, J., in Henning v. Boyle, 112 Fed. Rep. 397.

"There are two general methods for taking depositions to be used on the trial of law cases provided for in the Revised Statutes; the one being the mode pointed out in sec. 863, and the other in sec. 866. When taken under the provisions of the former section, a commission to the officer is not sued out from the court in which the cause is pending, but the party desiring to take the testimony gives notice to the opposite party or his attorney of the time and place when and where the testimony is to be taken, and selects as the commissioner any one of the parties named in the section. When depositions are thus taken, no opportunity is afforded to the opposite party to be heard upon the matter of the selection of the commissioner. Hence it is required of the party taking the deposition that he shall select a disinterested commissioner, and the statute requires the party selected to certify that he is not of counsel for either party, nor interested in the event of the suit. If, however, the depositions are not taken under sec. 863, but under the authority granted in sec. 866, then, by the express terms of the latter section, the provisions of secs. 863, 864 and 865 are not applicable thereto. Section 866 provides for the court granting a *dedimus*, and in so doing it is presumed that the court will select a proper person to act as the commissioner, and the parties can be heard upon the question of the appointment before the commission issues. The authority conferred by sec. 866 is the granting a *dedimus* to take depositions according to common usage. In McLennan v. Railroad Co., 22 Fed. Rep. 198, it was held:

"'When, however, the facts are such in a given case that, under the provisions of statutes of the United States, the right to take the testimony of witnesses by deposition exists, then, as to the mere mode of procuring the deposition, parties may follow, at their election, either the provisions of the state law or of the act of congress.'

"In other words, if the right to take depositions existed, then the party desiring to take the same might do so under the provisions of sec. 863, or according to common usage, which, in an action at law, would be deemed to be in accordance with the mode provided for by the statutes of the state." Shiras, J., in Giles v. Paxton, 36 Fed. Rep. 882, 883.

"Reasonable notice" depends upon the particular circumstances of the case. American Exchange National Bank v. First Nat'l. Bank, 82 Fed.

Rep. 961; 27 C. C. A. 274. That to be used upon the trial, depositions taken in a case removed from a state court before its removal must comply with sec. 863, see Texas & P. R. Co. v. Wilder, 92 Fed. Rep. 953; 35 C. C. A. 105. As to naming the officer in the notice, see Gormley v. Bunyan, 138 U. S. 623; 34 L. Ed. 1086.

Section 865, Revised Statutes of the United States: "Every deposition taken under the two preceding sections shall be retained by the magistrate taking it, until he delivers it with his own hand into the court for which it is taken; or it shall, together with a certificate of the reasons as aforsaid of taking it and of the notice, if any, given to the adverse party, be by him sealed up and directed to such court, and remain under his seal until opened in court. But unless it appears to the satisfaction of the court that the witness is then dead, or gone out of the United States, or to a greater distance than one hundred miles from the place where the court is sitting, or that, by reason of age, sickness, bodily infirmity, or imprisonment, he is unable to travel and appear at court, such deposition shall not be used in the cause."

As to the requisites of the officer's certificate, see Sage v. Tauszky, Fed. Case 12,214; Jones v. Knowles, 1 Cranch C. C. 523; Fed. Case 7,474; Bussard v. Catalino, 2 Cranch C. C. 421; Fed Case 2,228; Egbert v. Citizens' Ins. Co., 7 Fed. Rep. 47; United States v. Julian, 162 U. S. 324; 40 L. Ed. 984. As to sealing, see *In re* Thomas, 35 Fed. Rep. 337.

Section 866, Revised Statutes of the United States: "In any cases where it is necessary, in order to prevent a failure or delay of justice, any of the courts of the United States may grant a *dedimus potestatem* to take depositions according to common usage; and any circuit court, upon application to it as a court of equity, may, according to the usages of chancery, direct depositions to be taken in *perpetuam rei memoriam*, if they relate to any matters that may be cognizable in any court of the United States. And the provisions of secs. 863, 864 and 865 shall not apply to any deposition to be taken under the authority of this section."

For the circumstances under which a *dedimus* under § 866 should be awarded, see Zych v. American Car & Foundry Co., 127 Fed. Rep. 723, 727; and see note to sec. 863, Revised Statutes of the United States, above.

"The method of taking deposition by commission is cumbersome and unsatisfactory, and not resorted to when the convenient method of taking proof prescribed by sec. 863, Revised Statutes of the United States, is available." Lacombe, J., in Henning v. Boyle, 112 Fed. Rep. 397. "The words 'common usage' in regard to a suit in equity refer to the practice in courts of equity." Blatchford, C. J., in Bischoffscheim v. Baltzer, 10 Fed. Rep. 1.

Section 867, Revised Statutes of the United States: "Any court of the United States may, in its discretion, admit in evidence in any cause before it any deposition taken in *perpetuam rei memoriam*, which would be so admissible in a court of the state wherein such cause is pending, according to the laws thereof."

"The provision is intended to permit the courts of the United States to admit in evidence testimony per-

55.

DEPOSITION DEEMED PUBLISHED WHEN FILED.

Upon the filing of any deposition or affidavit taken under these rules or any statute, it shall be deemed published, unless otherwise ordered by the court.[81]

56.

ON EXPIRATION OF TIME FOR DEPOSITIONS, CASE GOES ON TRIAL CALENDAR.

After the time has elapsed for taking and filing depositions under these rules, the case shall be placed on the trial calendar. Thereafter no further testimony by deposition shall be taken except for some strong reason shown by affidavit. In every such application the reason why the testimony of the witness can not be had orally on the trial, and why his deposition has not been before taken, shall be set forth, together with the testimony which it is expected the witness will give.[82]

58.

DISCOVERY—INTERROGATORIES—INSPECTION AND PRODUCTION OF DOCUMENTS—ADMISSION OF EXECUTION OR GENUINENESS.

The plaintiff at any time after filing the bill and not later than twenty-one days after the joinder of issue, and the defendant at any time after filing his answer and not later than twenty-one days after the joinder of issue, and either party at any

petuated according to the laws of the state, and in no wise relates to testimony perpetuated by direction of a circuit court in pursuance of the statutes of the United States under which this bill is filed." Benedict, J., in New York & Balto. Co. v. New York Co., 9 Fed. Rep. 578, 579.

81—A new rule abolishing the order of publication required by former Rule 69.

82—A new rule.

As Rule 47 allows a total of 110 days for depositions after the cause is at issue, this rule may be construed to mean that no case can go on the trial calendar until that time has elapsed.

What showing must be made under this rule on the application for leave to take testimony, and when such leave is proper to be granted, and that it may be made without prejudice to the opposing party even though he attends the taking of the testimony, are matters discussed in United Lace Mfg. Co. v. Barthels Mfg. Co., 217 Fed. Rep. 175.

time thereafter by leave of the court or judge, may file interrogatories in writing for the discovery by the opposite party or parties of facts and documents material to the support or defense of the cause, with a note at the foot thereof stating which of the interrogatories each of the parties is required to answer. But no party shall file more than one set of interrogatories to the same party without leave of the court or judge.

If any party to the cause is a public or private corporation, any opposite party may apply to the court or judge for an order allowing him to file interrogatories to be answered by any officer of the corporation, and an order may be made accordingly for the examination of such officer as may appear to be proper upon such interrogatories as the court or judge shall think fit.

Copies shall be filed for the use of the interrogated party, and shall be sent by the clerk to the respective solicitors of record, or to the last known address of the opposite party, if there be no record solicitor.

Interrogatories shall be answered, and the answers filed in the clerk's office, within fifteen days after they have been served, unless the time be enlarged by the court or judge. Each interrogatory shall be answered separately and fully and the answers shall be in writing, under oath, and signed by the party or corporate officer interrogated. Within ten days after the service of interrogatories, objections to them, or any of them, may be presented to the court or judge, with proof of notice of the purpose so to do, and answers shall be deferred until the objections are determined, which shall be at as early a time as is practicable. In so far as the objections are sustained, answers shall not be required.

The court or judge, upon motion and reasonable notice, may make all such orders as may be appropriate to enforce answers to interrogatories or to effect the inspection or production of documents in the possession of either party and containing evidence material to the cause of action or defense of his adversary. Any party failing or refusing to comply with such an order shall be liable to attachment, and shall also be liable, if a plaintiff, to have his bill dismissed, and if a defendant, to have his answer stricken out and be placed in the same situation as if he had failed to answer.

By a demand served ten days before the trial, either party may call on the other to admit in writing the execution or genuineness of any document, letter or other writing, saving all just exceptions; and if such admission be not made within five days after such service, the costs of proving the document, letter or writing shall be paid by the party refusing or neglecting to make such admission, unless at the trial the court shall find that the refusal or neglect was reasonable.[83]

§ 212. Effect of former adjudication.—A former decision adjudging the plaintiff's title to the trademark is a sufficient basis, where infringement is clear, for a preliminary injunction.[84] Of course the former adjudication is not conclusive, but it is always of persuasive value.[85]

When a former adjudication is urged as a bar to a later suit, the questions to be determined are, what was the judgment, was it within the jurisdiction of the court, was it between the same parties or their privies, and is it still in force and effect?[86] Where privity exists between the successive defendants, the decree in the earlier case must be given the same force and effect as if the original defendant were the defendant in the later case.[87]

The effect of a voluntary dismissal of a bill for trademark infringement has been held in England to be the abandonment

83—A new rule adopting the English practice of Order XXI, "Discovery and Inspection."

Under this rule the plaintiff's interrogatories are no longer a part of the bill, nor defendant's a part of the answer; in other words, they are no longer pleadings. Luten v. Camp, 221 Fed. Rep. 424. Interrogatories may be filed after issues are joined. *Ibid.* By inference from this rule, there is no longer any requirement that the answer in equity be made under oath. Pittsburgh Water Heater Co. v. Beler Water Heater Co., 222 Fed Rep. 950. "Undoubtedly the purpose of authorizing interrogatories was to enable the court to make a summary disposition of a cause by applying the law to an admitted state of facts." Bronk v. Scott Co., 211 Fed. Rep. 338; 128 C. C. A. 17.

84—Symonds v. Greene, 28 Fed. Rep. 834, 835; Moxie Nerve Food Co. v. Beach, 33 Fed. Rep. 248; Carmel Wine Co. v. Palestine Hebrew Wine Co., 161 Fed. Rep. 654.

85—Price Baking Powder Co. v. Fyfe, 45 Fed. Rep. 799.

86—Mr. Justice Day, in Deposit Bank v. Frankfort, 191 U. S. 510; 48 L. Ed. 279.

87—W. A. Gaines & Co. v. Rock Spring Distilling Co., 226 Fed. Rep. 531, 537; 141 C. C. A. 287.

of the trademark;[88] but it has been held that the dismissal of such a bill for want of prosecution, through the failure of the plaintiff to press the case, is not a bar to a later action against the successor in business of the original defendant.[89]

88—Browne v. Freeman, 12 W. R. 305.

89—Chapin-Sacks Mfg. Co. v. Hendler Creamery Co., 231 Fed. Rep. 550, 555.

CHAPTER XV.

COSTS.

§ 213. **Generally.**—In cases of unfair trade the same rules as to costs obtain as in other actions. The general rule is that costs follow the event. A successful plaintiff will be awarded costs,[1] and costs will be refused to one who is unsuccessful.[2]

So costs will be awarded to the successful plaintiff, even though he is denied damages,[3] and against an infant,[4] or a married woman having a separate estate.[5]

§ 214. **Avoiding costs by submission.**—We have had occasion elsewhere to refer to the rule laid down by Sir George Jessel, that the complainant in actions of the character now under consideration should not give notice to the infringer before suit;[6]

1—Coats v. Holbrook, 2 Sandf. Ch. 586; Cox, 20; Seb. 79; Pierce v. Frank, 15 L. J. Ch. 122; Seb. 81; Rodgers v. Nowill, 6 Hare, 325; Seb. 82; Burgess v. Hately, 26 Beav. 249; Seb. 169; Burgess v. Hills, 26 Beav. 244; 28 L. J. Ch. 356; Seb. 170; Collins Co. v. Walker, 7 W. R. 222; Seb. 171; Jurgenson v. Alexander, 24 How. Pr. 269; Cox, 298; Seb. 211; Edelsten v. Edelsten, 1 DeG. J. & S. 185; Seb. 213; McAndrews v. Bassett, 4 DeG. J. & S. 380; Seb. 234; Chubb v. Griffiths, 35 Beav. 127; Seb. 255; Field v. Lewis, Seton (4th Ed.), 237; Seb. 289; Weed v. Peterson, 12 Abb. Pr. N. S. 178; Seb. 387; Compagnie Laferme v. Hendrick, Seb. 512; Sawyer v. Kellogg, 9 Fed. Rep. 601; Cox, Manual, 682; McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828; Chappell v. Davidson, 2 K. & J. 123; Seb. 136; *In re* Kuhn & Co's Trademark, 53 L. J. Ch. 238. Costs "are always awarded to the successful side, unless there has been something in the conduct of the party which renders such a course inequitable and unjust to the losing side." Nixon, J., in Bunker v. Stevens, 26 Fed. Rep. 245-249.

2—Bass v. Dawber, 19 L. T. N. S. 626; Seb. 310; Appeal of the Putnam Nail Co., Cox, Manual, No. 725; Weener v. Brayton, 152 Mass. 101.

3—Weed v. Peterson, 13 Abb. Pr. N. S. 178; Seb. 387.

4—Chubb v. Griffiths, 35 Beav. 127; Seb. 255; Cory v. Gerteken, 2 Madd. 49; Woolf v. Woolf, 43 Sol. J. 127.

5—Nicholls v. Kimpton, 3 Times L. R. 674.

6—Upmann v. Forester, L. R. 24 Ch. D. 231.

and it has been held in this country that no demand or notice is necessary.[7] It is of the gravest importance to the practitioner to bear this rule in mind, whether he be for the plaintiff or defendant. A failure to observe it will oftentimes involve an innocent and injured client in the payment of costs which would otherwise fall upon the other party; for it is no defense to an assessment of costs against the defendant that no demand was made or notice served before suit.[8] A defendant who makes a full submission will not be mulcted in costs. Thus, a label manufacturer who had innocently made labels upon the order of a customer evaded costs by promising to desist from the manufacture, and offering to surrender the lithograph stone with which the work was done.[9] Lord Romilly, in a leading case in which the defendants were forwarding agents holding as bailee goods bearing a spurious mark, gave the doctrine this succinct expression: "It is his (the defendant's) duty at once to give all the information required, and to undertake that the goods shall not be removed or dealt with until the spurious brand has been removed, and to offer to give all facilities to the person injured for that purpose. If, after that, the person injured files a bill, though he will be entitled to all that he asks in the shape of relief, as he might have got it all without suit, he will not get from such defendant the costs of the suit, and he may have to pay them."[10]

This rule has been uniformly followed.[11] A defendant may make such an offer of submission, by answer or otherwise, at any stage of the proceedings, and so throw upon the plaintiff all costs subsequently accruing.[12]

7—Sawyer v. Kellogg, 9 Fed. Rep. 601.

8—*Ibid.*

9—Bass, Ratcliff & Gretton v. Guggenheimer, 69 Fed. Rep. 271.

10—Upmann v. Elkan, L. R. 12 Eq. 140; Seb. 369.

11—Millington v. Fox, 3 Myl. & Cr. 338; Seb. 63; Burnett v. Leuchars, 13 L. T. N. S. 495; Seb. 253; Wharton v. Thurber, Cox, Manual, 663; Nunn v. D'Albuquerque, 34 Beav. 595.

12—"If the defendant had offered the plaintiffs all they were entitled to, and after that the plaintiffs had proceeded in the suit, I most certainly should not have given the plaintiffs a penny of the costs incurred after that period; indeed, I should have endeavored to make them pay them." Lord Romilly in Burgess v. Hills, 26 Beav. 244; Seb. 170. And to the same effect see the opinion of the same Master of the Rolls in Moet v. Cous-

§ 215. Submission to avoid costs must be complete.—It is the necessary correlative of the rule stated in the preceding section that no submission can avail a defendant unless it is full, adequate and complete. Thus a submission, otherwise good, was rendered ineffective because the defendant did not couple with it an offer to pay all costs accrued.[13] An offer of submission on condition that each party pay his own costs was held ineffective.[14] Further adjudications in support of the general doctrine of this section will be found in the note.[15]

§ 216. Costs refused successful defendant.—There are a number of instances wherein a defendant against whom the plaintiff has been denied relief has been left to pay his own costs. These cases are not always predicated upon the defendant's absolute fraud, for, even where fraud could not be established, he may have been guilty of conduct so suspicious as to justify the imposition of his own costs.[16] Thus where the defendant had dealt in bitters, and assented to suggestions that they might be passed off on the public as the "Hostetter's Bitters" of the plaintiff, the court thought the facts did not warrant an injunction, but that the defendant had invited the litigation by his conduct and ought not to have his costs.[17]

In a case where a charge of unfair competition has been established, but relief denied the complainant because of fraudulent representations respecting its goods, the bill will be dismissed without costs.[18]

ton, 33 Beav. 578; Seb. 235; Cole v. Cole's Many-use Oil Co., 147 Fed. Rep. 930.

13—Hutchinson v. Blumberg, 51 Fed. Rep. 829; McAndrews v. Bassett, 4 DeG. J. & S. 380; Seb. 234; Burgess v. Hately, 26 Beav. 249; Seb. 169; Burgess v. Hills, 26 Beav. 244; Seb. 170; Collins Co. v. Walker, 7 W. R. 222; Seb. 171; Coats v. Holbrook, 2 Sandf. Ch. 586; Weed v. Peterson, 12 Abb. Pr. N. S. 178.

14—Moet v. Couston, 33 Beav. 578.

15—Tonge v. Ward, 21 L. T. N. S. 480; Seb. 321; Coats v. Holbrook, 2 Sandf. Ch. 586; Cox, 20; Seb. 79; Fennessy v. Day, 55 L. T. N. S. 161.

16—Talcott v. Moore, 6 Hun, 106; Seb. 478; Rose v. Loftus, 47 L. J. Ch. 576; Seb. 608. Thus, where both plaintiff and defendant made cigars falsely marked "Habana," the English court of appeal dismissed the bill without costs and adjudged the costs of the appeal against the defendant. Newman v. Pinto, 4 R. P. C. 508; 57 L. T. N. S. 31.

17—Hostetter v. Van Vorst, 62 Fed. Rep. 600.

18—Moxie Nerve Food Co. v. Modox Co. (3), 155 Fed. Rep. 304.

§ 217. Miscellaneous matters.—Innocent wharfingers in whose possession was found champagne bearing a false brand, and who were made parties defendant to an action but at once submitted to act as the court might direct, were awarded their costs, and given a lien for their warehouse charges, and that lien given priority over the plaintiff's claim for costs.[19]

Where the defendant is a retail dealer, who has acted innocently and handled only a small quantity of the infringing goods, a plaintiff may not be awarded costs even though the injunction issues.[20] Some courts apply this rule where it appears that the defendant's sales have not been large enough to justify the expense of taking an account.[21]

Where it appeared that the defendant had adopted plaintiff's trademark (which consisted of words understood by many simply to indicate quality), and did so in ignorance of the plaintiff's existence, the plaintiff was granted an injunction but without costs.[22] A plaintiff may be denied costs because of his delay in instituting suit.[23]

If in his bill the plaintiff makes specific charges against the defendant which he is unable to substantiate with proof, he may, under the English practice, obtain an injunction with costs,

19—Moet v. Pickering, L. R. 8 Ch. D. 372.

20—Thus where a small retailer was charged with infringing a cigarette trademark, and it was shown that the transaction related only to five hundred cigarettes, valued at 17s. 6d., which the defendant had bought in ignorance of the infringement, it was said: "I think that this is not the kind of action which ought to be encouraged. If the owner of a trademark finds that it is being pirated, surely it is not the small retailer who ought to be punished, but an endeavor ought to be made to prosecute those who place the spurious goods on the market; and although I agree that the plaintiffs are entitled to an injunction, yet I can not think it is the duty of the court in every case in which a small retail dealer who has innocently (and I think that the defendants in this case have acted innocently) happened to purchase a small quantity of the spurious goods, to say that he ought to be fixed with the costs of the action." Shilling, J., in American Tobacco Co. v. Guest, L. R. (1892) 1 Ch. D. 630-632.

21—Saxlehner v. Eisner & Mendelson Co., 88 Fed. Rep. 61-70.

22—Millington v. Fox, 3 Myl. & Cr. 338; Cox, Manual, 642.

23—Amoskeag Mfg. Co. v. Garner (2), 54 How. Pr. 298.

but be adjudged to pay all of the defendant's costs occasioned by the making of the unfounded charge.[24]

Where the infringement was not innocent, but the defendants offered to pay costs and publish any reasonable advertisements announcing that they had no connection with the plaintiffs, it was held that by ignoring this offer the plaintiffs had lost their right to relief, and the action was dismissed. It is doubtful if this decision would be given much consideration by an American court.[25]

One who procures the preparation of an article bearing an infringement of another's trademark will be liable to refund to the manufacturer such reasonable sum as he may pay to the owner of the trademark in compromise of an action for the infringement, together with the costs of such action.[26]

In regard to appeals, the same general rules as to costs obtain as are applied by the inferior courts. Thus on an appeal from a committal for contempt, based on the violation of an injunction in a trademark case, the upper court sustained the ruling of the lower, but, because the violation seemed open to disputes, gave no costs of the appeal.[27]

In the leading case of *McLean v. Fleming* the defendant appealed from a decree awarding the plaintiff an injunction and accounting. The supreme court reversed the decree as to the accounting, on the ground that the plaintiff was guilty of laches, but let the decree of injunction stand. It then gave plaintiff his costs in the lower court, and the defendant the costs of the appeal.[28]

The costs of an unsuccessful motion to commit for contempt will be taxed against the moving party.[29] The costs of contempt proceedings can be taxed against defendant only where, upon the facts, he might have been committed.[30] While it would seem the better practice to make no order as to costs

24—Saxlehner v. Apollinaris Co., L. R. (1897) 1 Ch. 893.

25—Valentine v. Valentine, 31 L. R. Ir. 488.

26—Dixon v. Fawcus, 3 Ell. & Ell. 537.

27—Devlin v. Devlin, 69 N. Y. 212.

28—McLean v. Fleming, 96 U. S. 245; 24 L. Ed. 828.

29—Hennessy v. Budde, 82 Fed. Rep. 541.

30—Dence v. Brand, W. N. 1881, p. 31.

upon the entry of interlocutory decrees, and to withhold such order until the entry of final decree upon the master's report, we find very respectable authority for the contrary practice.[31]

In a case where, although the injunction is granted, the defendant is found to have acted without fraudulent intent, so that the case appears to be "one of honest trade differences," no costs should be allowed to either party.[32]

A party who prevails to a substantial extent upon the merits may be awarded the full costs of the appellate court.[33]

31—The Collins Co. v. Oliver Ames & Son Corporation, 18 Fed. Rep. 561-571. "Courts of equity, having a large discretion in matters of costs, frequently give costs in intermediate stages of a cause, without waiting for the final decree." Dick, J., in Avery v. Wilson, 20 Fed. Rep. 856-859.

32—Champion Spark Plug Co. v. A. R. Mosler & Co., 233 Fed. Rep. 112, 117.

33—Knabe Bros. Co. v. American Piano Co., 232 Fed. Rep. 140 (C. C. A. 6).

APPENDIX

CONTENTS OF APPENDIX

A. Trademark Act of July 8, 1870. Annotated.
B. Label Registration Act of June 18, 1874. Annotated. Patent Office Rules, and Forms relative thereto.
C. Trademark Act of August 14, 1876. Annotated.
D. Trademark Act of March 3, 1881. Annotated.
E. Trademark Act of February 20, 1905. Annotated. Patent Office Rules, and Forms relative thereto.
F. Trademark Statutes of the States and Territories. Annotated. With Forms for Registration Applications.
G. Canadian Trademark and Design Act, with Rules and Forms.
H. Bills of Complaint and Answers. Judicially Approved.
I. Forms of Injunction—Interlocutory and Final Decrees.
J. Classification of Registered Trademarks.
K. International Convention of March 20, 1883.
L. Trademark Provision of an Act incorporating the American National Red Cross.
M. Federal Trade Commission Act; Rules of the Commission.
N. False Stamping. Act of June 13, 1906, Ch. 3289, 34 Stat. L. 260.

APPENDIX A.

ACT OF CONGRESS OF JULY 8, 1870.[1]

SECTION 77.[2] And be it further enacted, that any person or firm domiciled in the United States, and any corporation creat-

1—Although this act is no longer in force, having been held unconstitutional, and the Acts of 1881 and 1905 having been since enacted, it is thought advisable to set forth the earlier act, in order that the decisions under it may be understood. In Leidersdorf v. Flint (1), 8 Biss, 327, the validity of the Act of 1870 was questioned by the United States Circuit Court, on the ground that the constitution of the United States did not authorize legislation by congress on the subject of trademarks, except such as had been actually used in commerce with foreign nations and among the several states, or with the Indian tribes; and in Trademark Cases, 100 U. S. 82, the act was formally declared by the supreme court to be on this ground unconstitutional and invalid. But this does not entitle persons having marks registered under the invalid act to recover back the fees paid by them (Woodman v. United States, 15 Ct. of Cl. 541), though they will be credited with such fees when applying for registration under the new act. See Act of 1881, § 6. *infra*. Nor does the invalidity of the act justify the disregard of injunctions granted under the general jurisdiction of the court. United States v. Roche, 1 McCrary, 385. And it has been held that registration of a mark under the invalid act, even without re-registration under the Act of 1881, is sufficient to prevent registration of a similar mark under the new Act of 1881. *Ex parte* Lyon, Dupuy & Co., 28 Off. Gaz. 191. Since the passing of the Act of 1870, it has been considered in the Patent Office that while, on the one hand, the benefits of registration as trademarks were to be reserved for trademarks, and for trademarks only (*e. g.*, *In re* Parker, 13 Off. Gaz. 323, registration as a trademark was refused to that which could at most amount to a design), so, on the other hand, it was only by registering them as trademarks, and not by patenting them as designs (*Ex parte* King, Comm. Decis. 1870, p. 109; *In re* Whyte, *Id.* 1871, p. 304), or registering them as labels (*In re* Godillot, 6 Off. Gaz. 641; *In re* Simpson & Sons, 10 *Id.* 333; *Ex parte* Davids & Co., 16 *Id.* 94; *Ex parte* Schumacher & Ettlinger (1), 19 *Id.* 791), that the benefits of

2—See Act of 1881, secs. 1, 2.

ed by the authority of the United States, or of any state or territory thereof, and any person, firm or corporation resident of or located in any foreign country which by treaty or convention affords similar privileges to the citizens of the United States, and who are entitled to the exclusive use[3] of any lawful trademark, or who intend to adopt and use any trademark,[4] for exclusive use within the United States, may obtain protection for such lawful

the statute could be obtained for trademarks. Descriptive words not registerable as trademarks were properly allowed to be registered as labels. *Ex parte* Waeferling, 16 *Id.* 746; *Ex parte* Brigham, 20 *Id.* 891; *Ex parte* Lutz, 33 *Id.* 1389; and see *In re* Park, 12 *Id.* 2, in which it was sought to register as part of a label a device for which the applicant had previously sought registration as a trademark. In United States v. Marble, 22 *Id.* 1366, however, the Supreme Court of the District of Columbia held that the Commissioner of Patents had no authority to refuse registration to a label merely on the ground that it might have been registered as a trademark; but in the later case of *Ex parte* Schumacher & Ettlinger (2), 22 *Id.* 1291, the commissioner again refused registration as labels to what he considered to be trademarks; and in *Ex parte* Moodie, 28 *Id.* 1271, and *Ex parte* Wiesel, 36 *Id.* 689, the commissioner repeated this decision, and his course was in the former case upheld on appeal by the Supreme Court of the District of Columbia in *Ex parte* Moodie, 28 *Id.* 1271. The federal courts have also held that a trademark must be registered as such, and not copyrighted as a label. Schumacher & Ettlinger v. Wogram, 35 Fed. Rep. 210. It is for the commissioner to decide whether what is presented to him is a trademark or label. *Ex parte* Moodie, 28 Off. Cas. 1271.

3—In McElwee v. Blackwell, 15 Off. Gaz. 658, it was held that although where registration had been wrongfully granted to one, it might subsequently be properly granted to another who was really entitled to the exclusive use, yet it would not be granted to another who was not entitled to the exclusive use, even though he might be entitled to use the mark to some extent. And see Wright v. Simpson, 15 *Id.* 968; also Sorg v. Welsh, 16 *Id.* 910, as to admissions of right in another; and Yale Cigar Manufacturing Co. v. Yale, 30 *Id.* 1183. Under the Act of 1881 registration will be refused where it appears that the applicant is only one of several who have a right to use the mark. *Ex parte* Langdon, 61 Off. Gaz. 286.

4—Under these words a new trademark might be registered prior to any actual use. *In re* Rothschild, 7 Off. Gaz. 220; and see Hoosier Drill Co. v. Ingels, 14 *Id.* 785. This is not the case under the Act of 1881. See secs. 1 and 2, notes, and *Ex parte* Strasburger & Co., 20 Off. Gaz. 155.

trademark[5] by complying with the following requirements,[6] to-wit:

First. By causing to be recorded in the Patent Office,[7] the names of the parties and their residence and place of business,[8] who desire the protection of the trademark.

Second. The class of merchandise[9] and the particular description of goods[10] comprised in such class, by which the trademark has been or is intended to be appropriated.

5—As to what is a lawful trademark, see *infra*, § 79. Registration can not make lawful trademark out of that which does not contain the necessary elements (Moorman v. Hoge, 2 Sawy. 78; Schumacher & Ettlinger v. Schwenke (2), 36 Off. Gaz. 457); but by sec. 7 of the Act of 1881 registration is *prima facie* evidence of ownership. It has been doubted whether the use of a registered trademark can be restrained (Decker v. Decker, 52 How. Pr. 218); but in Glen Cove Manufacturing Co. v. Ludeman, 23 Blatchf. 46, an injunction was granted in such a case. See also Schumacher & Ettlinger v. Schwenke (2), 36 Off. Gaz. 457. Separate registration must be obtained for each mark which differs from another by the addition of a symbol: *e. g.*, "X," "XX," "XXX," were held to require separate registration. *In re* English, Comm. Decis. 1870, 142; and see *In re* Eagle Pencil Co., 10 Off. Gaz. 981.

6—Absolute compliance with these requirements is necessary on the part of applicants. *In re* Hankinson, 8 Off. Gaz. 89. But it is not necessary that the very words of the act should be cited, so long as the spirit of it is satisfied. *In re* Vidvard & Sheehan, 8 *Id.* 143.

7—In Lacroix v. Escobal, 37 La. Ann. 533, it was held that a French citizen, who had not deposited his mark in the United States patent office, as required by the Convention of 1869 between the United States and France, was not entitled to maintain an action for infringement. But see Société, etc. de la Benedictine v. Micalovitch, 36 Alb. L. J. 364.

8—The registration of the name of a firm has been held to be sufficient, without giving the particulars as to each of the partners. Smith v. Reynolds (2), 3 Off. Gaz. 213; 10 Blatchf. 100.

9—This requirement has been interpreted to exclude from registration the marks of persons other than manufacturers or merchants: *e. g.*, a carpet cleaner. *In re* Hankinson, 8 Off. Gaz. 89.

10—It has been held that a description of the class and goods as "paints" is sufficient (Smith v. Reynolds (2), 10 Blatchf. 100), and so with "alcoholic spirits" (*In re* Boehm & Co., 8 Off. Gaz. 319); but that "fancy goods" is insufficient, as being too general a term. *In re* Lisner, 13 *Id.* 455. Different persons may register the same trademark for different descriptions of goods even in the same class. Sorg v. Welsh, 16 *Id.* 910. In Smith v. Reynolds (2), 10 Blatchf. 100, and s. c. (3), 3 *Id.* 213, it was held that a firm which

Third. A description of the trademark itself [11] with *fac-similes* thereof [12] and the mode in which it has been or is intended to be applied and used. [13]

Fourth. The length of time, if any, during which the trademark has been used. [14]

Fifth. The payment of a fee of twenty-five dollars, in the same manner and for the same purpose as the fee required for patents [15]

Sixth. The compliance with such regulations as may be prescribed by the Commissioner of Patents. [16]

Seventh. The filing of a declaration, [17] under the oath of the person or of some member of the firm or officer of the corporation, to the effect that the party claiming protection for the trademark has the right to the use of the same, and that no other person, firm or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as might be calcu-

had registered a trademark for "paints" was not entitled to restrain the use of the mark on white lead by another firm which had used the mark on that variety of paint before the plaintiffs had used or registered their mark; and in the former case it was held that the registration being bad as to white lead was bad *in toto*, though but for that it might have been good.

11—The trademark must be sufficiently described for it to be possible to clearly distinguish between the essential and non-essential elements. *In re* Volta Belt Co., 8 Off. Gaz. 144.

12—The *fac-simile* limits the verbal description of the mark. Duke v. Green, 16 Off. Gaz. 1094.

13—The previous user of the applicants or their derivative title must be stated. *Ex parte* Consolidated Fruit Jar Co., 16 Off. Gaz. 679. Only one example of the mode of use will be admitted. *In re* Kimball, 11 *Id.* 1109. And see Smith v. Reynolds (2), 10 Blatchf. 100.

14—See *Ex parte* Consolidated Fruit Jar Co., 16 Off. Gaz. 679.

15—A fee paid can only be recovered when it was paid by actual mistake: *e. g.*, a payment in excess, or one not required by law When, therefore, an application has failed because the proposed mark was not registrable, the fee paid can not be recovered, although a renewed application for the registration of an essentially different mark has proved successful. *In re* Block & Co., 14 Off. Gaz. 235. See note 1, p. 501, *supra*, as to crediting fees paid under this invalid act.

16—See § 81, *infra*, and note thereto.

17—As to the necessity for the filing of this declaration, and for the production of sufficient evidence of it, on a trial for infringement, see Smith v. Reynolds (1), 10 Blatchf. 85, where an injunction was refused on the ground of the deficiency of such evidence.

lated to deceive,[18] and that the description and *fac-similes* presented for record are true copies of the trademark sought to be protected.

SECTION 78.[19] And be it further enacted, that such trademark shall remain in force for thirty years from the date of such registration, except in cases where such trademark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of any foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act, at the same time that it becomes of no effect elsewhere, and during the period that it remains in force it shall entitle the person, firm, or corporation registering the same to the exclusive use thereof so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other person shall lawfully use the same trademark, or substantially the same, or so nearly resembling it as to be calculated to deceive, upon substantially the same description of goods.[20] Provided that six months prior to the expiration of the said term of thirty years, application may be made for a renewal of such registration, under regulations to be prescribed by the Commissioner of Patents, and the fee for such renewal shall be the same as for the original registration, certificate of such renewal shall be issued in the same manner as for the original registration, and such trademark shall remain in force for further term of thirty years; and provided further, that nothing in this section shall be construed by any court as abridging or in any manner affecting unfavorably the claim of any person, firm, corporation, or company to any trademark after the expiration of the term for which such trademark was registered.

18—A declaration that no other person, firm or corporation has a right to the use of the same, or substantially the same, mark, is a sufficient compliance with this requirement. *In re* Vidvard & Sheehan, 8 Off. Gaz. 143.

19—See Act of 1881, secs. 5, 7, 11.

20—An illegal registration by a part owner not entitled to exclusive use, was held not to justify issuing another certificate to another part owner of the same mark, in order to put him on an equal footing in court. McElwee v. Blackwell, 15 Off. Gaz. 658. In an interference, the applicant was granted registration as against a prior registrant whose user had been experimental and interrupted. Sternberger v. Thalheimer, 3 Off. Gaz. 120.

SECTION 79. [21]And be it further enacted, that any person or corporation who shall reproduce, copy, counterfeit, or imitate any such recorded trademark, and affix the same to goods of substantially the same description, properties and qualities as those referred to in the registration,[22] shall be liable to an action on the case for damages for such unlawful use of such trademark at the suit of the owner thereof in any court of competent jurisdiction in the United States, and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of his trademark and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful use.[23] The Commissioner of Patents [24] shall not receive and record any proposed trademark which is not and can not become a lawful trademark,[25] or which is merely the name of a person, firm, or cor-

21—See Act of 1881, secs. 3, 7.

22—See Osgood v. Rockwood, 11 Blatchf. 310; Fed. Cas. No. 10605, where it was held that persons who had registered a trademark for prints made according to a patented process were not entitled under this act to an injunction against a person who had used the mark on prints not made in accordance with the patent.

23—The United States circuit courts had jurisdiction under this act in cases of infringement of trademark, even when both parties were citizens of the same state. Duwel v. Bohmer, 14 Off. Gaz. 270; but see secs. 7 and 11 of the Act of 1881.

24—The validity of the decisions of the acting commissioner was upheld in Simpson v. Wright (2), 15 Off. Gaz. 293.

25—The question what may be registered as being a "lawful trademark" has been considered in many cases. The device of a crown is a good trademark. Smith v. Reynolds (2), 10 Blatchf. 100. The arms of one of the states could not be registered as a trademark. *Ex parte* Davids & Co., 16 Off. Gaz. 94. And it has been held that the same is the case with the Freemasons' square and compass, Re Tolle, 2 *Id.* 415; and the word "Masonic," *Ex parte* Smith (3), 16 *Id.* 764. *In re* Thomas, 14 *Id.* 821, the Freemasons' symbols were allowed to be registered in combination, and *In re* Tolle, *supra*, was overruled. In *Ex parte* King (2), 46 *Id.* 119, the decision *In re* Thomas, 14 *Id.* 821, was followed, and the design of the badge adopted by the Grand Army of the Republic was allowed to be registered as a trademark for writing paper by a person who had no connection with that society, and it was said that, that society not having used their badge as a mark on writing paper, they would be infringing the applicant's rights if they were to begin to do so. The words "Knights of Labor" were refused registration as a mark for whisky on this ground and because deceptive. *Ex parte* Bloch & Co., 40 Off. Gaz. 443. A word which has be-

come common, *e. g.*, "Calhoun" plow, can not be registered. *In re* Hall & Co., 13 *Id.* 229. Registration has been refused to the following words and expressions, on the ground of descriptiveness: "Beeswax oil," *In re* Hauthaway (1), Comm. Decis. 1871, 97; s. c. (2), *Id.* 284; "Razor Steel," *In re* Roberts (4), *Id.* 100; "Invisible" face powder, *Ex parte* Palmer, *Id.* 289; "A. Richardson's Patent Union Leather Splitting Machine," *In re* Richardson, 3 Off. Gaz. 120; "Fuer Familien-Gebrauch," and "Lawrence Feiner Familien-Flannel", *In re* Lawrence, 10 *Id.* 163; "Iron Stone" drain pipes, *In re* Rader & Co., Comm. Decis. 1878, 67; "Croup Tincture," *In re* Roach, 10 Off. Gaz. 333; "Crack-proof" India rubber, *In re* Goodyear Rubber Co., 11 *Id.* 1062; "Evaporated" articles of food, *Ex parte* Alden, 15 *Id.* 389; "Standard A" cigars, *Ex parte* Cohn (1), 16 *Id.* 680; "Druggists' Sundries," *Ex parte* Cohn (2), 16 *Id.* 680; "Safety" powder, *Ex parte* Safety Powder Co., 16 *Id.* 136; "Medicated Prunes," *Ex parte* Smith (2), 16 *Id.* 679; "Satin Polish," shoe polish, *In re* Brigham, Comm. Decis. 1881, 38; "Swing" scythe sockets, *Ex parte* Thompson, Derby & Co., 16 Off. Gaz. 137; "Granulated Dirt Killer" soap, *Ex parte* Waeferling, 16 *Id.* 764; "Famous," merchandise generally, *In re* Brand Stove Co., 62 Off. Gaz. 588; and "Splendid" flour. *Ex parte* Stokes, 64 Off. Gaz. 437. And the same has been the case with respect to the figure of a fish for fishing lines, *In re* Pratt & Farmer, 10 *Id.* 866; and the representation of a twig with three leaves and a plum, for prunes, *Ex parte* Smith (2), 16 *Id.* 679; and see Popham v. Wilcox, 66 N. Y. 69. On the other hand, "The Blanchard Churn," *In re* Porter Blanchard's Sons, Comm. Decis. 1871, 97; "Beaverine" boots and shoes, *In re* Francis & Mallon, *Id.* 283; and "Dr. Lobenthal's Essentia Antiphthisica," *In re* Rohland, 10 Off. Gaz. 980, have been admitted to registration as being non-descriptive. In a series of cases registration has been refused on the ground that the term claimed, if properly applicable to the goods with respect to which it was used, was descriptive, but if not, was deceptive: *e. g.*, "Bromo-Quinine," *In re* Grove 67 Off. Gaz. 1447; "American Sardines," *In re* American Sardine Co., 3 *Id.* 495; "Egg Macaroni," *In re* Bole Bros., 12 *Id.* 939; "Cachemire Milano," *In re* Warburg & Co., 13 *Id.* 44; "French Paints," *Ex parte* Marsching & Co., 15 *Id.* 294; "London" animal foods, *Ex parte* Knapp, 16 *Id.* 318; but see *In re* Green, 8 *Id.* 729, where registration was granted to "German Syrup." On the latter ground of deceptiveness, the word "patent" can not be registered as a part of a mark for an article made under an expired patent. *In re* Richardson, 3 *Id.* 120. A geographical name is not usually registrable. Armistead v. Blackwell, 1 *Id.* 603, "Durham" tobacco; *In re* Tolle, 2 *Id.* 415, "Cherry Street Mills," and "Market Street Mills;" *Ex parte* Knapp, 16 *Id.* 318, "London" animal foods; *Ex parte* Marsching & Co., 15 *Id.* 294, "French Paints;" *Ex parte* Farnum & Co., 18 *Id.* 412, "Lancaster" goods. But such a name may be registered when arbitrarily selected. *In re* Cornwall (2), 12 *Id.* 312,

"Dublin" soap. Similarly, numerals may be registered when arbitrarily selected. Kinney v. Allen, 1 Hughes, 106; *Ex parte* Dawes & Fanning, 1 Off. Gaz. 27; American Solid Leather Button Co. v. Anthony, 15 R. I. 338. But not otherwise, *In re* Eagle Pencil Co., 10 Off. Gaz. 91. It has been held that a peculiarity in the form of a barrel is not registrable as a trademark, Moorman v. Hoge, 2 Sawy. 78; nor a representation of such barrel when applied to the goods contained in it, *Ex parte* Halliday Bros., 16 Off. Gaz. 500; nor is a special kind of barrel-hoop registrable. *In re* Kane & Co., 9 *Id.* 105. But see Cook v. Starkweather, 13 Abb. Pr. N. S. 392. A special collar box was held not to constitute a trademark, Carrington v. Libby, 14 Blatchf. 128; and a sampler pattern was refused registration, *In re* Parker, 13 Off. Gaz. 323; and a strip of tobacco intended to be wrapped around the mouthpiece of cigarettes, on the ground that it was intended to serve purposes of convenience rather than of identification, *In re* Gordon, 12 *Id.* 517; and the use of a tin tag or ticket on the goods, irrespective of shape and design, is no trademark, Lorillard v. Pride, 28 Fed. Rep. 434; though a tin tag of special shape, size and color may be, Lorillard v. Wight, 15 Fed. Rep. 383. There is no trademark in the shape of a plug of tobacco, Liggett & Myers Tobacco Co. v. Hymes, 20 Fed. Rep. 883; or of a box, Sawyer v. Horn, 4 Hughes, 239; Ball v. Siegel, 116 Ill. 137; or of sticks of chewing gum. Adams v. Heisel, 31 Fed. Rep. 279; or of the frame of a sewing machine originally made under a patent, Wilcox & Gibbs Sewing Machine Co. v. Gibbons' Frame, 21 Blatchf. 431; Brill v. Singer Manufacturing Co., 41 Ohio St. 127; nor in a manner of arranging in boxes cakes of soap wrapped in differently colored paper wrappers, Davis v. Davis, 27 Fed. Rep. 490; nor in a *nom de plume*, Clemens v. Belford, 11 Biss. 459. But registration has been granted to a peculiarly shaped stick intended to be so placed in a roll of carpet as to show an octagonal ring at each end, Lowell Manufacturing Co. v. Larned, Fed. Cas. No. 8570. Registration can not be granted to minor and non-essential features in a compound mark. *Ex parte* Coats, 16 Off. Gaz. 544. Occasionally a mark has been allowed to be registered in alternative forms, *e. g.*, "The Star Shirt," the same words with the figure of a star, and "The * Shirt," Morrison v. Case, 9 Blatchf. 548; the figure of a lion, the word "Lion," or both, *In re* Weaver, 10 Off. Gaz. 1; and see *In re* Park, 12 *Id.* 2; *In re* Thomas, 14 *Id.* 821; *Ex parte* Peper, 16 *Id.* 678. A bad trademark does not become a good one by the addition of unobjectionable elements, *In re* Blakeslee & Co., Comm. Decis. 1871, 284, "Cundurango Ointment Co.;" *In re* Dick & Co. 9 Off. Gaz. 538, "D. D. & Co. tasteless" drugs; *In re* Rader & Co., 13 *Id.* 596, "Iron Stone" in an oval border. But it appears to be possible for two marks, which separately are not good trademarks, to form one in combination. *Ex parte* Davids & Co., 16 *Id.* 94. A trademark can not be registered for the purpose of being used by all the members of an association on

poration only,[26] unaccompanied by a mark sufficient to distinguish it from the same name where used by other persons, or which is identical with the trademark appropriated to the same class of merchandise and belonging to a different owner and already registered or received for registration, or which so nearly resembles such last mentioned trademark as to be likely to deceive the public.[27] Provided, that this section shall not prevent the

goods of any quality, nor can a mark which is intended to be used in furthering a scheme for the restraint of trade, *Ex parte* Cigar Makers' Association, 16 *Id.* 958; and in Schneider v. Williams, 44 N. J. Eq. 391, the court refused to protect such a mark at the instance of a member of the association. In Strasser v. Moonelis, 108 N. Y. 611; People v. Fisher, 57 N. Y. Sup. Ct. 552; Allen v. McCarthy, 37 Minn. 347; and Bloete v. Simon, 49 Abb. N. C. 88, however, a different view was taken of the propriety of such a mark. It seems that the decision of a competent court as to the validity of a mark is binding upon the patent office. *In re* India-rubber Comb Co., 8 Off. Gaz. 905. If an application is refused on the ground that the proposed mark is not registrable, a renewed application for the registration of a mark not open to objection must be treated as a new application, and it can not be treated as an amendment of the original application, nor can the fee originally paid be returned. *In re* Block & Co., 14 *Id.* 235.

26—Thus, *In re* Rowe & Post, 9 Off. Gaz. 496, the name "The New York Cutlery Co." was refused registration as a new mark. As to the registration of names as old marks, see *In re* Porter Blanchard's Sons, Comm. Decis. 1871, 97; *In re* Roberts (1), *Id.* 113; s. c. (2), *Id.* 100; s. c. (3), *Id.* 101; *In re* India-rubber Comb Co., 8 Off. Gaz. 905; *In re* Consolidated Fruit Jar Co., 14 *Id.* 269; *Ex parte* Davids & Co., 16 *Id.* 94; *In re* Creedmore Cartridge Co., 56 *Id.* 1333. The prohibition does not extend to the registration of the name of a person other than the applicant, and such names may be registered, at all events with their owners' consent, if living. *Ex parte* Sullivan & Burke, 16 *Id.* 765; *Ex parte* Pace, Talbott & Co., 16 *Id.* 909.

27—Thus, *In re* American Lubricating Oil Co., 9 Off. Gaz. 687, registration was refused to the word "Star" as a trademark on oil, the device of a star having already been registered for the same article; so *In re* Coggin, Kidder & Co., 11 *Id.* 1109, to a device in which the principal feature was the name "Haxall," which had long been the trademark of another firm; so *In re* Bush & Co., 10 *Id.* 164, to a combination mark consisting of the applicant's own registered trademark and two other devices appropriated by other firms; so in *Ex parte* Claire, 15 *Id.* 248, to the words "Black Swan," the word "Swan" being already registered; so in *Ex parte* Smith (1), 16 *Id.* 679, to "A. S. California Family * Soap," "California" and "*" being already separately on

registry of any lawful trademark rightfully used at the time of the passage of this act.[28]

SECTION 80.[29] And be it further enacted, that the time of the receipt of any trademark at the Patent Office for registration shall be noted and recorded and copies of the trademark and of the date of the receipt thereof, and of the statement filed therewith, under the seal of the Patent Office, certified by the commissioner, shall be evidence in any suit in which such trademark shall be brought into controversy.

SECTION 81.[30] And be it further enacted, that the Commissioner of Patents is authorized to make rules and regulations[31] and to

the register; and see *Ex parte* Weisert Bros., 16 *Id.* 680. On the other hand, *In re* Imbs, 10 *Id.* 463, registration was granted, notwithstanding that two other marks contained somewhat similar features; and *In re* Cornwall (1), 12 *Id.* 138, a device of a star and a crescent was registered, although a star had previously been registered.

28—Under this proviso registration was granted to a name used as a trademark before 1870, *e. g.*, "The India-rubber Comb Co. of New York," *In re* India Rubber Comb Co., 8 Off. Gaz. 905; "The Rubber Clothing Co." *In re* Rubber Clothing Co., 10 *Id.* 111. See *In re* Dole Bros., 12 *Id.* 939; *In re* Consolidated Fruit Jar Co., 14 *Id.* 369; *Ex parte* Consolidated Fruit Jar Co., 16 *Id.* 679. This saving proviso is, however, omitted from the Act of 1881, so that the prohibition as to names, etc., is universal. See Act of 1881, sec. 3, and *Ex parte* Fairchild, 21 Off. Gaz. 789, in which case registration was refused to a name which had been used as a trademark for twenty years, and had been registered under the Act of 1870.

29—See Act of 1881, secs, 3, 4.

30—See Act of 1881, sec. 12.

31—It was formerly decided that the authority given to the commissioner by section 81 to make regulations empowered him to declare an interference in a trademark case, for the purpose of deciding a question of title to the trademark, on the analogy of the practice in patent cases. Lantz Bros. & Co. v. Schultz & Co., 9 Off. Gaz. 791; Duke v. Green, 16 *Id.* 1094. And though it was thought in Swift v. Peters, 11 *Id.* 1110, that the question whether a registered proprietor of a mark was entitled to the exclusive use of it against an ex-partner was a question for a court of law, and not for the office, it was held in Hoosier Drill Co. v. Ingels, 14 *Id.* 785, that, in investigating the title of the mark, all matters relating to the ownership should be gone into; and in Hanford v. Wescott, 16 *Id.* 1181, Fed. Cas. No. 6022, it was held that a decision of the examiner of interferences, unappealed from, was conclusive as to the right to a mark; and see Josselyn v. Swezey & Dart, 15 Off. Gaz. 702, as to reopening the evidence taken on an

prescribe forms for the transfer of the right to use such trademarks, conforming as nearly as practicable to the requirements of the law respecting the transfer and transmission of copyrights.

SECTION 82.[32] And be it further enacted, that any person who shall procure the registry of any trademark, or of himself as the owner thereof, or an entry respecting a trademark, in the Patent Office under this act, by making any false or fraudulent representations or declaration verbally or in writing, or by any fraudulent means, shall be liable to pay damages in consequence of any such registry or entry to the person injured thereby, to be recovered in an action on the case in any court of competent jurisdiction within the United States.

SECTION 83.[33] And be it further enacted, that nothing in this act shall prevent, lessen, impeach or avoid, any remedy at law or in equity which any party aggrieved by any wrongful use of any trademark might have had if this act had not been passed.[34]

SECTION 84.[35] And be it further enacted, that no action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trademark which is used or claimed

interference, and Simpson v. Wright (1), 15 *Id.* 248, and s. c. (2), 15 *Id.* 293, as to rehearing an interference. After the case of United States v. Steffens, 100 U. S. 82, 25 L. Ed. 550, it was held that the Patent Office has no longer any authority to decide questions of disputed titles to trademarks, or to declare interferences in such cases. Braun & Co. v. Blackwell, 19 Off. Gaz. 481; and see *Ex parte* Strasburger & Co., 20 *Id.* 155, and Jacoby & Co. v. Lopez & Co., 23 *Id.* 342. And in Yale Cigar Mfg. Co. v. Yale, 30 *Id.* 1183, it was decided that a declaration of interference is authorized by section 3 of the Act of 1881. In such cases the only duty of the office is to decide whether the opponent has or has not a better title than the applicant, not to decide any further question. *Ibid.* If, on an interference between an applicant and a registered owner with respect to the same mark, the right to registration is adjudged to the applicant, notwithstanding the opposition of the registered owner, the result is, while strictly giving the applicant merely the right to register, practically to displace the registered owner, though his mark is not removed from the register. *Ibid.* For the present rule as to interferences see note 7 to sec. 3 of the Act of 1881; and see sec. 7, Act of 1905.

32—See Act of 1881, sec. 9.

33—See Act of 1881, sec. 10.

34—See Osgood v. Rockwood, 11 Blatchf. 310; Fed. Cas. No. 10605; United States v. Roche, 1 McCreary, 385; Fed. Cas. No. 16180.

35—See Act of 1881, sec. 8.

in any unlawful business or upon any article which is injurious in itself, or upon any trademark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.[36]

36—It seems that this act provided no means for removing from registration a mark which was wrongfully registered, *e. g.*, a mark which did not contain any of the essential particulars. See Armistead v. Blackwell, 1 Off. Gaz. 603; McElwee v. Blackwell, 15 *Id.* 658; Wright v. Simpson, 15 *Id.* 968; Yale Cigar Mfg. Co. v. Yale, 30 *Id* 1183.

APPENDIX B

LABEL ACT OF JUNE 18, 1874.

(18 Statutes at Large, 78.)

An act to amend the law relating to patents, trademarks and copyrights.

SECTION 3. That in the construction of this act the words "engraving," "cut" and "print" shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label not a trademark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the Commissioner of Patents, to the party entering the same.[1]

1—This law can be sustained only under the constitutional delegation of authority to congress to legislate upon copyrights.

The provision quoted has reference only to such writings as are the result of intellectual labor and are founded in the creative powers of the mind.

"It does not have any reference to labels which simply designate or describe the articles to which they are attached, and which have no value separated from the articles, and no possible influence upon science or the useful arts." Mr. Justice Field in Higgins v. Keuffel, 140 U. S. 428, 35 L. Ed. 470.

No action at law or in equity can be maintained for the infringement of a label so registered (copyrighted) unless the provision of the copyright law in regard to the notice has been complied with, *i. e.*, "by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words, viz.: 'Entered according to Act of Congress, in the year ———, by A. B., in the office of the Librarian of Congress, at Washington;' or (at the option of the registrant) the word 'Copyright,' together with the year the copyright was entered, and the name of the party by

whom it was taken out;" thus, "Copyright, 18——, by A. B." Higgins v. Keuffel, 140 U. S. 428, 35 L. Ed. 470.

It is manifest that under this decision the act affords no protection to labels, and registration under it is idle. Luby, Patent Office Practice, p. 121. But until there is a decision declaring the law unconstitutional the Patent Office is open for this class of registration. *Ex parte* H. J. Heinz Co., 62 Off. Gaz. 1064. It is held, however, that a label will not be admitted to registry unless it has the same degree of artistic excellence as would entitle it to copyright in the office of the Librarian of Congress. *Ex parte* Palmer, 58 Off. Gaz. 383. And labels containing or consisting of matter constituting trademarks will not be registered until such trademark matter has been registered as trademark. *Ex parte* Diamond Laboratory Co., 44 MSS. Dec. 19; *Ex parte* Ruckstuhl, 56 Off. Gaz. 927. A label bearing the name and address of the owner, the name of the article to which it is applied, with the price and directions for use, exhibiting no attempt at artistic or literary merit, will not be registered. *Ex parte* Eldredge Co., 55 Off. Gaz. 1278. The same ruling has been made as to a label purely descriptive of the articles to which it is intended to be applied. *Ex parte* C. G. Hainline & Co., 58 Off. Gaz. 947.

Prints and labels defined.—"Registered labels or prints and trademarks are recognized by the terms of the law and decisions of the courts as applicable only to some kind of merchandise: labels, as giving the names of the manufacturers, place of manufacture, nature or quality of goods, directions for use, and the like." Doolittle, Assistant Commissioner, in *Ex parte* Parker, 13 Off. Gaz. 323.

Long prior to the decision of Higgins v. Keuffel, 140 U. S. 428, 35 L. Ed. 470 (*supra*), Judge Blatchford had held that this section was purely a copyrighted act, and that under the general copyright regulation of congress (sec. 4956, R. S.) no person could claim protection for a label so registered unless "before publication" he had deposited a printed copy of the title of the article in respect of which the copyright was claimed, in the Patent Office. Marsh v. Warren, 14 Blatchf. 263; 14 Off. Gaz. 678; Fed. Cas. No. 9121; 16 Fed. Cas 821.

It has been held that the mere fact that words or designs which appear upon the label might be used as trademarks does not prevent registration under this act. *Ex parte* Orcutt & Son, 8 Off. Gaz. 276; and in another early case the applicant's label was admitted to registry, but certain "arbitrary words" and "fanciful figures" were first refused or stricken out of the label, and the commissioner suggested that they should be registered as trademarks. *Ex parte* W. Simpson & Sons, 10 Off. Gaz. 334. But as indicated in the first portion of this note, the prevailing doctrine was that "the presence in a label of matter registrable as a trademark excludes the whole from registration." *Ex parte* Thaddeus Davids & Co., 16 Off. Gaz. 94. It has been held by the Supreme Court of the District of Columbia, however, that the Commissioner of Patents has no discretion to determine whether a par-

ticular label should be classed as a trademark or as only a label. That his duties as respects this act are purely ministerial, and mandamus will lie to compel him to register any label properly presented for registration. United States ex rel. Wilcox & Gibbs Sewing Machine Co. v. Marble, 1 Mackey, 284; 22 Off. Gaz. 1366; United States ex rel. Schumacher v. Marble, 3 Mackey, 32. And it is now settled that a print will not be refused registration "even though it may contain matter capable of sequestration as a trademark, not in fact registered as a trademark." Greeley, Commissioner, in *Ex parte* United States Playing Card Co., 82 Off. Gaz. 1209, 1210.

In regard to this act, the Patent Office has adopted the following rule: "These sections of statutes (referring to sections 3, 4 and 5 of the Act of June 18, 1874) are construed as authorizing the registry of 'prints' and 'labels.' A label is a device or representation not borne by an article of manufacture or vendible commodity. A print is a device or representation not borne by an article of manufacture or vendible commodity, but in some fashion pertaining thereto—such, for instance, as a pictorial advertisement thereof. A label can not be registered if it bear a device capable of registration as a trademark, until after such device is registered as a trademark. Both labels and prints, in order to be entitled to registry, must be intellectual productions in the degree required by the copyright law."

The restriction contained in this rule as to the registration of labels containing a device capable of sequestration as a trademark does not apply to a print containing such a device, and it will be admitted to registration, even though it may contain a device so capable of sequestration as a trademark, and that device has not been registered. *Ex parte* United States Playing Card Co., 82 Off. Gaz. 1209.

The Patent Office has furnished the following information to applicants for the registration of prints and labels under this act, and forms for use in making application for such registration:

"The so-called print and label section of the copyright statute, approved June 18, 1874, is construed to provide for the registration of any print or label without examination as to its novelty.

"An adverse decision by the examiner who has charge of the registration of prints and labels, upon an applicant's right to have a print or label registered, will be reviewed by the commissioner in person, on petition, without fee.

"The word 'print,' as used in this act, so far as it relates to registration in the Patent Office, is defined as an artistic representation or intellectual production not borne by an article of manufacture or vendible commodity, but in some fashion pertaining thereto—such, for instance, as an advertisement thereof.

"The word 'label,' as used in this act, so far as it relates to registration in the Patent Office, is defined as an artistic representation or intellectual production impressed or stamped directly upon the articles of manufacture, or upon a slip or piece of paper or other material, to be attached in any man-

ner to manufactured articles, or to bottles, boxes, and packages containing them, to indicate the contents of the package, the name of the manufacturer, or the place of manufacture, the quality of goods, directions for use, etc.

"By the words 'articles of manufacture' (to which such print or label is applicable by this act) is meant all vendible commodities produced by hand, machinery, or art.

"No print or label can be registered unless it properly belongs to an article of commerce and is as above defined.

"To entitle the proprietor of any such print or label to register the same in the Patent Office, the application for the registration thereof must be made to the Commissioner of Patents, and said application should be signed by the proprietor or his agent. There must also be filed in the Patent Office five copies of the print or label one of which, when the print or label is registered, shall be certified under the seal of the Commissioner of Patents and returned to the proprietor.

"The certificate of such registration will continue in force for twenty-eight years.

"The certificate may be continued for a further term of fourteen years upon filing a second application within six months before the expiration of the term of the original certificate, and complying with all other regulations with regard to original applications. Within two months from the date of said renewal, the applicant must cause a copy of the record thereof to be published for four weeks in one or more newspapers printed in the United States.

"The fee for registration of a print or label is $6, to be paid in the same manner as fees for trade-marks.

"The attention of persons contemplating the registry of a print or label in the Patent Office is called to the decision of the United States Supreme Court in Higgins v. Keuffel, 55 O. G. 1139; 140 U. S. 428; to the decision of the United States Circuit Court in Marsh *et al.* v. Warren *et al.*, 14 O. G. 678, and to the decisions of the Commissioner of Patents in *Ex parte* United States Playing Card Co., 82 O. G. 1209, and *Ex parte* Mahn, 82 O. G. 1210."

The simulation of currency being forbidden by sec. 5430 R. S. U. S. a label containing simulations of currency or coins will not be registered. *Ex parte* Ball, 98 Off. Gaz. 2366; and so of labels containing the flag of the United States, *Ibid*, or the shields of the United States and and Cuba. *Ex parte* R. Steinecke Co., 122 Off. Gaz. 3011.

If not an artistic production the label will not be registered, and the fee will be returned. *Ex parte* Sides, 123 Off. Gaz. 1663. A fanciful design to be placed upon cards and letterheads is not registrable as a print under this act. "The article of manufacture referred to in the statute must be separate and independent of the print itself." Greeley, Act. Com., in *Ex parte* Barnhart Bros. & Spindler, 87 Off. Gaz. 2118, 2119.

To be registrable, the label must identify the article on which it is used. *Ex parte* Mahn, 82 Off. Gaz. 1210; *Ex parte* American Weavers' Assn., 94 Off. Gaz. 586; *Ex parte* Ball, 98 Off. Gaz. 2366.

RULES GOVERNING THE REGISTRATION OF PRINTS AND LABELS IN THE PATENT OFFICE.

UNITED STATES PATENT OFFICE,
Washington, D. C., August 15, 1913.

The following rules, designed to be in strict accordance with the provisions of the copyright law, for the registration of prints and labels, are published for gratuitous distribution.

Applicants for registration and their attorneys are advised that their business will be facilitated by the observance of the forms on pages 13 to 15.

THOMAS EWING,
Commissioner of Patents.

CORRESPONDENCE.

1. All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

2. Applicants and attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will be returned. But all such papers will first be submitted to the commissioner, and only returned by his direct order.

3. All letters should be addressed to "The Commissioner of Patents," and all remittances by postal order, certified check, or draft should be to his order.

4. A separate letter should in every case be written in relation to each distinct subject of inquiry or application. Complaints against the examiner, assignments for record, fees, and orders for copies or abstracts must be sent to the office in separate letters.

5. Letters relating to pending applications should refer to the name of the applicant and date of filing. Letters relating to

registered prints and labels should refer to the name of registrant and number and date of certificate.

6. The personal attendance of applicants at the Patent Office is unnecessary. Their business can be transacted by correspondence.

7. When an attorney shall have filed his power of attorney, duly executed, the correspondence will be held with him.

8. A double correspondence with an applicant and his attorney, or with two attorneys, can not generally be allowed.

9. The office can not undertake to respond to inquiries propounded with a view to ascertain whether certain prints and labels have been registered, or, if so, to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed.

10. Express, freight, postage, and all other charges on matter sent to the Patent Office must be prepaid in full; otherwise it will not be received.

ATTORNEYS.

11. An applicant may prosecute his own case, but he is advised, unless familiar with such matters, to employ a competent attorney. The office can not aid in the selection of any attorney.

12. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. But general powers given by a principal to an associate can not be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or co-partnership will not be recognized, either in favor of the firm or any of its members, unless all its members shall be named in such power of attorney.

13. Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second attorney to appoint a third.

14. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the commissioner; and when so revoked the office will communicate directly with the applicant, or such other attorney as he may appoint. An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney.

15. For gross misconduct the commissioner may refuse to recognize any person as an attorney, either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the Secretary of the Interior.

WHO MAY REGISTER A PRINT OR LABEL.

16. (*a*) The author or proprietor of any print or label, or his executors, administrators, or assigns, who is a citizen of the United States.

(*b*) An alien author or proprietor of any print or label, or his executors, administrators, or assigns, only as provided by section 8 of the copyright act approved March 4, 1909.

Any person to whom an author, who has the privilege of copyright in the United States, has transferred his copyright can apply for and obtain a copyright entry as a proprietor.

THE APPLICATION.

17. To entitle the author or proprietor of any such print or label or his executors, administrators, or assigns to register the same in the Patent Office, the application for registration thereof must be made to the Commissioner of Patents, and the said application should be signed by the author or proprietor, or by his executors, administrators, or assigns, or for the author or proprietor by duly authorized agent.

18. A complete application comprises—

(*a*) A statement addressed to the Commissioner of Patents, disclosing applicant's name, citizenship, residence, and place of doing business; whether author, proprietor, or executors, administrators, or assigns of the author or proprietor; and, if proprietor, a disclosure of the citizenship of the author, the title of the print or label, and the name of the article of manufacture for which the print or label is to be used.

(*b*) Ten copies of the print or label, one of which, when the print or label is registered, shall be certified under the seal of the Patent Office and returned to the author or proprietor

(*c*) A fee of $6.

(*d*) A statement of the date when the print or label was first published with notice of copyright. (See sec. 9 of Act of Mar. 4, 1909.)

19. The title of the print or label must appear on the copies filed.

20. Pending applications are preserved in secrecy, and no information will be given without authority of the applicant respecting the filing of an application for the registration of a print or label by any person, or the subject-matter thereof, unless it shall, in the opinion of the commissioner, be necessary to the proper conduct of business before the office.

EXAMINATION OF APPLICATIONS.

21. The so-called print and label section of the copyright statute, approved June 18, 1874, is construed to provide for the registration of any print or label without examination as to its novelty.

22. All applications for registration are considered in the first instance by the examiner. Whenever, on examination of an application, registration is refused for any reason whatever, the applicant will be notified thereof. The reasons for such rejection will be stated, and such information will be given as may be useful in aiding the applicant to judge of the propriety of further prosecuting his application.

23. The examination of an application and the action thereon will be directed throughout to the merits, but in each letter the examiner shall state or refer to all his objections.

AMENDMENTS.

24. The application may be amended to correct informalities or to avoid objections made by the office, or for other reasons arising in the course of examination, and if the copies of the prints or labels furnished are for any reason not registrable under the copyright law, the applicant may substitute copies which conform to the requirements of said law.

25. In every amendment the exact word or words to be stricken out or inserted must be specified, and the precise point indicated where the erasure or insertion is to be made. All such amendments must be on sheets of paper separate from the papers previously filed and written on but one side of the paper.

26. After allowance, the examiner will exercise jurisdiction over an application only by special authority from the commissioner.

Amendments may be made after the allowance of an application on the recommendation of the examiner, approved by the commissioner, without withdrawing the case from issue.

27. After the completion of the application the office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers which he wishes to amend, the office will furnish them on the usual terms. (See rule 38.)

SUBJECT-MATTER OF APPLICATION.

28. The word "print," as used in section 3 of the copyright act, so far as it relates to registration in the Patent Office, is defined as an artistic and intellectual production designed to be used for an article of manufacture and in some fashion pertaining thereto, but not borne by it; such, for instance, as an advertisement thereof.

29. The word "label," as used in this act, so far as it relates to registration in the Patent Office, is defined as an artistic and intellectual production impressed or stamped directly upon the article of manufacture or upon a slip or piece of paper or other material to be attached in any manner to manufactured articles or to bottles, boxes, and packages containing them to indicate the article of manufacture.

30. No print or label can be registered unless it properly belongs to an article of manufacture and is descriptive thereof and is as above defined.

APPEALS.

31. An adverse decision by the examiner who has charge of the registration of prints and labels, upon an applicant's right to have a print or label registered, will be reviewed by the commissioner in person, on appeal, without fee.

ISSUE, DATE, AND DURATION OF CERTIFICATE.

32. When the requirements of the law and of the rules have been complied with and the office has adjudged a print or label registrable, a certificate will be issued, signed by the Commissioner of Patents under the seal of the Patent Office. Attached to the certificate will be a copy of the print or label.

33. A certificate of registration shall remain in force for twenty-eight years from the date of first publication.

34. The certificate may be continued for a further term of twenty-eight years upon filing a second application within one year prior to the expiration of the term of the original certificate and complying with all other regulations with regard to original applications.

ASSIGNMENTS.

35. Prints and labels are assignable in law by an instrument in writing signed by the proprietor. This should state the names of the assignee and assignor, the title of the print or label assigned, the date of filing the application, or, if registered, the date and number of the certificate, and should be dated.

COPIES AND PUBLICATIONS.

36. After a print or label has been registered, copies thereof may be furnished, when authorized by the commissioner, upon the payment of the fee.

37. The Official Gazette of the Patent Office will contain a list of all the prints and labels registered, with the name and address of the registrant in each case, the title of the print or label, and a statement of the particular goods to which it is to be applied, together with the date of filing the application.

FEES.

38. On filing an application for registration of a print or label	$6.00
For manuscript copies of records, for every 100 words or fraction thereof	.10
If certified, for the certificate, additional	.25
For recording every assignment, power of attorney, or other paper, of 300 words or under	1.00
Of over 300 and under 1,000 words	2.00
For each additional 1,000 words or fraction thereof	1.00
For abstracts of title:	
For the search, one hour or less, and certificate	1.00
Each additional hour or fraction thereof	.50
For each brief from the digest of assignments, of 200 words or less	20
Each additional 100 words or fraction thereof	.10
For searching titles or records, one hour or less	.50
Each additional hour or fraction thereof	.50
For single printed copy, when authorized by the commissioner	.05
If certified, for the grant, additional	.50
For the certificate	.25

39. The fee for registration of a print or label is to be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor, which shall be transmitted to the Patent Office. When this can not be done without inconvenience the money may be remitted by mail, and in every such case the letter should state the exact amount inclosed. All money orders and checks should be made payable to the "Commissioner of Patents."

40. All money sent by mail, either to or from the Patent Office, will be at the risk of the sender. All payments to the office must be made in specie, Treasury notes, national bank notes, certified checks, or money orders.

REPAYMENT OF MONEY.

41. Upon refusal of the commissioner to register the print or label, and on application by the applicant, or his duly authorized agent, the fee may be returned.

NOTICE OF COPYRIGHT.

42. It is necessary, in order to maintain an action for infringement of a copyright, that the claim of copyright be printed on each copy of the article protected. The wording of the notice is determined by the copyright statute, section 18.

Approved March 13, 1912.

SAMUEL ADAMS,
Acting Secretary.

FORMS

FORMS FOR APPLICATION FOR REGISTRATION OF PRINTS.

(1) FOR AN INDIVIDUAL.

To the Commissioner of Patents:

The undersigned, ———, [*insert name of applicant*] a ———, [*insert statement of applicant's citizenship, or of what ruler he is a subject*] residing at ———, [*insert applicant's residence, domicile or location*] and doing business at ———, [*insert applicant's place of doing business*] hereby applies as ———, [*state whether as author or proprietor; and if as proprietor, state also the citizenship of the author (or of what ruler he is a subject) from whom title is derived*] for registration of the print shown in the accompanying copies, 10 of which are furnished.

The print was first published, with Notice of Copyright thereon, on ———; [*insert date of publication*] its title is ———, [*insert title of print, which must appear on the copies furnished*] and it is used for advertising purposes for ——— [*state goods which print is used to advertise*].

(Signature of applicant) ———,
Author (or Proprietor).

(2) FOR A FIRM.

To the Commissioner of Patents:

The undersigned, ———, [*insert name of applicant*] a firm, domiciled in ———, [*insert applicant's residence, domicile, or location*] and doing business at ———, [*insert applicant's place of doing business*] hereby applies as proprietor, the author from whom title is derived being a citizen of (or subject of) ———, [*state citizenship of the author (or of what ruler he is a subject)*] for registration of the print shown in the accompanying copies, 10 of which are furnished.

The print was first published, with Notice of Copyright thereon, on ———; [*insert date of publication*] its title is ———, [*insert title of print, which must appear on the copies furnished*] and it is used for advertising purposes for ——— [*state goods which print is used to advertise*].

(Signature of applicant) ———,
Proprietor.
By ———,
A Member of the Firm.

(3) FOR A CORPORATION.

To the Commissioner of Patents:

The undersigned, ———, [*insert name of applicant*] a corporation duly organized under the laws of ———, [*state under the laws of what state or nation organized*] located in ———, [*insert applicant's residence, domicile, or location*] and doing business at ———, [*insert applicant's place of doing business*] hereby applies as proprietor, the author from whom title is derived being a citizen of (or subject of) ———, [*state citizenship of the author (or of what ruler he is a subject)*] for registration of the print shown in the accompanying copies, 10 of which are furnished.

The print was first published, with Notice of Copyright thereon, on ———; [*insert date of publication*] its title is ———, [*insert title of print, which must appear on the copies furnished*] and it is used for advertising purposes for ——— [*state goods which print is used to advertise*].

(Applicant's name) ———,
By ———,
President (or Other Officer).

(4) FOR EXECUTORS OR ADMINISTRATORS.*

To the Commissioner of Patents:

The undersigned, ———, [*give name of executors or administrators*] residing at ———, [*give residence of executors or administrators*] ———, [*state whether executors or administrators*] of the estate of ———, [*insert name of deceased author or proprietor*] deceased, late a ———, [*insert statement of deceased author's or proprietor's citizenship, or of what ruler he was a subject*] and a resident of ———, [*insert late residence of deceased author or proprietor*] hereby apply as proprietors for the registration of the print shown in the accompanying copies, 10 of which are furnished, and of which said ———, [*insert name of deceased author or proprietor*] deceased, was the ——— [*state whether deceased was author or proprietor; and, if proprietor, state also the citizenship of the author (or of what ruler he was a subject) from whom title was derived*].

The print was first published, with Notice of Copyright thereon, on ———; [*insert date of publication*] its title is ———, [*insert title of print, which must appear on the copies furnished*] and it is used for advertising purposes for ——— [*state goods which print is used to advertise*].

———,
———,
Executors (or Administrators) of the Estate of ———, [*insert name of deceased author or proprietor*] *Deceased.*

* When application is filed by an executor or administrator, a copy of the letters testamentary or of administration certified by the clerk of the court granting such letters must accompany the application.

FORMS FOR APPLICATION FOR REGISTRATION OF LABELS.

(1) FOR AN INDIVIDUAL.

To the Commissioner of Patents:

The undersigned, ———, [*insert name of applicant*] a ———, [*insert statement of applicant's citizenship, or of what ruler he is a subject*] residing at ———, [*insert applicant's residence, domicile, or location*] and doing business at ———, [*insert applicant's place of doing business*] hereby applies as ———, [*state whether as author or proprietor; and, if as proprietor, state also the citizenship of the author (or of what ruler he is a subject) from whom title is derived*] for registration of the label shown in the accompanying copies, 10 of which are furnished.

The label was first published, with Notice of Copyright thereon, on ———; [*insert date of publication*] its title is ———, [*insert title of label, which must appear on the copies furnished*] and it is used on ——— [*state goods on which the label is used*].

(Signature of applicant) ———,
Author (or Proprietor).

(2) FOR A FIRM.

To the Commissioner of Patents:

The undersigned, ———, [*insert name of applicant*] a firm domiciled in ———, [*insert applicant's residence, domicile, or location*] and doing business at ———, [*insert applicant's place of doing business*] hereby applies as proprietor, the author from whom title is derived being a citizen of (or subject of) ———, [*state citizenship of the author (or of what ruler he is a subject*] for registration of the label shown in the accompanying copies, 10 of which are furnished.

The label was first published, with Notice of Copyright thereon, on ———; [*insert date of publication*] its title is ———, [*insert title of label, which must appear on the copies furnished*] and it is used on ——— [*state goods on which the label is used*].

(Signature of applicant) ———,
Proprietor.
By ———,
A Member of the Firm.

(3) FOR A CORPORATION.

To the Commissioner of Patents:

The undersigned, ———, [*insert name of applicant*] a corporation duly organized under the laws of ———, [*state under the laws of what state or nation organized*] located in ———, [*insert applicant's residence, domicile, or location*] and doing business at ———, [*insert applicant's place of doing business*] hereby applies as proprietor, the author from

whom title is derived being a citizen of (or subject of) ———, [*state citizenship of the author (or of what ruler he is a subject)*] for registration of the label shown in the accompanying copies, 10 of which are furnished.

The label was first published, with Notice of Copyright thereon, on ———; [*insert date of publication*] its title is ———, [*insert title of label, which must appear on the copies furnished*] and it is used on ——— [*state goods on which the label is used*].

(Applicant's name) ———,
By ———,
President (or Other Officer).

(4) FOR EXECUTORS OR ADMINISTRATORS.*

To the Commissioner of Patents:

The undersigned, ———, [*give names of executors or administrators*] residing at ———, [*give residence of executors or administrators*] ———, [*state whether executors or administrators*] of the estate of ———, [*insert name of deceased author or proprietor*] deceased, late of ———, [*insert statement of deceased author's or proprietor's citizenship, or of what ruler he was a subject*] and a resident of ———, [*insert late residence of deceased author or proprietor*] hereby apply as proprietors for the registration of the label shown in the accompanying copies, 10 of which are furnished, and of which said ——— [*insert name of deceased author or proprietor*] deceased, was the ——— [*state whether deceased was author or proprietor; and, if proprietor, state also the citizenship of the author (or of what ruler he was a subject) from whom title was derived*].

The label was first published, with Notice of Copyright thereon, on ———; [*insert date of publication*] its title is ———, [*insert title of label, which must appear on the copies furnished*] and it is used on ——— [*state goods on which the label is used*].

———,
———,
Executors (or Administrators) of the Estate of ———, [*insert name of deceased author or proprietor*] *Deceased.*

* When application is filed by an executor or administrator, a copy of the letters testamentary or of administration certified by the clerk of the court granting such letters must accompany the application.

APPENDIX C.

PENAL ACT OF AUGUST 14, 1876.

(19 Statutes at Large, 141.)

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled:

SECTION 1. That every person who shall, with intent to defraud, deal in or sell, or keep or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trademark pursuant to the statutes of the United States, to which, or to the package in which the same are put up, is fraudulently affixed said trademark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished by a fine not exceeding one thousand dollars, or imprisonment not more than two years, or both such fine and imprisonment.

SECTION 2. That every person who fraudulently affixes, or causes, or procures to be fraudulently affixed, any trademark registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, to any goods of substantially the same descriptive properties as those referred to in said registration, or to the package in which they are put up knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SECTION 3. That every person who fraudulently fills, or causes or procures to be fraudulently filled, any package to which is affixed any trademark, registered pursuant to the statutes of the United States, or any colorable imitation thereof, calculated to deceive the public, with any goods of substantially

the same descriptive properties as those referred to in said registration knowing the same to be counterfeit, or not the genuine goods referred to in said registration, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SECTION 4. That any person or persons who shall, with intent to defraud any person or persons, knowingly and wilfully cast, engrave, or manufacture, or have in his, her, or their possession, or buy, sell, offer for sale, or deal in, any die or dies, plate or plates, brand or brands, engraving or engravings, on wood, stone, metal, or other substance, moulds, or any false representations, likeness, copy, or colorable imitation of any die, plate, brand, engraving or mould of any private label, brand, stamp, wrapper, engraving on paper or other substance or trademark, registered pursuant to the statutes of the United States, shall, upon conviction thereof, be punished as prescribed in the first section of this act.

SECTION 5. That any person or persons who shall, with intent to defraud any person or persons, knowingly and wilfully make, forge or counterfeit, or have in his, her or their possession, or buy, sell, offer for sale, or deal in, any representation, likeness, similitude, copy, or colorable imitation of any private label, brand, stamp, wrapper, engraving, mould or trademark, registered pursuant to the statutes of the United States, shall upon conviction thereof, be punished as prescribed in the first section of this act.

SECTION 6. That any person who shall, with intent to injure or defraud the owner of any trademark, or any other person lawfully entitled to use or protect the same, buy, sell, offer for sale, deal in, or have in his possession any used or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed, so that the same may be obliterated without substantial injury to such box or other thing aforesaid, any trademark, registered pursuant to the statutes of the United States, not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, shall, on conviction thereof, be punished as prescribed in the first section of this act.

SECTION 7. That if the owner of any trademark, registered pursuant to the statutes of the United States, or his agent, make oath, in writing, that he has reason to believe, and does believe,

that any counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, or moulds, of his said registered trademark, are in the possession of any person with intent to use the same for the purpose of deception and fraud, or make such oaths that any counterfeits or colorable imitations of his said trademark, label, brand, stamp, wrapper, engraving on paper or other substance, or empty box, envelope, wrapper, case, bottle, or other package, to which is affixed said registered trademark not so defaced, erased, obliterated, and destroyed as to prevent its fraudulent use, are in the possession of any person with intent to use the same for the purpose of deception and fraud, then the several judges of the circuit and district courts of the United States, and the commissioners of the circuit courts may, within their respective jurisdictions, proceed under the law relating to search-warrants, and may issue a search-warrant authorizing and directing the marshal of the United States for the proper district to search for and seize all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, and said counterfeit trademarks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper, or other substance, and the said empty boxes, envelopes, wrappers, cases, bottles or other packages that can be found; and upon satisfactory proof being made that said counterfeit dies, plates, brands, engravings on wood, stone, metal, colorable imitations thereof, labels, brands, stamps, or other substance, moulds, counterfeit trademarks, wrappers, engravings on paper or other substance, empty boxes, envelopes, wrappers, cases, bottles, or other packages, are to be used by the holder or owner for the purpose of deception and fraud, that any of said judges shall have full power to order all said counterfeit dies, plates, brands, engravings on wood, stone, metal, or other substance, moulds, counterfeit trademarks, colorable imitations thereof, labels, brands, stamps, wrappers, engravings on paper or other substances, empty boxes, envelopes, wrappers, cases, bottles, or other packages, to be publicly destroyed.

SECTION 8. That any person who shall, with intent to defraud any person or persons, knowingly and wilfully aid or abet in the violation of any of the provisions of this act, shall upon conviction thereof, be punished by a fine not exceeding five hundred

dollars, or imprisonment not more than one year, or both such fine and imprisonment.[1]

1—This act is important because of its connection with the Trademark Cases, 100 U. S. 82, 25 L. Ed. 550. In that case the supreme court declared the Act of 1870 to be unconstitutional because this act was by its express terms confined to frauds, counterfeits, and unlawful use of trademarks which were registered under the provisions of the former act. The registration act being invalid, the criminal enactment intended to protect the rights of registrants fell with it. Trademark Cases, 100 U. S. 82-99, 25 L. Ed. 550.

It was held that there could be no conviction under this act unless the certificate of registration contained words to show that the alleged owner acquired an exclusive property in the mark claimed. United States v. Braun, 39 Fed. Rep. 775.

This statute having been judicially declared void could not be and was not made operative by the enactment of the statute of 1881. United States v. Koch, 40 Fed. Rep. 250.

The requirements of an application for a search-warrant under sec. 7 of this act were discussed by Judge Treat *In re* O'Donnell, Fed. Case No. 10434, 14 Off. Gaz. 379.

APPENDIX D.

TRADEMARK ACT OF MARCH 3, 1881.[1]

An act to authorize the registration of trademarks and protect the same.

Be it enacted by the Senate and House of Representatives of the United States in Congress assembled:

SECTION 1.[2] That owners[3] of trademarks[4] used in commerce with foreign nations or with the Indian tribes,[5] provided such

1—This act has been usually treated as valid. South Carolina v. Seymour, 153 U. S. 353, 38 L. Ed. 742; 67 Off. Gaz. 1191; L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep 624; Hennessy v. Braunschweiger, 89 Fed. Rep. 664. But in a late case Judge Jenkins said: "There has been no ruling upon the constitutionality of this act, and it need only be said that its validity is fairly doubtful." Illinois Watch Case Co. v. Elgin National Watch Co., 94 Fed. Rep. 667-669; 87 Off. Gaz. 2323; 35 C. C. A. 237.

The supreme court, in affirming the decree of the court of appeals in this case, expressly declined passing upon the question of the constitutionality of the act. Elgin National Watch Co. v. Illinois Watch Case Co. (2), 179 U. S. 665-677, 45 L. Ed. 365.

This act presupposed the existence of a valid trademark which might be registered on compliance with the requirements of the act, and registration under the act did not in any manner affect the nature or function of the mark. Edison v. Thomas A. Edison, Jr., Chemical Co., 128 Fed. Rep. 1013.

2—See Notes, Act of 1870, sec. 77, *ante*, p. 501.

3—Ownership is a prerequisite. A carpet cleaner was refused registration for the mark used by him on his wagons and upon carpets cleaned by him, because he could not comply with the clause of the Act of 1870 requiring a statement of the class of merchandise and the particular description of goods to which he applied the mark. *In re* Hankinson, 8 Off. Gaz. 89. An official fish inspector has no trademark in the official brand used by him, because he has no private ownership therein. Chase v. Mays, 121 Mass. 343. A certificate of registration of trademark will not be issued to the applicant and his assignee jointly. *Ex parte* Spinner, 35 MSS. D., July, 1887. A trademark adopted by a real estate dealer for use in the course of his business can not be registered. *Ex parte* Roy, 54 Off. Gaz. 1267. When

it appears that several parties have the right to the use of the mark, independent registration will not be granted to either of them. *Ex parte* Langdon, 61 Off. Gaz. 286. A certificate will not be issued to the assignee of the applicant. *Ex parte* Roasted Cereals Co., 57 MSS. D. 455. Even when the assignment has been recorded. *Ex parte* Bassett, 55 Off. Gaz. 997; *Ex parte* Spinner, 35 MSS. D. 15.

Thus registration was refused where the facts showed that "applicant is a voluntary association or league of flour manufacturers, all members of which use the mark upon their product and have an interest severally and in common in its protection; and the present application for registration is made by the association through its secretary, an officer duly authorized to that end. The applicant is not a corporation, nor is it, in strict use of the term, a partnership; but it is a voluntary association or league or union of the kind recognized by the laws and courts of the state of its domicile, and by the laws and courts of nearly all the states of the Union, as lawful and of the kind to which they extend protective and other relief in proper cases. As an association it does not itself make, brand, or sell the flour to which its mark is applied; but its members by its authority use the selected mark on wheat flour of their own manufacture. The league states its objects to be: 'To oppose the adulteration of flour, to assist in enforcing the law, to protect its honest millers from dishonest competition, to expose fraud, to maintain the integrity of the American milling trade, and to afford buyers a guarantee that they can obtain from members of this league absolutely pure flour.' As to its membership, the rule is: 'Any miller who does not adulterate flour can join this league upon the payment of ten dollars membership fee, and executing the affidavit and contract which are conditions of the membership.' * * * But the ownership of the mark is, by agreement of all interested parties, vested in the association, and the right to its use by any individual arises only from permission of the association and is subject to forfeiture upon failure to comply with the prescribed terms." The commissioner saying: "I can find no authority in the trademark act permitting this office to register a trademark, the right to use which is farmed out and which is not actually used by the would-be registrant. While the verified declaration accompanying the statement in this case sets forth that no other person, firm or corporation has any right to use the mark, yet the brief of counsel shows that all of the members of the association, which is stated to be composed of a majority of the principal flour manufacturers of the United States, have a right, under certain conditions, to use the mark." Duell, Commissioner, in *Ex parte* The Anti-Adulteration League, 86 Off. Gaz. 1803.

A word to be used as the name of or mark for a patented article will not be admitted to registration. In so ruling the commissioner has said: "In view of the fact that under the Trademark Act of 1881 a certificate of registry re-

mains in force for thirty years from its date, I do not think this office should register trademarks which, though lawful trademarks at the date when registry is sought, will become public property before the expiration of the thirty years. By so doing the Patent Office would be placed in the light of attempting to aid in prolonging a monopoly, which manifestly, under the decisions of the courts, is unwarranted. To thus attempt to give the petitioner a monopoly for many years longer than is given by the patent would be a fraud upon the public." Duell, Commissioner, in *Ex parte* Velvril Co., 84 Off. Gaz. 807. To the same effect see *Ex parte* F. H. Gilson Co., 83 Off. Gaz. 1992.

4—"Under the statute of March 3, 1881, 'owners of trademarks,' under certain conditions as to use and upon compliance with certain requirements which need not now be considered, are entitled to obtain registration therefor. The phrase 'owners of trademarks' manifestly limits the right of registration to such person or persons, natural or artificial, as possess the legal title to that for which registration is sought, and it further limits the right of registration to that which is a trademark. It is therefore incumbent upon the various tribunals of the office having in charge the registration of trademarks, when an application for registration is filed, to decide at the outset two questions: (1) Is applicant the *owner*, and (2) is that which he seeks to register a *trademark?* Manifestly the tribunals of this office, in deciding the question of ownership, are not precluded by the statement and declaration of ownership, made by the applicant from considering and deciding whether he is or is not the *owner* of the thing sought to be registered. It is not unusual to refuse registration because of the absence of legal title in the applicant—for example, when it appears that before applicant adopted and used his alleged mark the identical thing has been adopted and used by another. Equally is it the province and duty of the tribunals of the office having jurisdiction of the registration of trademarks to decide whether the *thing* presented for registration is a *trademark*. An applicant may be the owner of the thing alleged to be his trademark, and yet the thing presented for registration may not be a trademark. The statement and declaration of applicant that the thing presented for registration is a trademark are not conclusive. The question is what the thing *is*, and not what it is *called*. That the statute vests in this office the power to pass upon these two questions I believe, and to pass upon such questions has been the uniform practice of my predecessors ever since the enactment of the trademark law of 1881." Duell, Commissioner, in *Ex parte* The Bronson Co., 87 Off. Gaz. 1782; and in *Ex parte* Buffalo Pitts Co., 89 Off. Gaz. 2069.

5—Commerce with the Indian tribes may be conducted wholly within the limits of a single state. "The power of congress is not determined by the locality of the traffic, but extends wherever intercourse with Indian tribes, or with any member of an Indian tribe, is

owners shall be domiciled in the United States or located in any foreign country or tribe, which, by treaty, convention, or law,[6] affords similar privileges to citizens of the United States, may obtain registration[7] of such trademarks by complying with the following requirements:

found, although it may originate and end within the limits of a single state." Prentice & Egan, Commerce Clause of the Federal Constitution, p. 346, citing United States v. Holliday, 3 Wall. 407, 18 L. Ed. 182; Territory v. Guyott, 9 Mont. 46.

6—The fact that a mark is lawful in a foreign country is no test of its registrability here. *In re* Moet & Chandon, 18 MSS. D. 259. In that case registration was refused although the mark had been registered in France. On the other hand, the words "Germania" and "Goliath" have been registered in the United States by citizens of Germany, notwithstanding the fact that the words could not be registered in Germany as trademark, because it appeared that citizens of the United States had been permitted to register marks in Germany for which German citizens would not be allowed registration. *In re* Manske & Co., 64 Off. Gaz. 858; *In re* Schmidt, 53 MSS. D. 7. Under this act a foreigner is entitled to no other or further rights than a citizen of the United States. *Ex parte* Buffalo Pitts Co., 89 Off. Gaz. 2069.

The distinction between the terms "treaty" and "convention" is purely artificial. "A treaty is primarily a contract between two or more independent nations." Mr. Justice Field, in Whitney v. Robertson, 124 U. S. 190-194, 31 L. Ed. 388.

The International Convention for the Protection of Industrial Property, signed at Paris, March 20, 1883, and acceded to by presidential proclamation on behalf of the United States, March 29, 1887, can not become operative in the absence of federal legislation. Opinions of the Attorney-General, 1889, p. 253; 47 Off. Gaz. 398; *Ex parte* Zwack & Co., 76 Off. Gaz. 1855.

For treaties and conventions, 1776-1887, see "Treaties and Conventions Between the United States and Other Powers:" Government Printing Office, 1889.

The declaration with Great Britain is drawn so as to confer mutual trademark rights upon the subjects and citizens of each of the contracting parties throughout the dominions and possessions of the other. Citizens or residents of British colonies are therefore permitted to register their trademarks under this treaty whenever it is satisfactorily shown that in the respective colonies similar protection is afforded to citizens of the United States.

7—"Registration under the Act of 1881 is of but little, if any, value, except for the purpose of creating a permanent record of the date of adoption and use of the trademark; or in cases where it is necessary to give jurisdiction to the United States courts." Hawley, J., in Hennessy v. Braunschweiger, 89 Fed. Rep. 664. To the same effect see Waukesha Hygeia Mineral Springs Co. v. Hygeia Distilled

1st. By causing to be recorded in the Patent Office a statement specifying name,[8] domicile,[9] location,[10] and citizenship[11] of the party applying; the class of merchandise and the partic-

Water Co., 70 Off. Gaz. 1319; 63 Fed. Rep. 438; 11 C. C. A. 277; Sarrazin v. W. R. Irby Cigar & Tobacco Co., 93 Fed. Rep. 624-627; Brower v. Boulton, 53 Fed. Rep. 389; Adams v. Heisel, 31 Fed. Rep. 279-281.

The act does not define trademarks.—"It will be observed that the statute (referring to the Act of 1870) does not define the term 'trademark,' or say of what it shall consist. The term is used as though its signification was already known to the law. It speaks of it as an already existing thing, and protects it as such. The thing to be protected must be an existing lawful trademark, or something that may then for the first time be adopted as a lawful trademark independent of the statute. There must be a lawful trademark adopted without reference to the statute, and then, by taking the prescribed steps, that trademark, so already created and existing, may receive certain further protection under the statute." Moorman v. Hoge, 2 Sawy. 78. The reasoning of this opinion is equally applicable to the Act of 1881. L. H. Harris Drug Co. v. Stucky, 46 Fed. Rep. 624-628; *Ex parte* M. Block & Co., 40 Off. Gaz. 443.

8—The christian name of the applicant should be given in all cases, instead of the initial only, for reasons indicated in Monroe Cattle Co. v. Becker, 147 U. S. 47, 37 L. Ed. 72; United States v. Upham, 43 Fed. Rep. 68.

9—Domicile, *i. e.*, the place of residence of the applicant; "that place in which he has fixed his habitation, without any present intention of departing therefrom." Gordon, J., in Carey's Appeal, 75 Pa. St. 201-205.

10—Where an application shows the applicant to be a citizen of one foreign country and located in another, his application will be governed by the existing treaty, convention or law of the country of his location. By location is meant the *situs* of the factory or other place of business of the applicant. *In re* Haggenmacher, 60 Off. Gaz. 438.

11—What the applicant's citizenship may be is wholly immaterial. His right to registration is governed by the country of his location, which may or may not be identical with that of his citizenship. *In re* Haggenmacher, *supra.*

Citizenship defined.—Citizenship means "residence with intention of remaining permanently at that place. A man may reside in a state for an indefinite period of time without becoming a citizen, but the moment a man takes up his residence in a state different from that where he formerly was domiciled or was a citizen, with intent and purpose of making the new place of residence his future home, that moment he loses his former domicile, and becomes domiciled in the new place; or in other words, he ceases to be a citizen of the former place of residence and becomes a citizen of the state of his adoption." Turner, J., in Winn v. Gilmer, 27 Fed. Rep. 817.

ular description of goods comprised in such class to which the particular trademark has been appropriated;[12] a description of the trademark itself[13] *fac-similes* thereof,[14] and a statement of

12—The fact that the Amoskeag Manufacturing Company had applied its mark to cotton goods except prints did not give it an exclusive right to its use on all cotton goods including prints. Amoskeag Mfg. Co. v. Garner, 55 Barb. 151. The term "Fancy Goods" includes too many sub-classes to be allowed in one registration. *In re* Lisner, Comm. Decis. 1878, p. 46. Registration has been refused for a mark to cover an indurated blood compound and the various articles, such as door knobs, to be made from it. *In re* Dibble Mfg. Co., 18 MSS. D. 428. Application for registration of a mark to be used upon druggists' sundries was refused because the words were too indefinite. *In re* Maw, Son & Thompson, 22 MSS. D. 403.

What one registration may cover. —A single trademark may be registered to be applied to all goods made of hard rubber. *In re* India Rubber Comb Co., 16 MSS. D. 38. Bourbon, wheat and rye whiskies, wines, brandies and gins, may be included in one registration. *In re* Boehm & Co., Comm. Decis. 1875, p. 103; as may "agricultural implements," *In re* Manny & Co., 17 MSS. D. 155; "canned goods," *In re* Fitzpatrick, Davis & Co., 18 MSS. D. 278; and "cutlery," *In re* Kampfe Bros., 58 MSS. D. 306; as well as proprietary medicinal and toilet compounds, *In re* Knight, 38 MSS. D. 341. One registration may, however, cover all the classes of goods upon which the trademark has been used. *Ex parte* Clark-Jewell-Wells Co., 83 Off. Gaz. 915. But a picture and a word can not be embodied in the same registration unless they are true alternatives. *Ex parte* J. D. Richards & Sons, 54 MSS. D. 425; *Ex parte* Adam Roth Gro. Co., 62 Off. Gaz. 315; *Ex parte* Kinney, 72 Off. Gaz. 1349; *Ex parte* Muir, 87 Off. Gaz. 357; *Ex parte* Lazarus Schwarz & Lipper, 64 Off. Gaz. 1396.

13—The description must distinguish the essential from the non-essential features of the mark. *In re* Volta Belt Co., 8 Off. Gaz. 144. The essential features being those serving to distinguish the goods of the applicant, an essential feature can not be anything that is not a valid trademark, such as the geographical word "Lancaster." *In re* Farnum & Co., Comm. Decis. 1880, p. 155; 18 Off. Gaz. 412; *In re* Adriance, Platt & Co., Comm. Decis. 1881, p. 52; 20 Off. Gaz. 1820; *In re* Pierce, 23 MSS. D. 16. The description and fac-simile incorporated in the certificate of registration are evidence to show the extent of the owner's claim of trademark, when he sues for its protection as a common-law trademark. Richter v. Reynolds, 59 Fed. Rep. 577; Kohler Mfg. Co. v. Beeshore, 53 Fed. Rep. 262; s. c., 8 C. C. A. 215. The essential feature of a trademark is not that which the registrant elects to designate as such, but that which would strike the public mind as its most salient feature. *Ex parte* Standard Fashion Co., 89 Off. Gaz. 189.

14—This section does not contemplate registration of form, material, or color. Materials are not

the mode in which the name is applied and affixed to goods,[15]

subject to appropriation as trademark; it has been so held in regard to tin used as tags upon plug tobacco, Lorillard v. Pride, 28 Fed. Rep. 434; nor is a method of bronzing horse-shoe nails, Putnam Nail Co. v. Bennet, 43 Fed. Rep. 800; 59 Fed. Rep. 909; 8 C. C. A. 362; nor the form of sticks of chewing gum, Adams v. Heisel, 31 Fed. Rep. 279; nor the method in which goods are arranged in packages, *Ibid.*, and Davis v. Davis, 27 Fed. Rep. 490.

For further discussion of form, color, etc., see *ante*, pp. 280 *et seq.*

A fac-simile need not contain any unessential portion of the mark sought to be registered. *In re* Watson, 16 MSS. D. 467; *In re* Armstrong & Co., 26 MSS. D. 260.

One fac-simile only is sufficient to illustrate the mode of using the mark. *In re* Kimball, Comm. Decis. 1887, p. 54.

Fac-simile defined.—"A fac-simile is an exact counterpart of an original, and a fac-simile represented by a drawing is an exact counterpart of an original, so far as the nature of a drawing permits. A close adherence to the language of the statute would seem to require that in each case the trademark and nothing but the trademark should be represented by the drawing, and while, perhaps, it would be going too far to apply in all cases a rule so rigorous, it is certainly within the discretion of the office to insist upon it in cases where * * * legitimate doubts arise as to whether protection should not be sought through the law relating to designs. In my judgment the cases are very rare in which the registration of a trademark under the statute requires or should permit of any other matter than the fac-simile of the trademark." Mitchell, Commissioner, in *Ex parte* Hudson, 55 Off. Gaz. 1401. Applicants are restricted to symbols which conform to their fac-similes as well as to their verbal descriptions. Duke v. Green, 16 Off. Gaz. 1094.

15—The statement of the mode of application must be given. *Ex parte* Hudson, 55 Off. Gaz. 1401. It must appear that the trademark is intended to be used upon "goods or manufactured articles, the general objects of commerce." *Ex parte* Roy and Nourse, 54 Off. Gaz. 1267. The use of a trademark upon billheads, letter-heads, cards and circulars used in a business does not come within the contemplation of the statute; although it would be properly a trademark if used thereon as articles of commerce and not as mere vehicles of communication between a dealer and other persons. *Ibid.* The things to which a trademark may be affixed so as to be entitled to registration are goods, wares and merchandise—articles that may be transported, in contradistinction to those fixed species of property which the law includes under the term real estate. *Ibid.* Registration under this act is limited to marks used upon manufactures or merchandise. *In re* Hankinson, 8 Off. Gaz. 89. It is a sufficient application if the mark is used in advertising, and a lithographed reproduction of it inserted in each box

and the length of time during which the trademark has been used.[16]

2d. By paying into the treasury of the United States the sum of twenty-five dollars,[17] and complying with such regulations as may be prescribed by the Commissioner of Patents.

containing the merchandise. Hay & Todd Mfg Co. v. Querns Brothers, 86 Off. Gaz. 1323.

16—The language of the Act of 1870 was "the length of time, *if* any, during which the trademark has been used." This was construed to admit marks to registration that never had been used in commerce. *In re* Rothschild, 7 Off. Gaz. 220. It must now be shown as a prerequisite to registration that there has been actual application of the mark to merchandise and actual user in commerce. United States v. Seymour, 66 Off. Gaz. 1167. Registration under this statute avails nothing if the name or symbol is never used. Siegert v. Abbott, 72 Hun. 243.

It was held in one case that a citizen of France who had not deposited his mark in the Patent Office under the provisions of the treaty of 1869 between the United States and France could not maintain an action for infringement. Lacroix v. Escobal, 37 La. Ann. 533. But in a later case it is held that a registration under the Act of 1881 by a French citizen renders the deposit of the mark under the terms of that convention unnecessary. Société de la Benedictine v. Micalovitch, 36 Alb. L. J. 364. The dates of adoption set forth in the applications of two rival registrants are not conclusive. Einstein v. Sawhill, 61 Off. Gaz. 287. Where actual user appears to have been first made after application for registry, the mark may be admitted to registration upon the filing of a supplemental application. Einstein v. Sawhill, (2), 64 Off. Gaz. 1533.

User in a foreign country alone does not entitle an applicant to registration under this section. Farmers Mfg. Co. v. W. R. Harrison & Co., 96 Off. Gaz. 2062; Leprince v. Iler & Morris, 92 Off. Gaz. 189. "Limited sales in this country by a foreign manufacturer upon especial orders to supply particular customers" do not give a common law right to the mark "since they did not constitute a use of the mark in such circumstances as to publicity and length of use as to show an intention to adopt it as a trademark." Allen, Commissioner, in Farmers Mfg. Co. v. W. R. Harrison & Co., 96 Off. Gaz. 2062.

17—The fee cannot be refunded because registration is refused. *In re* Thayer, 54 Off. Gaz. 957. Where the domestic branch of a house having offices in the United States and abroad, filed an application in ignorance of the fact that an identical application had been made by one of the foreign offices, the fee paid on the second application was refunded. *In re* Finlayson, Bousfield & Co., 61 Off. Gaz. 152.

SECTION 2.[18] That the application prescribed in the foregoing section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or by a member of a firm,[19] or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trademark sought to be registered, and that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive,[20] that such trademark is used in commerce with foreign nations or Indian tribes, as above indicated,[21] and that the description and fac-similes presented for registry truly represent the mark sought to be registered.[22]

SECTION 3.[23] That the time of the receipt of any such application shall be noted and recorded. But no alleged trademark shall be registered unless the same appear to be lawfully [24] used

18—See Act of 1870, sec. 77, *ante*, p. 501.

19—An application of a partnership can not properly be made by one not a member of the firm but merely a so-called "director." *Ex parte* Kirker, Greer & Co. (Ltd.), 37 MSS. D. 392.

20—Registration will be refused whenever in the opinion of the commissioner the mark offered is so similar to a registered mark as to be likely to lead to mistake or confusion. *Ex parte* Coon, 58 Off. Gaz. 946. In case of doubt concerning such similarity, that doubt will be resolved against the applicant. *In re* Bowe, 50 MSS. D. 168; *In re* Bogardus, 50 MSS. D. 2.

21—The declaration on oath that there has been a user of the mark in the classes of commerce specified is insisted on by the Patent Office. *Ex parte* Strasburger & Co., 20 Off. Gaz. 155.

22—A word and a figure which are true alternatives constitute a single mark. Morrison v. Case, 9 Blatchf. 548; 2 Off. Gaz. 544. Hence they may be covered by one registration. *In re* Weaver, 10 Off. Gaz. 1; *Ex parte* Kinney, 72 Off. Gaz. 1346. But where they are not true alternatives, as in the case of the word "Crescent" and the figure of the crescent moon, and the word and figure might convey wholly different meanings to the observer, they will not be registered upon a single application. *Ex parte* Lazarus Schwarz & Lipper, 64 Off. Gaz. 1396; *Ex parte* Roth Grocery Co., 62 Off. Gaz. 315.

23—See Act of 1870, secs. 79, 80, *ante*. The fact that this act does not expressly exclude descriptive words from registration does not raise a presumption that descriptive words should be admitted to registration. L. H. Harris Drug Co. v. Stucky, 46 Fed Rep. 624-627.

24—See cases cited in note to sec. 79 of the Act of 1870, *ante*.

A mark that is deceptive in its nature will not receive registration. *Ex parte* Bloch & Co., 40 Off. Gaz. 443; *In re* Chichester Chemical Co., 52 Off. Gaz. 1061; *In re* American Sardine Co., Comm. Decis. 1873, p. 82; *In re* Grove, 67 Off. Gaz. 1447. The coat-of-arms of the United States, or either of the states, will not be admitted to registration. *Ex parte* Schmachtenberg Bros., 51 MSS. D. 204.

Nor will a descriptive word: as "Albany Beef," for canned sturgeon, *In re* Ames, 23 Off. Gaz. 344; "Chili Colorow," for table sauce, *In re* Railton, 25 MSS. D. 321; "Time-Keeper," for watches, *Ex parte* Strasburger & Co., 20 Off. Gaz. 155; "Cristalline," for artificial jewels, *Ex parte* Kipling, 24 Off. Gaz. 899.

Nor a picture or word that is descriptive or deceptive. *Ex parte* Martin, 89 Off. Gaz. 2258; *Ex parte* Wolf, 80 Off. Gaz. 1271; *Ex parte* Grove, 67 Off. Gaz. 1447.

Nor a geographical word: as "Cromarty," for dried fish, *In re* Proctor, Jr., 51 Off. Gaz. 1785; "Trenton," for saws, *In re* American Saw Co., 58 Off. Gaz. 521; "Cloverdale," *In re* Hendley, 72 Off. Gaz. 1654. In many instances, however, where the commissioner has deemed the geographical word to be used in a purely arbitrary sense it has been admitted to registration. *In re* Cornwall & Bros., 12 Off. Gaz. 312; *Ex parte* Tietgens & Robertson, 87 Off. Gaz. 2117. The following extracts from leading rulings of the Patent Office may serve as guides for applicants seeking registration for geographical words. Their registrability "is to be determined in view of the circumstances of each particular case. * * * One geographical name might be either descriptive or deceptive; another geographical name applied to the same article might be neither." Thus, it was held that it having become a common practice to apply the words "Irish," "Limerick," etc., to soap, there was no objection to registering the word "Dublin," as applied to soap; in view of the state of the trade and the nature of the article, "Dublin" applied to soap manufactured in this country, was neither descriptive nor deceptive. This doctrine was announced in a decision of Acting Commissioner Doolittle, refusing registration for the word "French" as applied to American made paints on the ground that it was deceptive. *In re* J. Marsching & Co., 15 Off. Gaz. 294. In a later decision, refusing registration to the word "Cloverdale" as a trademark for canned fruits and vegetables, Acting Commissioner Fisher announced the following classification: "Geographical names may for convenience be divided into three classes; first, those that are well known and in common use—such, for example, as 'United States,' 'New York,' 'San Francisco,' etc. The law is settled that words coming under this class ought not to be registered. The second class includes words which in their primary significance are not geographical, even though they may appear in the Postal Guide or similar publications. Such words as 'trilby,' 'creole,' 'puritan' and 'volunteer,' are good examples of this class. These words, it seems to me, ought not to be refused registration on the ground that they are geographical, since it can not fairly be said that they are 'words in common use as designating locality or sec-

as such by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant,[25] nor which is identical with a registered or known trademark [26] owned by another and

tion of a country.' The third class would logically occupy a position between the two classes mentioned above, and it consists of words which primarily have a geographical meaning—for example, terms ending or compounded with such words as 'city,' 'town,' 'shire,' 'mount,' or 'mont.' Such words, I think, should not be registered, for the reason that they are clearly geographical in their primary significance, even if it can not be said that they are widely enough known to come strictly under the first class. It seems to me that the word in question, 'Cloverdale,' clearly comes under the third class." *Ex parte* Hendley, 72 Off. Gaz. 1654. A geographical word does not become properly registrable by being enclosed in a geometrical figure. So the word "Yucatan" was refused registration as a mark for leather, even though enclosed in a square figure. *Ex parte* Weil, 83 Off. Gaz. 1802.

25—This prohibition is strictly enforced. Even a name used as a mark for twenty years, and admitted to registration under the Act of 1870 has been refused registration under this statute. *In re* Fairchild, 21 Off. Gaz. 789. Congress by an enactment under date of August 5, 1882, provided: "That nothing contained in the law (of March 3, 1881), shall prevent the registry of any lawful trademark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act." 22 Stats. at Large, p. 298. This proviso has admitted to registration names of corporations, as, for example, the words "Union Metallic Cartridge Co.," which were in use as merchandise marks prior to March 3, 1881. But no name of a corporation not used prior to that time as a mark can now be admitted to registration. *Ex parte* Creedmore Cartridge Co., 56 Off. Gaz. 1333. And see note to the Act of August 5, 1882. Registration has been refused to a name as part of a trademark which also included a device. *Ex parte* Adriance, Platt & Co., 20 Off. Gaz. 1820. But a name used as part of an old combination trademark has been admitted to registry. *Ex parte* Freiberg & Workum, 20 Off. Gaz. 1164. A proper name joined to a geographical name does not constitute a valid trademark, therefore "Buffalo Pitts" was refused registration as a trademark for threshing machines. *Ex parte* Buffalo Pitts Co., 89 Off. Gaz. 2069.

26—Registration has been refused where the applicant's mark, "Triumphant" for flour, had been registered by another under the Act of 1870, and not re-registered under the Act of 1881. *Ex parte* Lyon, Dupuy & Co., 28 Off. Gaz. 191; Dyrenforth, Acting Commissioner, tersely observing that "To decide otherwise would be to open Pandora's box and turn loose fraud

appropriated to the same class of merchandise, or which so nearly resembles some other person's lawful trademark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers.[27] In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trademark; [28] and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable, the practice of courts of equity of the United States in analogous cases. [29]

upon individuals and imposition upon the public." The fact that the applicants used the mark in foreign commerce while the record did not show the registrant to have done so was held immaterial. *Ibid;* and to the same effect, Yale Mfg. Co. v. Yale, 30 Off. Gaz. 1183. A trademark consisting of a design will not be admitted to registration, when the same design has been embodied in a design patent granted to another. *Ex parte* Lee & Shepard, 24 Off. Gaz. 1271.

27—The commissioner must decide, "first, if the applicant has actually used the trademark in lawful commerce with foreign nations or with the Indian tribes, and then if he has the right to the use of it at all. If he finds that the alleged trademark is the name of the applicant or any other name which can not lawfully be converted into a trademark at common law, or that it is identical with the trademark of another, registered or unregistered, or is a deceptive imitation of another, or that it is not the property of the applicant, he can not admit it to registration, though he may be satisfied that the applicant has used it in regular commerce with foreign nations or the Indian tribes." Court of Appeals, District of Columbia, by Sheppard, J., in United States v. Seymore, 66 Off. Gaz. 1167-1169. Where a part of the applicant's mark was the word "Railway," which word had been registered by another, the application was refused. *Ex parte* Strasburger & Co., 20 Off. Gaz. 155. The question presented to the commissioner upon an issue of anticipation is "whether the trademark sought to be registered is so similar to any trademark already registered for use upon the same class of articles as to be calculated to deceive purchasers using ordinary caution." Frothingham, Assistant Commissioner, in *Ex parte* George B. Hurd & Co., 59 Off. Gaz. 1763; and to the same effect, *Ex parte* Coon, 58 Off. Gaz. 946.

28—No court can grant registration nor direct the action of the commissioner by *mandamus*. His duties are not ministerial, but require the exercise of judgment and discretion. His performance of those duties will not be reviewed on or controlled by *mandamus*. United States v. Seymour, 66 Off. Gaz. 1167-1172; 153 U. S. 353; 38 L. Ed. 742.

29—Under this provision the commissioner has power to declare

SECTION 4. That certificates of registry of trademarks shall be issued in the name of the United States of America under the seal of the Department of the Interior, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the specifications, shall be kept in books for that purpose. Copies of trademarks and of statements and declarations filed therewith, and certificates of registry so signed and sealed, shall be evidence in any suit in which such trademarks shall be brought in controversy.[30]

an interference, even between a partnership and one of its members. If the applicant shows better title he will be admitted to registration notwithstanding a prior registry. Yale Mfg. Co. v. Yale, 30 Off. Gaz. 1183. In such a case the burden of proof to establish priority is upon the applicant. Manitowoc Mfg. Co. v. Dickerman, 57 Off. Gaz. 1721. In cases of interference the question presented to the commissioner is substantially the same as would arise in a court of equity if either of the parties were seeking to enjoin the other from the use of the mark. *Ibid.* In interferences the issue is as broad as the broadest claim. S. Hernsheim Bros. & Co. (Ltd.) v. J. H. Hargrave & Son, 81 Off. Gaz. 503; Joseph Banigan Rubber Co. v. Bloomingdale, 89 Off. Gaz. 1670. By sec. 9 of the act establishing the Court of Appeals of the District of Columbia that court is given the determination of appeals from the decision of the Commissioner of Patents "in any interference case." That court has held that this clause does not refer to or include trademark interferences. Einstein v. Sawhill, 65 Off. Gaz. 1918. An applicant presented for registration a mark substantially the same as one registered by another under the Act of 1870, which had not been re-registered under the Act of 1881. Registration was refused by the examiner. The applicant then sought to institute an interference; this was refused because the former registration was void. Under all the facts the commissioner notified the registrant under the Act of 1870 that an application for registry was pending with which his registry would interfere if it were a registry under the Act of 1881, and that sixty days would be allowed wherein the former registrant might make an application under the Act of 1881 with a view to interference. *Ex parte* American Lead Pencil Co., 61 Off. Gaz. 151.

30—The decision of the Commissioner of Patents upon interference proceedings was held under the Act of 1870 to render the issues presented to him *res adjudicata* and they can not be reopened in a subsequent proceeding between the parties. Hanford v. Westcott, Fed. Case No. 6,022; 16 Off. Gaz. 1181. But in passing upon the same question under the Act of 1881 Judge Adams said, of Hanford v. Westcott, "if the reasoning of that case was ever persuasive, it can not be considered

SECTION 5. That a certificate of registry shall remain in force for thirty years from its date, except in cases where the trademark is claimed for and applied to articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it shall cease to have any force in this country by virtue of this act at the time that such trademark ceases to be exclusive property elsewhere. At any time during the six months prior to the expiration of thirty years, such registration may be renewed on the same terms and for a like period.[31]

SECTION 6. That applicants for registration under this act shall be credited for any fee or part of a fee heretofore paid into the Treasury of the United States with intent to procure protection for the same trademark.[32]

SECTION 7. That registration of a trademark shall be *prima facie* evidence of ownership.[33] Any person who shall reproduce, counterfeit, copy or colorably imitate any trademark registered

so in the light of the changes in the law since it was rendered." A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 123 Fed. Rep. 149, 152.

31—See Act of 1870, § 78, *ante*.

32—The fee for registration under the Act of 1881 was required to be paid upon filing the application.

The sum of $10 paid as a first fee under the Act of 1870 was credited upon this payment on application pending in the Patent Office when the Act of 1881 went into effect.

But all persons to whom registration was granted under the Act of 1870 were entitled to register under this act without additional charge. Jacoby & Co. v. Lopez, 23 Off. Gaz. 342.

33—As to the evidenciary value of the certificate of registration, see Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S. 665-672, 45 L. Ed. 377; Brower v. Boulton, 7 C. C. A. 567; 58 Fed. Rep. 888; United States v. Duell, 17 App. D. C. 478; Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 824; Hennessy v. Braunschweiger, 89 Fed. Rep. 664; Welsbach Light Co. v. Adam, 107 Fed. Rep. 463. That this section has no bearing upon the jurisdiction of a state court in a proceeding under a state statute see People v. Molins, 10 N. Y. Supp. 130.

Thus the registration of a mark by another throws the burden of proving priority upon one who subsequently applies for registration for the same mark. Manitowoc Mfg. Co. v. Dickerman, 57 Off. Gaz. 1720. See Act of 1870, § 78, 79; *ante*.

under this act, and affix the same to merchandise of substantially the same descriptive properties as those described in the registration,[34] shall be liable to an action on the case for damages for the wrongful use of said trademark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trademark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.[35]

SECTION 8. That no action or suit shall be maintained under the provisions of this act in any case when the trademark is used in any unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or under any certificate of registry fraudulently obtained.[36]

SECTION 9. That any person who shall procure the registry of a trademark, or of himself as the owner of a trademark, or an entry respecting a trademark, in the office of the Commissioner

34—As to what is "merchandise of substantially the same descriptive properties," see Air-Brush Mfg. Co. v. Thayer, 84 Fed. Rep. 640; Mass, Ratcliff & Gretton (Ltd.), v. Feigenspan, 96 Fed. Rep. 206.

Blanks and envelopes used by a telegraph company are not "merchandise" within the meaning of this section. Postal Tel. Cable Co. v. Netter, 102 Fed. Rep. 691.

35—Registration of a mark common to the trade does not confer an exclusive right to its use. Stachelberg v. Ponce, 128 U. S. 686, 32 L. Ed. 569. Registration of a mark is not conclusive. Its use may be restrained at the suit of one who has a prior right to its use. Glen Cove Mfg. Co. v. Ludeling, 22 Fed. Rep. 824, 826; Schumacher v. Schwenke (2), 36 Off. Gaz. 457; Hennessy v. Braunschweiger, 89 Fed. Rep. 664.

The registrant will not be protected in the use of his trademark if it is found to contain a material false representation. Seabury v. Grosvenor, 14 Blatchf. 262.

Jurisdictional amount.—The amount in controversy is the value of the trademark. Symonds v. Greene, 28 Fed. Rep. 834; Hennessy v. Herrmann, 89 Fed. Rep 669.

36—This provision is merely in declaration of the common law. See Act of 1870, § 84, *ante*.

of Patents, by a false or fraudulent representation or declaration, orally or in writing, or by any fraudulent means, shall be liable to pay any damage sustained in consequence thereof to the injured party, to be recovered in an action on the case.[37]

SECTION 10. That nothing in this act shall prevent, lessen, impeach or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trademark might have had if the provisions of this act had not been passed.[38]

SECTION 11. That nothing in this act shall be construed as unfavorably affecting a claim to a trademark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same state, unless the trademark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.[39]

SECTION 12. That the Commissioner of Patents is authorized to make rules and regulations and prescribe forms for the transfer of the right to use trademarks and for recording such transfers in his office.[40]

37—See Act of 1870, § 82, *ante*.

38—See Act of 1870, § 83, *ante*. "The present act does not abridge or qualify the common law right, but by the express term of sec. 10 preserves it intact." Wallace, J., in LaCroix v. May, 15 Fed. Rep. 236.

39—See Act of 1870, § 78, *ante*. Where both parties are citizens of the same state the averments of the complaint must show that both the parties are using the mark in commerce with foreign nations or with the Indian tribes. Ryder v. Holt, 128 U. S. 525, 32 L. Ed. 529; Luyties v. Hollender (1), 21 Fed. Rep. 281; Schumacher v. Schwenke, 26 Fed. Rep. 818; Luyties v. Hollender (2), 30 Fed. Rep. 632; Gravely v. Gravely, 42 Fed. Rep. 265; Prince's Metallic Paint Co. v. Prince Mfg. Co., 53 Fed Rep. 493. Such an averment is necessary only where the proceeding is between citizens of the same state. It is not necessary where the complainant is an alien. Hennessy v. Braunschweiger, 89 Fed. Rep. 664.

40—See Act of 1870, § 81. This section provides for transfers only being registered. An instrument affecting the use of a trademark, but not amounting to a transfer or assignment thereof, can not legally be registered in the Patent Office. Waukesha Springs Co. v. Hygeia Water Co., 63 Fed. Rep. 438-442.

SECTION 13. That citizens and residents of this country wishing the protection of trademarks in any foreign country, the laws of which require registration here as a condition precedent to getting such protection there, may register their trademarks for that purpose as is above allowed to foreigners, and have certificate thereof from the Patent Office.[41]

41—"One reading the section would infer that foreigners have been allowed under the preceding sections some privilege; but a careful reading of the act fails to disclose that a foreigner is entitled to any other or further rights than those given to citizens of the United States. The phrase 'as is above allowed to foreigners' renders the section meaningless." Duell, Commissioner, in *Ex parte* Buffalo Pitts Co., 89 Off. Gaz. 2069.

APPENDIX E.

TRADEMARK ACT OF FEBRUARY 20, 1905.

(33 Stat. L., 728.)

SECTION 1. (As amended May 4, 1906, ch. 2081, 34 Stat. L. 168; February 18, 1909, ch. 144, 35 Stat. L. 627.) That the owner of a trademark used in commerce with foreign nations, or among the several states, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States, or resides in or is located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, may obtain registration for such trademark by complying with the following requirements: First, by filing in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which the trademark is appropriated; a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trademark has been used; a description of the trademark itself shall be included, if desired by the applicant or required by the Commissioner, provided such description is of a character to meet the approval of the Commissioner. With this statement shall be filed a drawing of the trademark, signed by the applicant, or his attorney, and such number of specimens of the trademark as actually used as may be required by the Commissioner of Patents. Second, by paying into the Treasury of the United States the sum of ten dollars, and otherwise complying with the requirements of this act and such regulations as may be prescribed by the Commissioner of Patents.

The enactment of a law whose provisions should extend to the owners of trademarks used in interstate commerce was inspired by the omission of such a provision in the Act of 1881. Concerning that act, Mr. Chief Justice Fuller has said, that "Obviously

the act was passed in view of the decision that the prior act was unconstitutional, and it is, therefore, strictly limited to lawful commerce with foreign nations and with Indian tribes. It is only the trademark used in such commerce that is admitted to registration, and it can only be infringed when used in that commerce, without right, by another than its owner." [1]

Sec. 1 of the Act of 1881 was substantially identical with the above section in other respects, except that the above section requires specimens of the trademark as actually used to be filed, and reduces the government fee from twenty-five dollars to ten dollars.

Sec. 1 should be read in connection with the following sections of the Act of May 4, 1906, 34 Stat. L. 169:

Sec. 2. (Classes of merchandise to be established, etc.) That the Commissioner of Patents shall establish classes of merchandise for the purpose of trademark registration, and shall determine the particular descriptions of goods comprised in each class. On a single application for registration of a trademark the trademark may be registered at the option of the applicant for any or all goods upon which the mark has actually been used comprised in a single class of merchandise, provided the particular descriptions of goods be stated.

Sec. 3. (Rights of trademarks used on products of American factories.) That any owner of a trademark who shall have a manufacturing establishment within the territory of the United States shall be accorded, so far as the registration and protection of trademarks used on the products of such establishment are concerned, the same rights and privileges that are accorded to owners of trademarks domiciled within the territory of the United States by the act entitled: "An act to authorize the registration of trademarks used in commerce with foreign nations or among the several states or with Indian tribes, and to protect the same." Approved, February twentieth, nineteen hundred and five.

Sec. 4. (Effect.) That this act shall take effect July first, nineteen hundred and six.

Form or appearance of merchandise not registrable.—The structural form of an article is not registrable under this act, because "a trademark registration * * * would give * * * a perpetual monopoly. The Trademark Act can not be used as an avenue to escape the limitations of the patent law." Van Orsdel, J., in *Herz v. Lowenstein*, 40 App. D. C. 277; 192 O. G. 993. "That the applicant can have no trademark in the form or appearance of the merchandise is well settled." Allen, Com., in *Ex parte Dodge Mfg. Co.*, 128 O. G. 2531, C. D. 1907, 173.

"Affixed to goods."—The affixion required by this section has been interpreted to be of such character as to definitely associate

1—Warner v. Searle and Hereth Co., 191 U. S. 195, 204, 48 L. Ed. 147.

the mark with the goods. "The usual definition of a trademark includes the limitation that it must be 'affixed' to the goods. The limits of the conditions which will satisfy this requirement are not very clearly defined in the adjudicated cases which I have been able to find. A mark is very commonly applied or affixed to the goods themselves, as by printing, engraving, or embossing. In many cases it is impossible or inconvenient to affix the mark to the commercial article itself, as in the case of liquids, powder, etc., and in these cases it has been held sufficient ordinarily to affix the mark to the packages in which the goods are sold. It has also been held in a decision by Mr. Commissioner Duell, in the case of *Hay & Todd Mfg. Co. v. Querns Bros.* (C. D. 1899, 25; 86 O. G. 1323) that it is unnecessary to attach physically the label containing the mark to the packages of goods, but that it is sufficient to place the label bearing the mark in the package containing the goods. On the other hand, it has been held that a mere advertisement of the goods associated with a mark is not such a use of the mark as will create a trademark right (*St. Louis Piano Mfg. Co. v. Merkel*, 1 Mo. App. 305; *Hazelton Boiler Co. v. Tripod Boiler Co.*, 142 Ill. 494; *Hartshorn v. Philbrick*, C. D. 1902, 427; 101 O. G. 2077), nor the use of a mark in ordering goods or selling them to customers (*Thompson v. Montgomery*, 6 R. P. C. 404). In the case at bar the mark was not printed or impressed upon the goods sent out for use, for this would have rendered them unfit for the object intended, nor was the mark placed on the packages or on a label placed in the packages; but the mark was plainly printed on samples of the press-board identical in all respects with that furnished to customers except as to size. These samples could not be put into presses and used in the way press-boards are ordinarily used; but they could be otherwise tested as to color, thickness, quality, etc., so that persons who received them could determine the advisability of ordering press-boards of the quality exhibited, and when so ordered and the orders were filled could determine whether the goods furnished were of the quality of the sample. Thus purchasers were able to definitely associate the particular mark with a particular class and quality of goods, and this is believed to be the valid requisite to the establishment of a property right in a mark. In Powell's case (66 L. J. Ch. 303), Bowen, L. J., said:

> "'The function of a trademark is to give an indication to the purchaser or possible purchaser as to the manufacture or quality of the goods, to give an indication to his eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market.'

"By placing in the hands of the public samples of goods with the trademark printed thereon it is believed that Murphey &

Company have so associated the mark with the goods as to tell the public from what source they come and that they have for this reason exclusive right to the use thereof." Moore, Com., in *Case Bros. v. Murphey & Co.*, C. D. 1908, 196; 136 O. G. 225.

Applicant's right to claim trademark matter free from accessories.—That the applicant is under no compulsion to claim as a trademark all the matter shown on his specimens or fac-similes would seem self-evident. "When an applicant presents his alleged mark for registry under the Act approved February 20, 1905, who is to determine of what the mark consists? If, as in the present case, the mark is impressed upon a label, and, in addition to the matter claimed as the trademark by an applicant, certain accessories are shown, is the power vested in the Commissioner of Patents to say to applicant, you must describe or show your mark not only as consisting of what you say it is, but you must include such portion of the accessories, or parts of the label as I think are a material portion of the mark, although you may think otherwise. The power is an autocratic one and its possession by the Commissioner of Patents can not be presumed but must, we think, be set forth in the statute with reasonable clearness. * * * Nowhere in the act do we find any power vested in the Commissioner of Patents to decide for the applicant the scope of the trademark. * * * We repeat that we do not think that Congress intended to confer upon the Commissioner of Patents authority to say to an applicant how much or how little of the embellishments appearing in connection with what may be called the essential feature of a trademark, form an actual part of the trademark. Rather do we think that this right of selection and designation rests with the applicant. No general rule can possibly be applied, and where this is the case it is unwise to attempt to exercise a power not expressly vested in an executive office. The proper forum for the decision of such questions is the courts, where each case can be passed upon as it arises." *In re Standard Underground Cable Co.*, 27 App. D. C. 320, 123 O. G. 656; followed in *Graves v. Gunder*, 136 O. G. 227.

Specimens.—Following this section, Rule 22, *post*, requires the filing of five specimens or fac-similes of the trademark as actually used. If the Examiner believes that the specimens filed do not disclose an actual use of the trademark he may refuse registration on that ground, and his action may be reviewed by appeal, but not by petition. *Ex parte Barclay & Barclay*, 134 O. G. 1562. So on an application to register the words "Library Slips" as a trademark for trading coupons the specimens showed the words in a number of places on the coupon but always in connection with other words. They were not so used as to suggest they were arbitrary words used to indicate origin or ownership of the coupons

and registration was therefore denied. *Ex parte Magazine & Book Co.*, 135 O. G. 661.

Copy of application for use in litigation.—A copy of the file of a pending or abandoned application for registration will not be furnished to a stranger to the record except when a judge before whom a suit is pending certifies that a copy of the application would be material and relevant for the party requesting the same. *In re John C. Dowd & Co.*, C. D. 1908, 134; 134 O. G. 1297.

Application not prima facie evidence of ownership.—In an opposition proceeding, the applicant's application is not *prima facie* evidence of ownership of the mark. *Green, Tweed & Co. v. Manufacturer's Belt Hook Co.*, 137 O. G. 2221.

Registration of matter formerly copyrighted.—"The appellant further urges that registration should not be granted Forbes because he has registered under the copyright laws a label embodying his present trademark. It is urged that to register the trademark now would be to extend the monopoly secured by the copyright registration and that such extension would be contrary to the intent of the law. The appellant seems to suppose that the same principle is involved as that underlying the decisions of the courts, to the effect that the name given to a patented article is public property after the expiration of the patent. I can not agree that the principle applies. Copyrights and trademarks are separate and distinct rights, and the trademark is not the mere name of the copyrighted picture. It is the symbol by which the goods are known. Others may take the picture and call it what they please after the expiration of the copyright and may adopt it as a trademark for goods. The registrant has an equal right with others in that respect. If, as here, he adopts it as a trademark for particular goods, others may not adopt and use it for the same goods unless they were first in the field." Allen, Com., in *Rosenzweig v. Forbes*, 121 O. G. 2667; C. D. 1906, 155.

Assignment of trademark—Re-registration by assignee.—The rights under a registration being transferable, it is not necessary for the assignee to re-register in his own name, as was formerly held in *Ex parte Bassett*, 55 O. G. 997; C. D. 1891, 69, which is now overruled, *Frank & Gutmann v. McWilliam*, 114 O. G. 542; C. D. 1905, 17.

Application—Signature.—The signature to the drawing and the statement must correspond exactly. *Ex parte Boston Fountain Pen Co.*, 116 O. G. 2531; C. D. 1905, 225.

Application—Description.—As sec. 1 requires "a description of the trademark itself" as well as a drawing, a reasonably definite description of the mark is required. *Ex parte Carborundum Co.*, 118 O. G. 2250; C. D. 1905, 433.

Application—"One trademark right" rule.—One application can not embrace items of merchandise not of the same descriptive properties. *Ex parte Harris*, 117 O. G. 903; C. D. 1905, 255. A requirement of division made on this ground is in effect a rejection for the reason that the application "covers more than one trademark right;" the action of the Examiner is reviewable by appeal, and not upon petition. *Ex parte Kingan Packing Assn.*, 119 O. G. 2234; C. D. 1905, 538. See sec. 2, Act of May 4, 1906, 34 Stat. L. 169, *supra*.

Application—Agreement between drawing and description.—There must be no inconsistency between the drawing and the description, even though the variance is trifling. A word hyphenated in the drawing must be so written in the description. *Ex parte Atkins & Co.*, 119 O. G. 2236; C. D. 1905, 544.

SECTION 2. (As amended February 18, 1909, ch. 144, 35 Stat. L. 627.) That the application prescribed in the foregoing section, in order to create any right whatever in favor of the party filing it, must be accompanied by a written declaration verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, to the effect that the applicant believes himself or the firm, corporation, or association in whose behalf he makes the application to be the owner of the trademark sought to be registered, and that no other person, firm, corporation, or association, to the best of the applicant's knowledge and belief, has the right to use such trademark in the United States, either in the identical form or in such near resemblance thereto as might be calculated to deceive; that such trademark is used in commerce among the several states, or with foreign nations, or with Indian tribes, and that the description and drawing presented truly represent the trademark sought to be registered. If the applicant resides or is located in a foreign country, the statement required shall, in addition to the foregoing, set forth that the trademark has been registered by the applicant, or that an application for the registration thereof has been filed by him in the foreign country in which he resides or is located, and shall give the date of such registration, or the application thereof, as the case may be, except that in the application in such cases it shall not be necessary to state that the mark has been used in commerce with the United States or among the states thereof. The verification required by this section may be made before any person within the United States authorized by law to administer oaths, or,

when the applicant resides in a foreign country, before any minister, *charge d'affaires,* counsel, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States.

This section embraces the matter included in sec. 2 of the Act of 1881, with additional provisions concerning the requirements of the statements to be made by a resident of a foreign country.

"*Statement,*" refers not to the particular document which is ordinarily termed the "statement" of the application, but to all the facts set forth by the applicant in the declaration. *Ex parte Koniglíches Hofbrauam & Munchen,* 146 O. G. 720.

SECTION 3. That every applicant for registration of a trademark, or for renewal of registration of a trademark, who is not domiciled within the United States, shall, before the issuance of the certificate of registration, as hereinafter provided for, designate, by a notice in writing, filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings affecting the right of ownership of the trademark of which such applicant may claim to be the owner, brought under the provisions of this act or under other laws of the United States, may be served, with the same force and effect as if served upon the applicant or registrant in person. For the purposes of this act it shall be deemed sufficient to serve such notice upon such applicant, registrant, or representative by leaving a copy of such process or notice addressed to him at the last address of which the Commissioner of Patents has been notified.

This section is new and made desirable by the provisions of sec. 2 providing for the registration of marks by persons domiciled in foreign countries. In the manner indicated, effective service can be had in case suit is instituted involving the mark registered.

The designation of a resident in the United States required by this section must be made by the foreign applicant; the authority to make such designation can not be delegated to an attorney. *Ex parte E. Wertheimer & Cie.,* 132 O. G. 679.

SECTION 4. That an application for registration of a trademark filed in this country by any person who has previously regularly filed in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States, an application for registration of the same trademark shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same trademark was first filed in such foreign country: *Provided*, That such application is filed in this country within four months from the date on which the application was first filed in such foreign country: *And provided*, That certificate of registration shall not be issued for any mark for registration of which application has been filed by an applicant located in a foreign country until such mark has been actually registered by the applicant in the country in which he is located.

This section is new in the present act, and is intended for the protection of applicants who have previously filed an application for registration in a foreign country wherein reciprocal privileges are extended to citizens of the United States. Its provisions are in furtherance of Article 4 of the International Convention.

"Art. 4. Anyone who shall have regularly deposited an application for a * * * trade or commercial mark in one of the contracting states shall enjoy for the purpose of making the deposit in the other states, and under reserve of the rights of third parties, a right of priority during the periods hereinafter determined.

"In consequence, the deposit subsequently made in one of the other states of the Union before the expiration of these periods can not be invalidated by acts performed in the interval, especially by another deposit, * * * by the employment of the mark.

"The periods of priority above mentioned shall be * * * three months for trade or commercial marks. They shall be augmented by one month for countries beyond the seas."

SECTION 5. (As amended March 2, 1907, ch. 2573, 34 Stat. L. 1251; February 18, 1911, 36 Stat. L. 918; January 8, 1913, ch. 7, 37 Stat. L. 649.) That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trademark on account of the nature of such mark unless such mark—

"(*a*) Consists of or comprises immoral or scandalous matter.

"(*b*) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any state or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any state in the United States prior to the date of the adoption and use by the applicant: *Provided,* That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: *Provided,* That trademarks which are identical with a registered or known trademark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trademark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered: *Provided,* That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this act: *Provided further,* That no portrait of a living individual may be registered as a trademark except by the consent of such individual, evidenced by an instrument in writing: *And provided further,* That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several states or with Indian tribes which was in actual and exclusive use as a trademark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February twentieth, nineteen hundred and five: *Provided further,* That nothing herein shall prevent the registration of a trademark otherwise registrable because of its being the name of the applicant or a portion thereof."

The Committee on Patents of the House of Representatives, in their report recommending the passage of the act, said in reference to this section:

"In the past there has been considerable complaint in regard to what could be registered under the existing law as a trademark. Much of the time of the committee in the hearing of the bill has been consumed in a discussion upon this particular feature of the legislation. Sec. 5 of the proposed bill, we believe, will permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trademark and become the exclusive property of the party using the same as his trademark.

"The language of sec. 5 is taken almost verbatim from sec. 5 of the bill proposed by Mr. Arthur P. Greeley, as contained in the report of the Commissioners appointed to revise the statutes relating to patents, trade and other marks, and trade and commercial names, under the Act of Congress, approved June 4, 1898. Full protection is given by the court, under the doctrine of unfair competition, to the users of such marks as do not, under the common law, constitute technically what is known as a trademark, and which can become the subject of exclusive ownership. By other sections of the bill, to which attention will be called later, provision is made for an appeal from the decision of the Commissioner of Patents to the District Court of the District of Columbia from a decision refusing the registration of a trademark. By these provisions of the bill it would seem that there could not be a conflict of decisions, about which so much complaint has been made in the past. Through the decisions of the courts a uniform system and uniform rules governing and controlling the registration of marks will in time be adopted.

"A proviso has been added permitting all marks that have been in actual use as trademarks for a period of ten years to be registered."

See the Act of August 5, 1882:

"That nothing contained in the law entitled 'An act to authorize the registration of trademarks and protect the same,' approved March third, eighteen hundred and eighty-one, shall prevent the registry of any lawful trademark rightfully used by the applicant in foreign commerce or commerce with Indian tribes at the time of the passage of said act."

This act is based on the provisions of the British trademark law in reference to what are known as "old marks"; that is, marks in use prior to the date of the passage of the first law which provided for registration of trademarks and defined what should be registrable as trademarks. This provision is

found in sec. 64 of the Patents, etc., Acts, 1883-1888, and is as follows:

"(3) *Provided* as follows:

* * * * * * * *

"(ii) Any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures, used as a trademark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trademark under this part of this act."

"*So nearly resemble.*"—The test is whether "the applicant's mark so nearly resembles the registered trademarks cited as to be likely to cause confusion in the mind of the public and to deceive purchasers." Moore, Com., in *Ex parte Satzman & Forman*, 134 O. G. 2243. "The purpose of the act was to protect and not to deceive the public. The language used empowers the Commissioner to exercise his discretion as to whether a proposed mark should be registered, if in his opinion its registration will 'be likely to cause confusion or mistake in the mind of the public' or 'deceive purchasers,' he is bound to reject it." Robb, J., in *Re S. C. Herbst Importing Co.*, 30 App. D. C. 297, 134 O. G. 1565. "We agree with the Commissioner that the resemblance is such as to produce the confusion in trade which it is the object of the Trademark Act to prevent." Shepard, C. J., in *Re Indian Portland Cement Co.*, 30 App. D. C. 463, 134 O. G. 518.

ILLUSTRATIONS.

Under this section the following marks sought to be registered have been refused registration because of the prior use of the marks set opposite them.

The Mark.	*The Prior Mark.*
"AA."	"AI."[2]
"American Lady."	"American Girl."[3]
"Autola."	"Au-to-do."[4]
"Chewies."	"Chewso."[5]
"Chlologestin."	"Clologen."[6]
"Creo-Carbolin."	"Carbolineum."[7]
"Dyspepticide."	"Dyspepticure."[8]
"Edelweiss-Maltine."	"Maltine."[9]

2—Craver's Sons v. Conklin & Sons, 165 O. G. 241.

3—Wolf Bros. & Co. v. Hamilton-Brown Shoe Co., 125 O. G. 667.

4—*Ex parte* J. Fred Wilcox Co., 153 O. G. 546.

5—*Ex parte* McInnerney, 85 O. G. 148.

6—Breitenbach & Strong Co. v. Rosenberg, 167 O. G. 763.

7—*In re* Barrett Mfg. Co., 167 O. G. 513.

8—*Ex parte* Foley & Co., 87 O. G. 1957.

9—Peter Schoenhofen Brew. Co. v. Maltine Co., 134 O. G. 1804.

The Mark.	*The Prior Mark.*
"Florodora."	"Floridena." [10]
"Green Ribbon."	"Green River." [11]
"La Vona."	"Larona." [12]
"Maple Leaf."	"Silver Leaf." [13]
"Nayassett."	"Nassae." [14]
"Old Dutch."	"Royal Dutch." [15]
"Olivoint."	"Oliveine." [16]
"Omnaline."	"Omnia." [17]
"Piano-Auto."	"Autopiano." [18]
"Powellton."	"Powell's Run." [19]
"Sunshine."	"Sunbeam." [20]

Effect of combining non-registrable words.—To combine two or more words, each of which is non-registrable, does not make the combination registrable.

ILLUSTRATIONS.

"Lexington Club," whiskey, *Kentucky Distilleries & Warehouse Co. v. Old Lexington Club Distilleries Co.*, 31 App. D. C. 223, 135 O. G. 220; "Toledo Premium," dry goods, *Ex parte Lewis & Co.*, 66 MSS. Dec. 219, 1908 Com. Dec. 170; "America's Strength," coffee, *Ex parte Meyer Bros. Coffee & S. Co.*, 135 O. G. 893; "Rust? Never!" hooks and eyes, *Ex parte De Long Hook & Eye Co.*, 128 O. G. 885.

"Misbranding" (within the meaning of the Food and Drugs Act) as a bar to registration.—The Food and Drugs Act of June 30, 1906, contains the following provision: "Sec. 8. That the term 'misbranded' as used herein shall apply to all drugs, or articles of food, or articles which enter into the composition of food, the package or label of which shall bear any statement, design, or device regarding such article, or the ingredients or substances contained therein which shall be false or misleading in any particular, and to any food or drug product

10—*Ex parte* Grossmith, 100 O. G. 2175.

11—Lang v. Green River Dist. Co., 148 O. G. 280.

12—*Ex parte* Neuman, 159 O. G. 993.

13—*Ex parte* Vogel & Son, 99 O. G. 2321.

14—*Ex parte* Brown & Co., 143 O. G. 561.

15—*Ex parte* Dayton Spice Mills, 135 O. G. 893.

16—*Ex parte* Cross, C. D. 1907, 125; 128 O. G. 455.

17—*Ex parte* Nicholaus, 161 O. G. 268.

18—*Ex parte* Auto Grand Piano Co., 155 O. G. 307.

19—*Ex parte* Mt. Carbon Co., 150 O. G. 828.

20—*Ex parte* Austin, Nichols & Co., 167 O. G. 981.

which is falsely branded as to the state, territory, or country in which it is manufactured or produced." It has been held that "it is incumbent upon the Patent Office in considering the registrability of trademarks to co-operate with the other departments of the Government in the observance of the provisions of this act, and to that end it is the duty of the Examiner of Trademarks to refuse to register a mark when in his opinion statements are contained in the label presented which fall under the category defined as 'misbranded' in the Food and Drugs Act above referred to." Moore, Com., in *Ex parte Barclay & Barclay*, C. D. 1908, 154, 135 O. G. 217.

False representation on labels a bar to registration.—"It was the purpose of the act to protect honest manufacturers and dealers because in so doing the public would in turn be protected. It was not the purpose of the act to recognize the right of any person, firm, or corporation, to deceive the public by the use of a deceptive mark. In other words, the Government will not become a party to a fraud." Robb, J., in *Levy & Co. v. Uri*, 31 App. D. C. 441, 135 O. G. 1363.

Controlling and distinguishing feature must be registrable.—That the controlling and distinguishing feature must be registrable, or the mark as a whole will not be registered, see *In re Crescent Typewriter Supply Co.*, 30 App. D. C. 324, 133 O. G. 231; *In re Hopkins*, 29 App. D. C. 118, 128 O. G. 890; *Ex parte Union Carbide Co.*, 135 O. G. 160.

"Descriptive of the goods."—"The Act of 1905, chapter 84, sec. 5, only declared the accepted law of trademarks when it prohibited the registration of marks which consists—'merely in words or devices which are descriptive of the goods with which they are used, or of the character of such goods.'

"The general proposition was well established that words merely descriptive of the character, qualities or composition of an article or of the place where it was manufactured or produced, could not be monopolized as a trademark." McComas, J., in *Re National Phonograph Co.*, C. D. 1907, 550, 128 O. G. 1295.

Examples of marks held non-registrable because descriptive.—"No-rip," harness sweat-pads, *Ex parte Crescent Mfg. Co.*, C. D. 1901, 160, 97 O. G. 750; "Felt-less," harness sweat-pads, *Ex parte McClain*, C. D. 1902, 185, 99 O. G. 2101; "Rust? Never!" hooks and eyes, *Ex parte DeLong Hook & Eye Co.*, 128 O. G. 885; "Standard," phonographs, *In re National Phonograph Co.*, C. D. 1907, 550, 128 O. G. 1295; "Fits-U," eye glasses and spectacle frames (mere mis-spelling of "fits you"), *Ex parte American Optical Co.*, C. D. 1908, 102, 133 O. G. 1935; "Hold On," clutches for hat-pins, *Ex parte Goldsmith & Co.*, C. D. 1908, 104, 133 O. G. 1935. "Asbestos," shoes made of

leather and asbestos, C. D. 1908, 114, 134 O. G. 257; "Mountain Dew," whiskey, C. D. 1908, 117, 134 O. G. 513; "Health Food," bread and crackers, *Battle Creek Sanitarium Co. v. Fuller*, 30 App. D. C. 411, 134 O. G. 1299; "Library Slip," trading coupons, *Ex parte Magazine & Book Co.*, C. D. 1908, 163, 135 O. G. 661; "Nextobeer," non-intoxicating malt drink, *Ex parte Central Consumers Co.*, C. D. 1908, 186, 135 O. G. 1581; "Silver Dip," silver cleanser, *Ex parte Cobb Mfg. Co.*, C. D. 1908, 6, 132 O. G. 233; "Circular Loom," insulating tube partly woven on a circular loom, *In re American Circular Loom Co.*, C. D. 1907, 481, 127 O. G. 393; "Dull Black," hooks and eyes, *Ex parte De Long Hook & Eye Co.*, C. D. 1907, 139, 128 O. G. 1291; "Union," heel-plates, *Ex parte Sacks*, C. D. 1907, 169, 128 O. G. 2530; "Rat Bis-Kit," rat poison, *Ex parte Rat Biscuit Co.*, C. D. 1907, 241, 130 O. G. 300; "Nutty Corn," confection made of nuts and corn, *Ex parte Shenkberg Co.*, 132 O. G. 1073; "Apple & Honey," cough remedy containing cider brandy and honey, *Ex parte Heublein & Co.*, 87 O. G. 179; "Self-Loading," cartridges, *Winchester Repeating Arms Co. v. Peters Cartridge Co.*, C. D. 1908, 401, 30 App. D. C. 505, 134 O. G. 2030; "Bestok," toilet paper (mis-spelling of "best stock"), *Ex parte Scott Paper Co.*, 137 O. G. 1482, C. D. 1908, 254; "Purity," peanuts, *Ex parte Taylor & Co.*, 114 O. G. 972, C. D. 1905, 38; "Worthmore," shoes, *Ex parte Block Bros. Clothing Co.*, 124 O. G. 1521, C. D. 1906, 357; "Catarrhal Jelly," medicine, *Ex parte Kenyon*, 124 O. G. 2901, C. D. 1906, 411.

Examples of marks held non-registrable because geographical.—The registration of geographical terms is strictly prohibited by sec. 5. *In re Hopkins*, 29 App. D. C. 118, 128 O. G. 890, C. D. 1907, 549.

ILLUSTRATIONS.

"Oriental," typewriter ribbon, *In re Crescent Typewriter Supply Co.*, 30 App. D. C. 324, 133 O. G. 231, C. D. 1908, 318; "Ozark," overalls, *Ex parte Keet & Rountree D. G. Co.*, 115 O. G. 1849, C. D. 1905, 134; "Mattawan," shirts, *Ex parte Falkenberg*, 115 O. G. 1065, C. D. 1905, 109; "Savoy," beer, *Ex parte United States Brewing Co.*, 125 O. G. 352, C. D. 1906, 437.

Registrable geographical words.—The registrability of words having a geographical signification is determined by the nature of the particular word and the particular goods. Thus "Arab" has been registered for sardines, *Ex parte Seacoast Canning Co.*, 199 O. G. 617; "Hollander" refused registration for beer, *Ex parte Conrad Seipp Brew. Co.*, 206 O. G. 877; "Orange Grove" refused registration for flour, *H. Becker & Co. v. Gambrill Mfg. Co.*, 38 App. D. C. 585, 179 O. G. 1111; "Golden State" refused registration for tea, coffee, etc., *Ex parte Gold-*

berg, Bowen & Co., 182 O. G. 972; "Lakeside," granted registration for floor and wall coverings, *Ex parte United Roofing & Mfg. Co.*, 187 O. G. 1913.

Name of copyrighted publication.—There can be no valid registration of the name by which a copyrighted publication has been known and sold, after the copyright has expired. *Merriam Co. v. Syndicate Pub. Co.*, 237 U. S. 618, 622, 59 L. Ed. 1148.

"Written, printed, impressed, or woven in some particular or distinctive manner," etc.—"It is believed that the controlling principle underlying the requirement of the statute that a mere name unless written or printed in a distinctive manner may not be registered is that the distinctive manner in which the name is displayed must be of a character as to give such a distinctive impression to the eye of the ordinary observer as to outweigh the significance of the mere name." *Ex parte Polar Knitting Mills*, 154 O. G. 251. Approved *In re Artesian Mfg. Co.*, 37 App. D. C. 113, 166 O. G. 988, and in *Oliver Chilled Plow Works v. Oliver Mfg. Co.*, 40 App. D. C. 125, 192 O. G. 217. Same rule in *Ex parte C. H. Alden Co.*, 131 O. G. 2419.

Doubt as to registrability resolved in favor of registrant.—Where the mark whose registration is sought contains features closely resembling a registered mark all doubts should be resolved against the applicant. *Wayne County Preserving Co. v. Olney Canning Co.*, 32 App. D. C. 279, 140 O. G. 1003; *In re Wright & Taylor*, 33 App. D. C. 510, 148 O. G. 834; *Ex parte St. Anthony Milling & Elevator Co.*, 161 O. G. 1047.

Effect of combining non-registrable words.—A registrable trademark can not be made by combining two non-registrable words. *Kentucky Distilleries & Warehouse Co. v. Old Lexington Club Distilling Co.*, 31 App. D. C. 223, 135 O. G. 220; *In re Meyer Bros. Coffee & Spice Co.*, 32 App. D. C. 277, 140 O. G. 756; *Ex parte St. Anthony Milling & Elevator Co.*, 161 O. G. 1047.

Effect of use of other marks with that sought to be registered.—Where the specimen filed with the application shows other marks used in conjunction with the mark sought to be registered, the Patent Office has held that fact to be immaterial. *Lester H. Greene Co. v. Scott & Bowne*, 159 O. G. 242, following the rule of *Capewell Horse Nail Co. v. Mooney*, 167 Fed. Rep. 575, and *Enoch Morgan Sons v. Ward*, 152 Fed. Rep. 690.

The ten-year clause.—The validity of this clause, and the effect of registration under it, were determined with finality in *Davids Co. v. Davids*, 233 U. S. 461, 58 L. Ed. 1046. The substance of that decision is that the clause is valid, and that registration under it has the effect of "perfecting rights which might

have been imperfect when the use began, and would have so continued except for the statute," in the language of Judge Denison in *W. A. Gaines & Co. v. Rock Spring Distilling Co.*, 141 C. C. A. 287, 226 Fed. Rep. 531, 535. For the history of the Davids case, see *Thaddeus Davids Co. v. Davids*, 165 Fed. Rep. 792; *Thaddeus Davids Co. v. Davids*, 102 C. C. A. 249, 178 Fed. Rep. 801; *Thaddeus Davids Co. v. Davids*, 190 Fed. Rep. 285.

The Davids case interpreted.—"We do not regard the decision in the Davids case as holding that the statute directly operates to grant a monopoly to one who rightfully registers under the ten-year clause a descriptive or geographical word. We take it as holding that the statute was not intended to permit, under this clause, an ineffective and useless registration, and so, in effect, holding that the statute removed from descriptive words which had been exclusively used as a mark in interstate commerce for ten years the bar or disability caused by their descriptive character, and made them, after that probation, subject to exclusive appropriation with the same effect, in the main, as if the disability had never existed. Since the statute relates primarily to registration, it may well be that the disability continues until registration, somewhat retroactively, removes it; that is not now important. Neither is it important at present to know the exact distinctions between the manufacturer's rights formerly existing under the secondary meaning theory and those now existing under the statute. * * * Whether any exclusive rights which, in an essential part depend on this statute can extend to the regulation of strictly intrastate commerce, or whether the effect must be limited to the field where congress had power to act, is an interesting question, which is only suggested, but not presented, by this record." Denison, J., in *Nashville Syrup Co. v. Coca-Cola Co.*, 215 Fed. Rep. 527, 529, 132 C. C. A. 39, 41.

Other decisions touching upon the validity of the ten-year clause are *In re Cahn, Belt & Co.*, 27 App. D. C. 173, 122 O. G. 354; *Coca-Cola Co. v. Deacon Brown Bottling Co.*, 200 Fed. Rep. 105; *Coca-Cola Co. v. Nashville Syrup Co.*, 200 Fed. Rep. 153; *Hughes v. Alfred H. Smith Co.*, 205 Fed. Rep. 302; *Rossmann v. Garnier*, 128 C. C. A. 73, 211 Fed. Rep. 401.

Ten-year clause makes geographical and otherwise descriptive marks registrable by removing their disabilities. *In re Cahn, Belt & Co.*, 27 App. D. C. 173, 122 O. G. 354; *Battle Creek Sanitarium Co. v. Fuller*, 30 App. D. C. 411, 134 O. G. 1299; *Tim & Co. v. Cluett, Peabody & Co.*, 42 App. D. C. 212, 203 O. G. 306.

"*Exclusive use*," as that term is used in the ten-year clause, does not mean *sole* use, but the right to exclude others from using. *Whittemore Bros. & Co. v. Hauthaway*, 132 O. G. 233.

Effect given to registration by state courts.—It has been held that the word "Oneida," because of its registration under this act was entitled to protection in a state court. *Oneida Community v. Oneida Game Trap Co.*, 154 N. Y. S. 391, affirming 150 N. Y. S. 918. But such registration is not conclusive upon a state court either as to the validity of the mark, or the right of the applicant to register. *Buffalo Rubber Mfg. Co. v. Batavia Rubber Co.*, 153 N. Y. S. 779, 90 Misc. Rep. 418.

SECTION 6. (As amended March 2, 1907, ch. 2573, 34 Stat. L. 1252.) That on the filing of an application for registration of a trademark which complies with the requirements of this act, and the payment of the fees herein provided for, the Commissioner of Patents shall cause an examination thereof to be made; and if on such examination it shall appear that the applicant is entitled to have his trademark registered under the provisions of this act, the Commissioner shall cause the mark to be published at least once in the Official Gazette of the Patent Office. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office, within thirty days after the publication of the mark sought to be registered, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section two of this act. An opposition may be filed by a duly authorized attorney, but said opposition shall be null and void unless verified by the opposer within a reasonable time after such filing. If no notice of opposition is filed within said time, the Commissioner shall issue a certificate of registration therefor, as hereinafter provided for. If, on examination an application is refused, the Commissioner shall notify the applicant, giving him his reasons therefor.

The amendment of March 2, 1907, inserted the proviso that "An opposition may be filed by a duly authorized attorney, but such opposition shall be null and void unless verified by the opposer within a reasonable time after such filing." As the section read before the amendment it was held that the oath had to be made by the opposing party, and could not be made by an attorney or agent. *W. H. Baker v. Baker*, C. D. 1906, 337, 124 O. G. 909; *Martin v. Martin & Bowne Co.*, 27 App. D. C. 59, 122 O. G. 734, C. D. 1906, 642. After the amendment it was held that in the absence of a statutory requirement for a verification by

the attorney, a notice of opposition filed by an attorney need not be verified; that inasmuch as the amendment required the verification to be made by the opposer within a reasonable time after its filing, "verification by both the attorney and his principal would appear to be useless * * * unless the opposition is verified by the party damaged it is held null and void and can not form the basis for any proceeding, whether or not it is verified by the attorney" Billings, Asst. Com., in *Wellcome v. Baum*, 135 O. G. 894.

The Committee on Patents of the House of Representatives, in their report recommending the passage of the act, said in reference to the above section:

"The procedure provided by the bill for the registration of trademarks is similar in many respects to the procedure in patent cases. When the application for registration is filed sec. 6 provides for an examination of the mark offered for registration. If upon such examination the application is refused, notice is given to the applicant, in order that he may appeal, if he so desires, from the decision. The procedure for appeals is regulated by other sections of the bill. If, on the other hand, the examination discloses that the mark is entitled to registration, then the act provides that the Commissioner shall cause the mark to be published at least once in the Official Gazette of the Patent Office. The purpose of this publication is apparent. Owners of trademarks ought not to have their rights to the use of a trademark jeopardized by the registration of similar trademarks by other parties not entitled to the use of the same. Some notice should be given whereby the true owners of marks may have an opportunity to be heard by the Commissioner of Patents before any mark is registered and given, by reason of such registration, the evidence of ownership provided for by the terms of the bill."

Opposition—Who may maintain.—A corporation (The Asbestone Co.) may oppose the registration as a trademark of a word (Asbestone) which is a vital part of its corporate name, in view of the provisions of sec. 5 of this act, without proof of actual damage. *Asbestone Co. v. Philip Carey Mfg. Co.*, 41 App. D. C. 507, 200 O. G. 857.

Opposition is the proper remedy "where the two (articles) are so nearly alike in their fundamental characteristics and the uses to which they are applied are so closely related that their sale under the same trademark would be likely to cause the public to believe that they were the output of the same manufacturer." Robb, J., in *Woven Steel Co. v. Keasbey & Mattison Co.*, 41 App. D. C. 247, 198 O. G. 495.

Opposition under the ten-year clause.—An opposition may lie against the attempted registration of a mark under the ten-year proviso that would not lie under an application for regis-

tration of a technical trademark. *Barclay v. Carter Med. Co.*, 41 App. D. C. 240, 198 O. G. 238.

Publication not a bar to rejection.—Publication does not preclude a subsequent rejection, either because a statutory bar is found (*Ex parte Cluett, Peabody & Co.*, 120 O. G. 902), or on the ground that the mark involves misbranding within the meaning of sec. 8 of the Food and Drugs Act of June 30, 1906. *Ex parte Barclay & Barclay*, 135 O. G. 217.

Re-publication after amendment.—Where after publication in the Gazette the application is amended (so as to alter the particular description of the goods on which the mark is used) it is within the discretion of the Examiner to say whether the mark shall be re-published, and his exercise of that discretion will not be reviewed on petition. *Ex parte American Wringer Co.*, 134 O. G. 1803.

Notice of opposition—Requisites of.—It will not suffice to say that the opposer believes he would be damaged by the proposed registration. *Battle Creek Sanitarium Co. v. Fuller*, 30 App. D. C. 411, 134 O. G. 1299. Nor can an opposition be maintained merely in the public interest. *Underwood Typewriter Co. v. A. B. Dick Co.*, 36 App. D. C. 175, 163 O. G. 730.

Opposition may be maintained by one who has actually made commercial use of the descriptive term sought to be registered under the ten-year clause of sec. 5, during the ten-year period. *Natural Food Co. v. Williams*, 30 App. D. C. 348, 133 O. G. 232; *H. W. Johns-Manville Co. v. American S. P. Co.*, 33 App. D. C. 224, 145 O. G. 257; *Tim & Co. v. Cluett, Peabody & Co.*, 42 App. D. C. 212, 203 O. G. 306.

The opposer's use must be in the same general class of goods, *Johnson Educator Food Co. v. Sylvanus Smith & Co.*, 174 O. G. 1027. Thus coffee and cocoa are so nearly akin as to sustain an opposition, *Walter Baker & Co. v. Harrison*, 32 App. D. C. 272, 138 O. G. 770; fish products and bakery products are not, *Johnson Educator Food Co. v. Sylvanus Smith & Co.*, 174 O. G. 1027; nor are peroxid of hydrogen and beverages, *Consumers Co. v. Hydrox Chem. Co.*, 182 O. G. 721; nor calcimine and white lead, *Muralo Co. v. National Lead Co.*, 36 App. D. C. 541, 165 O. G. 475.

Opposition to the attempted registration of a surname will be sustained by proof of the applicant's assignment to the opposer of the right to use that surname as a trademark for goods of the same descriptive properties. *Andrew Jergens Co. v. Woodbury*, 133 O. G. 513.

Decisions of the Examiner of Interferences overruling a demurrer to a notice of opposition (*Drevet Mfg. Co. v. Liquozone*

Co., 122 O. G. 3014), or denying a motion to dismiss a notice of opposition (*Oakley & Co. v. Babcock*, 133 O. G. 761), are not appealable save under circumstances of extreme or unusual character.

Cross-bill will not lie in opposition proceeding.—Although the opposer recites his registered mark as a basis for his opposition, a cross-bill praying the cancellation of that registration will not be permitted to be filed. *Burton Med. Co. v. United Drug Co.*, 179 O. G. 288.

Modification of mark after adverse decision in opposition.—The defeated applicant may modify his application by cancelling the part of the mark involved in the opposition only if his mark is not thereby mutilated, and on making affidavit that the mark as modified was actually used. *Ex parte Vi-Stix Products Co.*, 175 O. G. 846.

Opposition notice.—Amendment after expiration of the statutory thirty-day limit is not permissible, where the original notice is not of itself legally sufficient to sustain the opposition. *National Water Co. v. A. Kron Brewing Co.*, 197 O. G. 999.

Opposition—Effect of answer under oath.—As the equity rules of the supreme court do not provide for an answer under oath, such an answer is not evidence in favor of the party filing it. *Universal Motor Truck Co. v. Universal Motor Co.*, 197 O. G. 533.

Opposition not sustainable by proof of unfair competition.—"There is a great mass of testimony in this case which is entirely irrelevant to the questions which this tribunal is called upon to decide. The record is full of matters which relate solely to the question of unfair competition in trade which matters it has been repeatedly held can not be considered in a trademark opposition. The only question for consideration here is whether or not applicant is entitled to register his mark, and such matters as the painting of the plows, the quality and reputation of the goods of the parties, the prices at which the plows are sold and similar matters are irrelevant to this controversy." *Oliver Chilled Plow Works v. Oliver Mfg. Co.*, 40 App. D. C. 279, 192 O. G. 217; *Johnson v. Brandau*, 134 O. G. 257.

Opposition—Right of applicant to withdraw application.—After opposition proceedings have been instituted, the applicant will not be permitted to withdraw or abandon his application unless he formally abandons his claim to the trademark. "Any other course would permit any applicant in an opposition proceeding to escape judgment in due course and at the same time reserve the determination of the questions involved for whatsoever time he may feel inclined to raise the same." Moore,

Acting Com., in *Perfect Safety Paper Co. v. George La Monte & Son*, 122 O. G. 869. (It is believed that this ruling goes beyond the jurisdictional power of the Patent Office, and that the right of the applicant to abandon the application without abandoning his trademark should never have been questioned.)

Opposition—Opposer must have applied mark to merchandise.—An opposition based on use of the mark in advertising only, and not applied to merchandise will be dismissed. "If he has not used the mark as a trademark upon goods of a like description he can suffer no damage from its registration by another." Shepard, C. J., in *Battle Creek Sanitarium Co. v. Fuller*, 30 App. D. C. 411, 134 O. G. 1299, C. D. 1908, 370.

Opposition—Burden of proof.—Where there is no apparent conflict between the mark sought to be registered and the mark of the opposer, the burden is on the opposer to show that as a matter of fact the registration of the applicant's mark "will likely cause confusion and deceive ordinary purchasers." *Andrew McLean Co. v. Adams Mfg. Co.*, 31 App. D. C. 509, 136 O. G. 440, C. D. 1908, 487.

Opposition—Application not prima facie evidence of ownership.—In an opposition proceeding, the applicant's application is not *prima facie* evidence of ownership of the mark. *Green, Tweed & Co. v. Manufacturer's Belt Hook Co.*, 137 O. G. 2221.

Opposition—Immaterial whether opposer entitled to register.—"It is not necessary, in order that an opposition should be sustained, that the opposer himself shall be entitled to register his mark for, if the opposer has used his mark prior to the time of its use by the applicant, the applicant is not entitled to the exclusive use of it, even though he may be entitled to use it in common with the rest of the public." Moore, Com., in *Green, Tweed & Co. v. Manufacturer's Belt Hook Co.*, 137 O. G. 2221.

Opposition—Time for filing.—The thirty days allowed by sec. 6 includes Sundays and holidays. *Keasbey Co. v. Portland Cementfabrik*, 133 O. G. 1936.

Demurrer to notice of opposition will lie where the only matter in common use by both parties is not subject to appropriation by either (*Johnson v. Brandau*, 134 O. G. 257); but this rule has no application where the applicant seeks to register under the ten-year clause of sec. 5. *Kutroff v. Cassella Color Co.*, 129 O. G. 3159.

Notice of opposition must contain the jurisdictional averment that the opposer "believes he would be damaged by the registration of the mark." *Hansen v. Inland Type Foundry*, 134 O. G. 775. But that averment may be added by amendment after the

thirty-day period fixed by sec. 6. *Battle Creek Sanitarium Co. v. Fuller*, 30 App. D. C. 411, 134 O. G. 1299.

Right to oppose not based on right to register.—"It is well settled that it is not necessary in order to sustain an opposition that it should appear that the opposer is entitled to register the mark." Moore, Com., in *Irish Industrial Assn. v. Barrett*, 186 O. G. 797; following *Natural Food Co. v. Williams*, 30 App. D. C. 348, 133 O. G. 232; *Lang v. Green River Dist. Co.*, 33 App. D. C. 506, 148 O. G. 280; *Johns-Manville Co. v. American S. P. Co.*, 33 App. D. C. 224, 145 O. G. 257.

Opposition—Res Adjudicata.—A judgment or decree in a prior case is conclusive in a later case as to questions actually in issue and decided, and not as to those which might have been decided. *Horine v. Wende*, 29 App. D. C. 415, 129 O. G. 2858. Consequently the fact that an opposition has been decided against the applicant is no bar to the registration of the mark under a later application based on the ten-year clause. *Carter Med. Co. v. Barclay*, 36 App. D. C. 123, 162 O. G. 785. So an adjudication by a federal court in an infringement suit that a former registration of the plaintiff there was invalid is not conclusive upon the Patent Office in an opposition between the same parties involving an application to register the former plaintiff's mark of more limited scope than the former registration. *A. Leschen & Sons Rope Co v. Broderick & Bascom Rope Co.*, 36 App. D. C. 451, 164 O. G. 977.

Opposition to part of the mark sought to be registered.—Opposition lies to the attempted registration of a mark which includes a tradename in use by the opposer. *Johnson v. Brandau*, 32 App. D. C. 348, 139 O. G. 732.

Opposition to mark used on article made under expired patent.—Opposition is the proper remedy as against an application to register a mark which has become public property through the expiration of the patent upon the article to which the mark was applied during the life of the patent. *J. A. Scriven Co. v. Towles Mfg. Co.*, 32 App. D. C. 321, 140 O. G. 510. *Udell-Predock Mfg. Co. v. Udell Works*, 32 App. D. C. 282, 140 O. G. 1002.

SECTION 7. That in all cases where notice of opposition has been filed the Commissioner of Patents shall notify the applicant thereof and the grounds therefor.

Whenever application is made for the registration of a trademark which is substantially identical with a trademark appropriated to goods of the same descriptive properties, for which a certificate of registration has been previously issued to another,

or for registration of which another has previously made application, or which so nearly resembles such trademark, or a known trademark owned and used by another, as, in the opinion of the Commissioner, to be likely to be mistaken therefor by the public, he may declare that an interference exists as to such trademark, and in every case of interference or opposition to registration he shall direct the Examiner in charge of Interferences to determine the question of the right of registration to such trademark, and of the sufficiency of objections to registration, in such manner and upon such notice to those interested as the Commissioner may by rules prescribe.

The Commissioner may refuse to register the mark against the registration of which objection is filed, or may refuse to register both of two interfering marks, or may register the mark, as a trademark, for the person first to adopt and use the mark, if otherwise entitled to register the same unless an appeal is taken, as hereinafter provided for, from his decision, by a party interested in the proceeding, within such time (not less than twenty days) as the Commissioner may prescribe.

As to oppositions, this section is supplemental to sec. 6. This section further provides for the creation of interference proceedings, which have formed a large part of the proceedings in the Patent Office under the Trademark Act of 1881, and the patent statutes. It further provides for an appeal from the decision of the Commissioner in cases of opposition and interference.

Interference in fact.—It exists between words which look alike and sound alike; as "Boraxine" and "Boraxaid," *Larkin Co. v. Pacific Coast Borax Co.*, 132 O. G. 679.

Interference—Dissolution where both applications owned by same party.—Upon a showing that the same party is the actual owner of both applications in interference, the interference will be dissolved. *Taussig v. Taussig,* 118 O. G. 2251, C. D. 1905, 434.

Interferences not dissolved by consent.—An agreement of the parties that the interference may be dissolved and all the marks involved registered will not be carried out by the Patent Office. *Wright & Taylor v. Bluthenthal & Bickert*, 119 O. G. 2234, C. D. 1905, 540.

Interferences—Evidence of use by stranger to the record.—As sec. 7 provides that the Commissioner "may refuse to register

both of two interfering marks," evidence of use by others, not parties, is competent as tending to show that neither party has the right to register. *Golden & Co. v. Heitz & Co.*, 125 O. G. 989, C. D. 1906, 453.

Interference—Effect of laches.—That one party to an interference has permitted the other to use and advertise the mark for many years is not a ground for refusing registration to him. *John T. Lewis Co. v. Phoenix Paint Co.*, 134 O. G. 1049.

Interference—Dissolution.—Where both marks have been concurrently used for a long time and there is no allegation of any resulting confusion in the trade, the interference should be dissolved. *Stier v. Marburg Bros.*, C. D. 1913, 234; 196 O. G. 803.

Interference—Resolving doubt against registrant.—Where a registrant, in interference with an applicant, moves to dissolve, his motion evidences his consent that the applicant's mark may be registered, and all reasonable doubts should be resolved in favor of the applicant. *Stier v. Marburg Bros.*, C. D. 1913, 234; 196 O. G. 803; *J. & R. Carr v. Schollhorn Co.*, C. D. 1912, 222; 181 O. G. 265.

Interference—Evidence of abandonment by registrant.—In an interference between an applicant and a registrant the applicant filed an affidavit that the registrant had abandoned the mark. This was held to put the burden upon the registrant to show by an answer to the affidavit, under oath, that he had not abandoned. *Ozo Remedy Co. v. Carnrick & Co., Ltd.*, C. D. 1909, 162, 143 O. G. 959.

Interference—Appeal from order refusing to reopen to take testimony.—The refusal of the Examiner of Interferences to reopen the case to extend time to take testimony is not an appealable question. *Goodfellow v. Jolly*, C. D. 1905, 105, 115 O. G. 1064; *Christensen v. McKenzie*, C. D. 1905, 238, 117 O. G. 277; *Wickers v. Weinwurm*, C. D. 1907, 219, 129 O. G. 2501; *California Fruit Canners Assn. v. Ratcliff-Sanders Grocer Co.*, C. D. 1909, 160; 146 O. G. 958.

Interference—Appeal—Parties.—A party claiming to be a successor to the trademark rights of a registrant who was a party, sought to intervene and be made a party by filing a new application. The Examiner of Interferences ruled that the new application did not present interfering subject-matter, and rendered judgment of priority against the registrant. Upon appeal by the alleged successor it was held he was not a party and his appeal must fail. *Yonkers Brewery v. Iler & Burgweger*, 143 O. G. 258, C. D. 1909, 93.

Interference—Motion to dissolve, appeal.—On appeal from the decision of the Examiner refusing to dissolve the interference

no question can be urged which was not raised in the motion and passed on by the Examiner; in this regard Rule 46, *post*, compels the practice to follow that in patent interferences. *Larkin Co. v. Pacific Coast Borax Co.*, 132 O. G. 679, C. D. 1908, 20.

Interference—Fee on appeal from decision denying motion to dissolve.—Where a motion to dissolve, based upon absence of interference in fact, is denied, the decision denying it is appealable, but only on payment of the appeal fee of $15.00. *Seamless Rubber Co. v. Star Rubber Co.*, C. D. 1910, 44, 152 O. G. 957.

Interference—Geographical term—Motion to dissolve.—Where the marks ("Arkoma" and "Armona") are similar in appearance and sound, a motion to dissolve will be denied notwithstanding it also raises the point that "Aroma" is non-registrable because geographical, registration for that word being sought under the ten-year clause of sec. 5. *California Fruit Canners Assn. v. Foster, Caldarera & Co.*, C. D. 1911, 11, 162 O. G. 539.

Interference—Actual user.—Where one party used the mark only as a mark of grade, style or quality, judgment awarding priority to the opposing party was affirmed. *United States Playing Card Co. v. Clark Pub. Co.*, 126 O. G. 2190, C. D. 1907, 44. So, also, where a party has not actually applied the mark to merchandise, the award of priority can not run in his favor. *Bigbie Bros. & Co. v. Bluthenthal & Bickart*, 126 O. G. 1063, C. D. 1907, 22.

Interference in fact.—Where any doubt exists as to the actual interference of the marks, the determination of that question should be postponed until final hearing in order to have the benefit of any testimony taken on the subject. *Anheuser-Busch Brewing Assn. v. Yuengling & Son*, 129 O. G. 3501.

Interference—Evidence of abandonment.—"Mere non-use of a trademark does not establish abandonment thereof, but one who contends that the mark has been abandoned must establish that the original owner * * * not only discontinued its use but intended to abandon the same." Moore, Com., in *Madame Irene v. Schweinburg*. C. D. 1912, 114, 177 O. G. 1043.

SECTION 8. That every applicant for the registration of a trademark, or for the renewal of the registration of a trademark, which application is refused, or a party to an interference against whom a decision has been rendered, or a party who has filed a notice of opposition as to a trademark, may appeal from the decision of the Examiner in charge of Trademarks, or the Examiner in charge of Interferences, as the case may be, to the Commissioner in person, having once paid the fee for such appeal.

This section relates to the right of appeal to the Commissioner from the Examiner of the Trademark division of the Patent Office, or the Examiner in charge of Interferences. It is modeled on sec. 4909, R. S. U. S., relating to appeals in applications for letters-patent.

That a requirement of division on the ground that the application embraces items of merchandise not of the same descriptive properties is in effect a rejection of the application, and is reviewable by appeal and not on petition, see *Ex parte Kingan Packing Assn.*, 119 O. G. 2234, C. D. 1905, 538.

Motion to suppress evidence.—That a ruling upon such a motion is not reviewable upon appeal prior to final hearing save in a clear case of abuse of discretion, see *Greene, Tweed & Co. v. Manufacturers' Belt Hook Co.* 132 O. G. 680.

SECTION 9. That if an applicant for registration of a trademark, or a party to an interference as to a trademark, or a party who has filed opposition to the registration of a trademark, or party to an application for the cancellation of the registration of a trademark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the Court of Appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.

This section, for the first time, creates the right of appeal to the Court of Appeals of the District of Columbia from the decision of the Commissioner in trademark applications, interferences and oppositions.

The decision of the court of appeals in appeals taken under this section is not "final" within the meaning of secs. 8 and 9; Act February 9, 1893, 27 Stat. at L. 434, 436, ch. 74, and hence is not appealable to the United States Supreme Court. *Atkins v. Moore*, 142 O. G. 571, 212 U. S. 285, 291, 53 L. Ed. 515, 517.

That this section, read with sec. 4915, R. S. U. S., authorizes an action in a District Court to compel the registration, see *Old Lexington Club Dis. Co. v. Kentucky Distilleries & Warehouse Co.*, 234 Fed. Rep. 464.

SECTION 10. That every registered trademark, and every mark, for the registration of which application has been made, together with the application for registration of the

same, shall be assignable in connection with the goodwill of the business in which the mark is used. Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or state in which the same is executed; any such assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from date thereof. The Commissioner shall keep a record of such assignments.

The first sentence of this section is merely a declaration of the law concerning the assignability of trademarks as it has been settled by the courts. The remainder of the section relates to the formalities attending upon the execution and recording of the assignment of registered marks.

"No assignee of a trademark registered under the Act of 1905 acquires any right to enforce it unless the goodwill of the business in which the mark is used is transferred with the mark." Lacombe, J., in *Eiseman v. Schiffer*, 157 Fed. Rep. 473, 476.

Recordable assignments.—Only assignments made in connection with goodwill will be admitted to record. A paper purporting to convey a territorial right to the use of a trademark is not recordable. *In re National Chemical Co.*, 134 O. G. 1298.

SECTION 11. That certificates of registration of trademarks shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the drawing and statement of the applicant, shall be kept in books for that purpose. The certificate shall state the date on which the application for registration was received in the Patent Office. Certificates of registration of trademarks may be issued to the assignee of the applicant, but the assignment must first be entered of record in the Patent Office.

Written or printed copies of any records, books, papers, or drawings relating to trademarks belonging to the Patent Office, and of certificates of registration, authenticated by the seal of the Patent Office and certified by the Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor and paying the fee required by law shall have certified copies thereof.

This section is based on sec. 4, Act of 1881, *ante*. The seal of the Patent Office takes the place of the seal of the Department of the Interior. The final paragraph follows sec. 892, R. S. U. S.

SECTION 12. That a certificate of registration shall remain in force for twenty years, except that in the case of trademarks previously registered in a foreign country such certificates shall cease to be in force on the day on which the trademark ceases to be protected in such foreign country, and shall in no case remain in force more than twenty years, unless renewed. Certificates of registration may be, from time to time, renewed for like periods on payment of the renewal fees required by this act, upon request of the registrant, his legal representatives, or transferees of record in the Patent Office, and such request may be made at any time not more than six months prior to the expiration of the period for which the certificates of registration were issued or renewed. Certificates of registration in force at the date at which this act takes effect shall remain in force for the period for which they were issued, but shall be renewable on the same conditions and for the same period as certificates issued under the provisions of this act, and when so renewed shall have the same force and effect as certificates issued under this act.

Under sec. 5 of the Act of 1881, a certificate of registration remains in force for thirty years from its date. That period is curtailed by the above section to twenty years.

A request for renewal is not subject to examination as is an original application; it is *prima facie* evidence that the mark has not been abandoned; and the renewal may be decreed under bill in equity against the Commissioner under sec. 4915, R. S. U. S. *Ewing v. Standard Oil Co.*, 42 App. D. C. 321, 203 O. G. 1556. "Renewal in no sense confers new rights. It is a correction of the record to the date of renewal by the registrant or owner of the mark asserting his continued use of it and, therefore, title in it." Van Orsdel, J., in *Ewing v. Standard Oil Co.*, 42 App. D. C. 321, 203 O. G. 1556.

SECTION 13. That whenever any person shall deem himself injured by the registration of a trademark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The Commissioner shall refer such application to the Examiner in charge of Interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hear-

ing before the Examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the Examiner shall so decide, the Commissioner shall cancel the registration. Appeal may be taken to the Commissioner in person from the decision of the Examiner of Interferences.

The Committee on Patents of the House of Representatives in their report recommending the passage of the act said as follows in reference to this section:

"By sec. 13 provision is made for the cancellation of registration of marks which may not have been entitled to registration. The only notice which is required, according to the provisions of the bill, of the application for the registration of a trademark is the publication of the application once in the Official Gazette. The purpose of this provision is to give to the owner of a mark an opportunity to have a prior registration of his mark, if granted, canceled upon a proper showing."

Cancellation on request.—That the defendant party (a registrant) in an interference may have his registration canceled on request, see *Ex parte Bloomington Canning Co.*, 119 O. G. 2235.

This section applies only to marks registered under the Act of 1905, as was held in *Funke v. Baldwin*, 127 O. G. 392.

Use only on goods not those named in the certificate is ground for cancellation. *Pioneer Suspender Co. v. Louis Oppenheimer's Sons*, 128 O. G. 1293.

Cancellation will result if the registrant had no right to register, or if he lost that right subsequent to registration.—Magic Curler Co. v. Porter, 128 O. G. 2088; *Illinois Hydraulic Cement Mfg. Co. v. Utica Hydraulic Cement Co.*, 129 O. G. 2502.

Registration under ten-year clause.—The issue of exclusive user during the ten-year period is triable in cancellation proceedings; if the registrant did not have sole use during that period the registration will be canceled. *Familton v. Bliss Medical Co.*, 135 O. G. 1359. Compare, *Whittemore Bros. & Co. v. Hauthaway*, 132 O. G. 233.

The petition for cancellation must show that the petitioner "has sustained an injury of a legal character." *McIlhenny v. New Iberia Co.*, 30 App. D. C. 337, 133 O. G. 995.

Cancellation—Use on goods of different descriptive properties.—One moving the cancellation of a registered mark for tooth

powder can not maintain the proceeding by showing that he has used the mark on dyspepsia cure. *Graves v. Gunder*, 136 O. G. 227.

Cancellation—Right of the applicant for cancellation to dismiss without prejudice.—Under Rule 55, *post*, the right to dismiss without prejudice to the right to file a new application for cancellation has been denied, after issue joined and proofs taken; said ruling being upon the authority of *Detroit v. Detroit City Ry. Co.*, 55 Fed. Rep. 569, and *Georgia Co. v. Bilfinger*, 129 Fed. Rep. 131. *Outcault v. New York Herald Co.*, 136 O. G. 437.

Cancellation on request of registrant.—By virtue of the jurisdiction conferred by sec. 13, the Patent Office will cancel a registration upon surrender of the certificate and upon the request of the registrant owner. *Ex parte Bloomington Canning Co.*, 119 O. G. 2235, C. D. 1905, 543.

SECTION 14. That the following shall be the rates for trademark fees:

On filing each original application for registration of a trademark, ten dollars: *Provided*, That an application for registration of a trademark pending at the date of the passage of this act, and on which certificate of registration shall not have issued at such date, may, at the option of the applicant, be proceeded with and registered under the provisions of this act without the payment of further fee.

On filing each application for renewal of the registration of a trademark, ten dollars.

On filing notice of opposition to the registration of a trademark, ten dollars.

On an appeal from the Examiner in charge of Trademarks to the Commissioner of Patents, fifteen dollars.

On an appeal from the decision of the Examiner in charge of Interferences, awarding ownership of a trademark or cancelling the registration of a trademark, to the Commissioner of Patents, fifteen dollars.

For certified and uncertified copies of certificates of registration and other papers, and for recording transfers and other papers, the same fees as required by law for such copies of patents and for recording assignments and other papers relating to patents.

The foregoing provisions as to fees do not provide for the fee to be paid upon an application to cancel registration, although a fee is fixed for the appeal from the decision of the Examiner of Interferences in such cases.

SECTION 15. That sections forty-nine hundred and thirty-five and forty-nine hundred and thirty-six of the Revised Statutes, relating to the payment of patent fees and to the repayment of fees paid by mistake, are hereby made applicable to trademark fees.

The sections of the Revised Statutes of the United States, referred to in the above section, are as follows:

Section 4935.

"Patent fees may be paid to the Commissioner of Patents, or to the Treasurer or any of the Assistant Treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the treasury as received, without any deduction whatever."

Section 4936.

"The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the treasury, or to any receiver or depositary, to the credit of the treasury, as for fees accruing at the Patent Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents."

SECTION 16. That the registration of a trademark under the provisions of this act shall be *prima facie* evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trademark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several states, or with a foreign nation,

or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

This section substantially embodies the provisions of sec. 7 of the Act of 1881, besides providing for increasing the actual damages found, to a sum not exceeding three times the amount of the verdict.

The first sentence of this section can not receive from the court a more liberal interpretation than was given to the same sentence in the Act of 1881; and as to that provision in the former act, it was expressly held that registration could not serve as the foundation for preliminary injunction. [21]

Obviously, a certificate of registration may be introduced in evidence as *prima facie* proof of ownership. This would follow if the provision were not expressed in the act, as otherwise any registration act would be idle.

The Committee on Patents of the House of Representatives, in their report recommending the passage of the act, said, in reference to this section, as follows:

"A remedy at law is given to the owners of trademarks by sec. 16. The provision contained in this section to give the court power to enter a judgment on a verdict for three times the amount of the verdict, in such cases as the court may deem it advisable, is new in the law of trademarks. Similar provisions exist in the copyright and patent laws and in other statutes. The difficulty of proving exact damages in cases of this character is well understood. It has seemed to your committee proper that the Government, which has made provision for the registration of trademarks, should accord to the owners thereof, who have complied with the terms of the statute, full and complete redress for violation of their rights. By another section of the bill provision is made for designating registered trademarks by printing under the trademark the fact that it is registered, as is done in cases of patents, so that any person who imitates or counterfeits a trademark will do so with notice, and should therefore be held to a strict accountability for the fraud committed."

21—A. Leschen Sons Rope Co. v. Broderick & Bascom Rope Company, 123 Fed. Rep. 149, 152.

That registration is by sec. 16 made *prima facie* evidence of ownership, see *In re Gorham Mfg. Co.*, 41 App. D. C. 263, 198 O. G. 703.

SECTION 17. That the circuit and territorial courts of the United States and the Supreme Court of the District of Columbia shall have original jurisdiction, and the Circuit Courts of Appeal of the United States and the Court of Appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trademarks registered in accordance with the provisions of this act, arising under the present act, without regard to the amount in controversy.

This section designates the courts having original and appellate jurisdiction in cases involving registered trademarks. As to the appellate jurisdiction in trademark cases generally, see *ante*, sec. 201, title "Appeals."

See also sec. 24. The Judicial Code (Hopkins' Judicial Code, p. 31).

Federal jurisdiction.—"The act of violation complained of, actual or threatened, must be an interstate act, and it is only when the defendant so uses the trademark that the Act of Congress confers the jurisdiction."

Dickinson, J., in *Louis Bergdoll Brew. Co. v. Bergdoll Brew. Co.*, 218 Fed. Rep. 131, 133. Following *Bernstein v. Danwitz*, 190 Fed. Rep. 604.

SECTION 18. That writs of *certiorari* may be granted by the Supreme Court of the United States for the review of cases arising under this act in the same manner as provided for patent cases by the act creating the circuit court of appeals.

This section is substantially identical with the corresponding section of the Judiciary Act of 1891, sec. 6. As to the issuance of the writ of *certiorari* by the supreme court, see *ante*, sec. 202, title *"Certiorari."*

This section precludes appeals to the United States Supreme Court in cases arising under this act. *Hutchinson, Pierce & Co. v. Loewy*, 217 U. S. 457, 54 L. Ed. 838; *Street & Smith v. Atlas Mfg. Co.*, 231 U. S. 348, 58 L. Ed. 262. See notes, sec. 9 *ante*, this appendix.

SECTION 19. That the several courts vested with jurisdiction of cases arising under the present act shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a

trademark registered under this act, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trademark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to increase such damages, in its discretion, as is given by section sixteen of this act for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed.

This section is substantially identical in its provisions with sec. 4921, R. S. U. S., relating to patent cases, with the addition of providing for the manner of assessing profits. See *ante*, sec. 198, title "Increase of Damages in Equity."

The Committee on Patents of the House of Representatives, in their report recommending the passage of the act, said in reference to this section:

"By sec. 19 provision is made for proceedings in equity against the infringer of a registered trademark. This section corresponds in terms with sec. 4921 of the Revised Statutes relating to patent cases, except that it specially provides the manner in which profits shall be ascertained. Under existing rules it is necessary for the complainant to prove sales and costs with entire and absolute accuracy. The only persons having knowledge of the cost of making the sales are the defendant or some one in his employ. It has seemed, therefore, only fair and just that if the complainant proves the sales, the defendant should be required to produce evidence of the expenses he was put to in making such sales as an offset against the sales proven by the complainant."

SECTION 20. That in any case involving the right to a trademark registered in accordance with the provisions of this act, in which the verdict has been found for the plaintiff, or an injunction issued, the court may order that all labels, signs, prints, packages, wrappers, or receptacles in the possession of the defendant, bearing the trademark of the plaintiff or complainant, or any reproduction, counterfeit, copy, or colorable imitation thereof, shall be delivered up and destroyed. Any injunction that may be granted upon hearing, after notice to the defendant, to pre-

vent the violation of any right of the owner of a trademark registered in accordance with the provisions of this act, by any circuit court of the United States, or by a judge thereof, may be served on the parties against whom such injunction may be granted anywhere in the United States where they may be found, and shall be operative, and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other circuit court, or judge thereof, in the United States, or by the Supreme Court of the District of Columbia, or a judge thereof. The said courts, or judges thereof, shall have jurisdiction to enforce said injunction, as herein provided, as fully as if the injunction had been granted by the circuit court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all the papers on which the said injunction was granted that are on file in his office.

This section was modeled on sec. 4966, R. S. U. S., part of the Copyright Act.

SECTION 21. That no action or suit shall be maintained under the provisions of this act in any case when the trademark is used in unlawful business, or upon any articles injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or has been abandoned, or upon any certificate of registration fraudulently obtained.

SECTION 22. That whenever there are interfering registered trademarks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant; and the court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trademark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation.

The Committee on Patents of the House of Representatives, in their report recommending the passage of the act, said in reference to this section:

"Sec. 22 provides for the cancellation of certificates of registration which have been granted to applicants who are subsequently found not to be the owners of the marks. This section provides only for the cancellation of trademarks which are in conflict with other registered trademarks. Sec. 13 provides that any person, whether the owner of any registered trademark or not, who may deem himself injured by the registration of a mark, may make application to the Commissioner of Patents to cancel the registration thereof, and proceedings are provided for any such case protecting the rights of the registrant of the mark."

SECTION 23. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trademark might have had if the provisions of this act had not been passed.

The Committee on Patents of the House of Representatives, in their report recommending the passage of the act, said in reference to this section:

"Sec. 23 is identical with sec. 10 of the Act of 1881 on the subject of trademarks, and is intended to give the user of a commercial mark, whether such mark comes within the technical definition of a trademark under the provisions of the proposed act the right to have such remedy against those who make use of such mark with fraudulent intent, as is given by the courts under the doctrine of unfair competition, and to further provide that the courts of the United States shall continue to have such jurisdiction as they now have to enforce relief in such cases."

SECTION 24. That all applications for registration pending in the office of the Commissioner of Patents at the time of the passage of this act may be amended with a view to bringing them, and the certificate issued upon such applications, under its provisions, and the prosecution of such applications may be proceeded with under the provisions of this act.

"*Pending*" means undecided, and does not comprehend cases under final rejection. *Ex parte Mark Cross Co.*, 116 O. G. 1733. A decision of the Commissioner that an applicant is not entitled to amend so as to bring his case under the Act of 1905 virtually refuses registration, and is therefore appealable. *In re Mark Cross Co.*, 116 O. G. 2534; *Ex parte American Separator Co.*, 119 O. G. 339.

SECTION 25. That any person who shall procure registration of a trademark, or entry thereof, in the office of the Commissioner of Patents by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered by an action on the case.

This section is identical with sec. 9 of the Act of 1881.

SECTION 26. That the Commissioner of Patents is authorized to make rules and regulations, not inconsistent with law, for the conduct of proceedings in reference to the registration of trademarks provided for by this act.

SECTION 27. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom house of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trademarks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trademark, issued in accordance with the provisions of this act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department fac-similes of his name, the name of the locality in which his goods are manufactured, or of his registered trademark; and thereupon the

Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

SECTION 28. That it shall be the duty of the registrant to give notice to the public that a trademark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or abbreviated thus, "Reg. U. S. Pat. Off.," or when, from the character or size of the trademark, or from its manner of attachment to the article to which it is appropriated, this can not be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; and in any suit for infringement by a party failing so to give notice of registration no damages shall be recovered, except on proof that the defendant was duly notified of infringement, and continued the same after such notice.

Damages are not recoverable where the registrant has failed to affix the imprint of the goods or give notice to the defendant. *Rossmann v. Garnier*, 211 Fed. Rep. 401, 128 C. C. A. 73.

SECTION 29. That in construing this act the following rules must be observed, except where the contrary intent is plainly apparent from the context thereof: The United States includes and embraces all territory which is under the jurisdiction and control of the United States. The word "states" includes and embraces the District of Columbia, the territories of the United States, and such other territory as shall be under the jurisdiction and control of the United States. The terms "person" and "owner," and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this act, include a firm, corporation, or association, as well as a natural person. The term "applicant" and "registrant" embrace the successors and assigns of such applicant or registrant. The term "trademark" includes any mark which is entitled to registration under the terms of this act, and whether registered or not, and a trademark shall be deemed to be "affixed" to an article when it is placed in any manner in or upon either the article itself or the receptacle or package or upon the envelope or other thing in, by, or with

which the goods are packed or inclosed or otherwise prepared for sale or distribution.

SECTION 30. That this act shall be in force and take effect April first, nineteen hundred and five. All acts and parts of acts inconsistent with this act are hereby repealed except so far as the same may apply to certificates of registration issued under the Act of Congress approved March third, eighteen hundred and eighty-one, entitled, "An act to authorize the registration of trademarks and protect the same," or under the act approved August fifth, eighteen hundred and eighty-two, entitled, "An act relating to the registration of trademarks."

RULES GOVERNING THE REGISTRATION OF TRADE-MARKS UNDER THE TRADEMARK ACTS.

UNITED STATES PATENT OFFICE,
Washington, D. C., October 15, 1913.

CORRESPONDENCE.

1. All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

2. Applicants and attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will be returned; but all such papers will first be submitted to the Commissioner, and only be returned by his direct order.

3. All letters should be addressed to "The Commissioner of Patents;" and all remittances by money order, check or draft should be to his order.

4. A separate letter should, in every case, be written in relation to each distinct subject of inquiry or application. Complaints against the Examiner in charge of Trademarks, assignments for record, fees, and orders for copies or abstracts must be sent to the office in separate letters.

5. Letters relating to pending applications should refer to the name of the applicant, the serial number of the application, and the date of filing. Letters relating to registered trademarks should refer to the name of the registrant, the number and date of the certificate, and the merchandise to which the trademark is applied.

6. The personal attendance of applicants at the Patent Office is unnecessary. Their business can be transacted by correspondence.

7. When an attorney shall have filed his power of attorney, duly executed, the correspondence will be held with him.

8. A double correspondence with an applicant and his attorney, or with two attorneys, can not, generally, be allowed.

9. The office can not undertake to respond to inquiries propounded with a view to ascertain whether certain trademarks have been registered, or, if so, to whom, or for what goods; nor can it give advice as to the nature and extent of the protection afforded by the law, or act as its expounder, except as questions may arise upon applications regularly filed.

10. Express, freight, postage, and all other charges on matter sent to the Patent Office must be prepaid in full; otherwise it will not be received.

ATTORNEYS.

11. The owner of a trademark may prosecute his own application for registration of such trademark, but he is advised, unless familiar with such matters, to employ a competent attorney. The office can not aid in the selection of an attorney.

A register of attorneys is kept in the Patent Office, on which is entered the names of all persons entitled to represent applicants before the Patent Office in the prosecution of applications for patents, and any registered attorney will be recognized in the prosecution of applications for registration of trademarks.

Registration of an attorney merely for the prosecution of an application for registration of a trademark will not be required, but in the absence of registration recognition will be limited to each case. The Commissioner reserves the right to decline to recognize any attorney, agent, or other person authorized to be recognized by the preceding provisions of this rule.

12. Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. General powers given by a principal to an associate can not be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or copartnership will not be recognized, either in favor of the firm or any of its members, unless all its members shall be named in such power of attorney.

13. Substitution or association may be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second attorney to appoint a third.

14. Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the Commissioner; and, when so revoked, the office will communicate

directly with the applicant, or such other attorney as he may appoint. A power of attorney appointing a second principal attorney will not be entered unless such power of attorney specifically revokes that given the principal attorney of record (Rule 8). An attorney will be promptly notified by the docket clerk of the revocation of his power of attorney.

15. For gross misconduct the Commissioner may refuse to recognize any person as an attorney, either generally or in any particular case; but the reasons for such refusal will be duly recorded and be subject to the approval of the Secretary of the Interior.

WHO MAY REGISTER A TRADEMARK.

Act of Feb. 20, 1905, sec. 1.

16. A trademark may be registered by any person, firm, corporation, or association domiciled within the territory of the United States, or residing in or located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, and who is the owner of such trademark, and uses the same in commerce with foreign nations, or among the several states, or with Indian tribes, upon payment of the fee required by law and other due proceedings had. (See Rules 17 and 20.)

Act of Feb. 20, 1905, secs. 1, 2, and 4; Act of May 4, 1906, sec. 3.

17. Except as provided by sec. 3 of the Act of May 4, 1906, no trademark will be registered to an applicant residing or located in a foreign country unless such country, by treaty, convention, or law, affords similar privileges to the citizens of the United States, nor unless the trademark has been registered by the applicant in the foreign country in which he resides or is located, nor until such applicant has filed in this office a certified copy of the certificate of registration of his trademark in the country where he resides or is located. In such cases it is not necessary to state in the application that the trademark has been used in commerce with the United States or among the several states thereof.

Act of May 4, 1906, sec. 3.

18. The owner of a trademark, residing or located in a foreign country and who shall have a manufacturing establish-

ment within the territory of the United States, may register a trademark used on the products of such establishment upon complying with the provisions of the Act of February 20, 1905, as prescribed for owners of trademarks domiciled within the territory of the United States.

WHAT MAY BE REGISTERED AS A TRADEMARK.

Act of Feb. 20, 1905, secs. 1, 5, and 21; Act of Feb. 18, 1909, sec. 1.

19. No trademark will be registered to an owner domiciled within the territory of the United States unless it shall be made to appear that the same is used as such by said owner in commerce among the several states, or between the United States and some foreign nation or Indian tribe; no trademark, except as provided by sec. 3 of the Act of May 4, 1906, will be registered to an owner residing in or located in a foreign country unless said country, by treaty, convention, or law, affords similar privileges to the citizens of the United States; no trademark will be registered which consists of or comprises immoral or scandalous matter, or which consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any state or municipality, or of any foreign nation, or which consists of or comprises any design or picture that has been adopted by any fraternal society as its emblem, unless it shall be shown to the satisfaction of the Commissioner of Patents that the mark was adopted and used as a trademark by the applicant or applicant's predecessors, from whom title is derived, at a date prior to the date of its adoption by such fraternal society as its emblem, or which trademark is identical with a registered or known trademark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resembles a registered or known trademark owned and in use by another, and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, or which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they

are used, or of the character or quality of such goods, or merely a geographical name or term; no portrait of a living individual will be registered as a trademark, except by the consent of such individual evidenced by an instrument in writing; and no trademark will be registered which is used in unlawful business, or upon any article injurious in itself, or which has been used with the design of deceiving the public in the purchase of merchandise, or which has been abandoned.

Act of Feb. 20, 1905, sec. 5; Act of Feb. 18, 1911.

20. Any mark, used in commerce with foreign nations or among the several states or with Indian tribes, may be registered if it has been in actual and exclusive use as a trademark of the applicant, or his predecessors from whom he derived title, for 10 years next preceding February 20, 1905. (See Rule 32.)

THE APPLICATION.

Act of Feb. 20, 1905, sec. 1.

21. An application for the registration of a trademark must be made to the Commissioner of Patents and must be signed by the applicant.

Act of Feb. 20, 1905, sec. 1; Act of Feb. 18, 1909, sec. 1.

22. A complete application comprises:

(*a*) A petition, requesting registration, signed by the applicant. (See Form 1, p. 611.)

(*b*) A statement specifying the name, domicile, location, and citizenship of the party applying, and if the applicant be a corporation or association, the state or nation under the laws of which organized; the class of merchandise (according to the official classification), and the particular description of goods comprised in such class upon which the trademark has actually been used; a statement of the mode in which the same is applied and affixed to the goods, and the length of time during which the trademark has been used upon the goods specified. A description of the trademark itself shall be included, if desired by the applicant or required by the Commissioner, provided such description is of a character to meet the approval of the Commissioner. (See sec. 29 of the Act of February 20, 1905, and Forms 2, 4, 6, and 10, pp. 612, 613, 614 and 616.

(*c*) A declaration complying with sec. 2 of the Act of February 20, 1905, as amended by the Act of February 18, 1909. (See Forms 3, 5, 7, 8, 9, and 11, pp. 612, 613, 614, 615, 616, and 617.)

(*d*) A drawing of the trademark, signed by the applicant, or his attorney, which shall be a *fac-simile* of the same as actually used upon the goods. (See Rules 36 and 37 and specimen drawing, p. 619.)

(*e*) Five specimens (*or fac-similes, when, from the mode of applying or affixing the trademark to the goods, specimens can not be furnished*) of the trademark as actually used upon the goods.

(*f*) A fee of $10.

23. The petition, the statement, and the declaration must be in the English language and written on one side of the paper only.

24. The name of the applicant will appear in the certificate of registration precisely as it is signed to the statement of the application, and, therefore, the signature to the statement must be the correct signature of the applicant, and the name of the applicant wherever it appears in the papers of the application will be made to agree with the name as signed to the statement.

25. No information will be given, without authority of the applicant, respecting the filing of an application for the registration of a trademark by any person, or the subject-matter thereof, unless it shall, in the opinion of the Commissioner, be necessary to the proper conduct of business before the office.

Act of Feb. 20, 1905, secs. 14 and 24.

26. All applications for registration pending in the Patent Office at the time of the passage of the Act of February 20, 1905, may be amended with a view to bringing them and the certificates issued under such applications under the provisions of said act, and the prosecution of such applications may be proceeded with under its provisions without the payment of further fee. When such an application is amended to bring it under the Act of February 20, 1905, it will be given a serial number and a date of filing under said act.

A trademark, registered under the Act of March 3, 1881, may be registered under the Act of February 20, 1905, but the application for such registration will be subject to examination in

the same manner as other applications filed under said Act of February 20, 1905.

Act of Feb. 20, 1905, sec. 4.

27. An application for registration of a trademark, filed in this country by any person who has previously regularly filed in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States an application for registration of the same trademark, shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same trademark was first filed in such foreign country: *Provided*, That such application be filed in this country within four months from the date on which the application was first filed in such foreign country.

Act of Feb. 20, 1905, sec. 3.

28. Every applicant for registration of a trademark, or for renewal of registration of a trademark, who is not domiciled within the United States, shall, before the issuance of the certificate of registration, designate, by a notice in writing, filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings affecting the right of ownership of the trademark of which such applicant may claim to be the owner may be served. This notice shall be indorsed upon the file wrapper of the application.

Act of Feb. 20, 1905, sec. 3.

29. In proceedings relating to an application, or to a registration under the Act of February 20, 1905, it shall be deemed sufficient to serve notice upon the applicant, registrant, or representative, by leaving a copy of the process or notice of proceedings addressed to him at the last address of which the Commissioner of Patents has been notified.

Act of May 4, 1906, sec. 2.

30. A trademark may, at the option of the applicant, be registered on a single application, for any or all goods comprised in a single class of merchandise, provided the particular description of goods be stated, and provided that the mark has been

actually used upon all of the goods specified. (See classification of merchandise, Appendix J, *post.*)

Act of Feb. 20, 1905, sec. 2; Act of Feb. 18, 1909, sec. 2.

31. The application must be accompanied by a written declaration, verified by the applicant, or by a member of the firm, or by an officer of the corporation or association applying, to the effect that he believes himself, or the firm, corporation, or association in whose behalf he makes the declaration, to be the owner of the trademark sought to be registered, and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use the trademark in the United States, either in the identical form or any such near resemblance thereto as might be calculated to deceive; that such trademark is used in commerce among the several states, or with foreign nations, or with Indian tribes; that the description and drawing truly represent the trademark sought to be registered; that the specimens (*or fac-similes*) show the mark as actually used upon the goods; and that the facts set forth in the statement are true. (See Rule 17 and Forms 3, 5, 7, 8, 9, and 11, pp. 612, 613, 614, 615, 616, and 617.)

Act of Feb. 18, 1911.

32. Where application is made under sec. 5 of the Act of February 20, 1905, on the ground that the mark has been in actual and exclusive use as a trademark by the applicant, or his predecessors from whom he derived title, for 10 years next preceding February 20, 1905, the applicant shall, in addition to the requirements of sec. 2 of said act, make oath to such actual use of the mark as a trademark by himself or his predecessors, or by those from whom title to the same is derived, for the period specified, and that, to the best of his knowledge and belief, such use has been exclusive. (See Form 8, p. 615.)

Act of Feb. 20, 1905, sec. 2.

33. If the applicant resides or is located in a foreign country, the declaration required, unless the application be presented under the provisions of sec. 3 of the Act of May 4, 1906, shall also set forth that the trademark has been registered by the applicant, or that an application for the registration thereof

has been filed by him in the foreign country in which he resides or is located, and shall give the date of such registration, or of the application therefor, as the case may be. In such cases it shall not be necessary to state that the mark has been used in commerce with the United States or among the states thereof.

Act of May 4, 1906, sec. 3.

If the application be presented under the provisions of sec. 3 of the Act of May 4, 1906, the declaration, in addition to the requirements of Rule 31, must state that the applicant has a manufacturing establishment within the territory of the United States and that the goods upon which the trademark is used are the product of such establishment.

Act of Feb. 20, 1905, sec. 2.

34. The declaration may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, *chargé d'affaires,* consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by the certificate of a diplomatic or consular officer of the United States, the declaration being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the same is made, except that no acknowledgment may be taken before any attorney appearing in the case. When the person before whom the declaration is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate of a clerk of a court of record, or other proper officer having a seal.

35. Amendment of the declaration will not be permitted. If that filed with the application be faulty or defective, a substitute declaration must be filed.

DRAWING.

36. (1) The drawing must be made upon pure white paper of a thickness corresponding to two-sheet Bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

(2) The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin all work and signatures must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring downwardly from the marginal line, a space of not less than 1¼ inches is to be left blank for the heading of title, name, number, and date. (See specimen drawing, p. 619.)

(3) All drawings must be made with the pen only. Every line and letter, signatures included, must be absolutely black. This direction applies to all lines, however fine, and to shading. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open.

Act of Feb. 20, 1905, sec. 1; Act of Feb. 18, 1909, sec. 1.

(4) The name of the proprietor of the trademark, signed by himself or by his attorney of record, must be placed at the lower right-hand corner of the sheet within the marginal lines, but in no instance should it encroach upon the drawing.

(5) When the view is longer than the width of the sheet, the sheet should be turned on its side and the heading should be placed at the right and the signature at the left, occupying the same space and position as in an upright view and being horizontal when the sheet is held in an upright position.

(6) Drawings transmitted to the office should be sent flat, protected by a sheet of heavy binder's board, or should be rolled for transmission in a suitable mailing tube. They should never be folded.

(7) An agent's or attorney's stamp, or advertisement, or written address will not be permitted upon the face of a drawing, within or without the marginal line.

37. The office, at the request of applicants, will furnish the drawings at cost.

EXAMINATION OF APPLICATIONS.

Act of Feb. 20, 1905, sec. 6.

38. All complete applications for registration are considered, in the first instance, by the Examiner in charge of Trademarks. Whenever, on examination of an application, registration is

refused for any reason whatever, the applicant will be notified thereof. The reasons for such refusal will be stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of further prosecuting his application.

39. The examination of an application and the action thereon will be directed throughout to the merits, but in each letter the Examiner shall state or refer to all his objections.

Act of Feb. 20, 1905, sec. 6.

40. If, on examination of an application for the registration of a trademark, it shall appear that the applicant is entitled to have his trademark registered under the provisions of the law, the mark will be published in the Official Gazette at least once. Such publication shall be at least thirty days prior to the date of registration.

If no notice of opposition be filed within thirty days after such publication, the applicant or his attorney will be duly notified of the allowance of his application, and a certificate of registration will be issued as provided in Rule 58.

The weekly issue closes on Thursday, and the certificates of registration of that issue bear date as of the fourth Tuesday thereafter.

AMENDMENTS.

41. The statement may be amended to correct informalities, or to avoid objections made by the office, or for other reasons arising in the course of examination, but no amendments to the description or drawing of the trademark will be permitted unless warranted by something in the specimens (*or fac-similes*) as originally filed.

42. In every amendment the exact word or words to be stricken out or inserted in the statement must be specified and the precise point indicated where the erasure or insertion is to be made. All such amendments must be on sheets of paper separate from the papers previously filed, and written on but one side of the paper.

Erasures, additions, insertions, or mutilations of the papers and records must not be made by the applicant or attorney.

43. When an amendatory clause is amended, it must be wholly re-written, so that no interlineation or erasure shall appear in

the clause, as finally amended, when the application is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the Examiner may require the entire statement to be re-written.

44. After allowance, the Examiner will exercise jurisdiction over an application only by special authority from the Commissioner.

Amendments may be made after the allowance of an application, if the case has not been printed, on the recommendation of the Examiner, approved by the Commissioner, without withdrawing the case from issue.

45. After the completion of the application, the office will not return the papers for any purpose whatever. If the applicant has not preserved copies of the papers which he wishes to amend, the office will furnish them on the usual terms.

45a. If an applicant fail to prosecute his application within one year prior to November 1, 1911, or for one year after the date when the last official notice of any action by the office was mailed to him, the application will be held to be abandoned, as set forth in Rule 57a.

45b. Whenever action upon an application is suspended upon request of an applicant and whenever an applicant has been called upon to put his application in condition for interference, the period of one year running against such application shall be considered as beginning at the date of the last official action preceding such actions.

45c. Acknowledgment of the filing of an application is an official action. Suspensions will only be granted for good and sufficient cause and for a reasonable time specified.

45d. Only one suspension will be granted by the Examiner of Trademarks. Any further suspension must be approved by the Commissioner.

INTERFERENCE, OPPOSITION, AND CANCELLATION.

46. Whenever application is made for the registration of a trademark which is substantially identical with a trademark appropriated to goods of the same descriptive properties, for which a certificate of registration has been previously issued to another, or for registration of which another had previously

made application, or which so nearly resembles such trademark, or a known trademark owned and used by another, as, in the opinion of the Commissioner, to be likely to be mistaken therefor by the public, an interference will be declared.

The practice in trademark interferences will follow, as nearly as practicable, the practice in interferences between applications for patents.

47. Before the declaration of interference, all preliminary questions must have been settled by the Examiner in charge of Trademarks, and the trademark which is to form the subject-matter of the controversy must have been decided to be registrable, and must have been published at least once in the Official Gazette of the Patent Office.

Whenever two or more applicants are found to be claiming substantially the same registrable trademark, and the application of one of the applicants is ready for publication, the Examiner in charge of Trademarks may require the other applicants to put their applications in condition for publication within a time specified, in order that an interference may be declared. If any party fail to put his application in condition for publication within the time specified, the declaration of interference will not be delayed, but after final judgment the application of such party will be held for revision and restriction, subject to interference with other applications or registered trademarks.

48. The Examiner in charge of Interferences may, either before or in his final decision in an interference or opposition, direct the attention of the Commissioner to any matter which may have come to his notice which can not be acted upon by him, which in his opinion precludes a proper determination of questions raised by the proceeding, or which amounts to a statutory bar to registration of the mark to any or all of the parties. The Commissioner may, before judgment, suspend the interference or opposition and remand the same to the Examiner in charge of Trademarks for his consideration of the matters to which attention has been directed. If the case be not so remanded, the Examiner in charge of Trademarks will, after judgment, consider any matter affecting right to registration which may have been brought to his attention, unless the same shall have been previously disposed of in the proceeding. From the

decision of the Examiner in charge of Trademarks appeals may be taken as in other cases.

49. Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude a proper determination of the question of the right of registration, or which deny the registrability of an applicant's mark, should contain a full statement of the grounds relied upon, and should, if possible, be made not later than the thirtieth day after the notices of the interference have been mailed. Such motions, and all motions of a similar character, should be accompanied by a motion to transmit the same to the Examiner in charge of Trademarks, and such motion to transmit will be noticed for hearing upon a day certain before the Examiner in charge of Interferences. When in proper form the motion presented will, with the files and papers, be transmitted, by the Examiner in charge of Interferences, for determination, to the Examiner in charge of Trademarks, who will thereupon fix a day certain when said motion will be heard before him upon the merits, and give notice thereof to all the parties. If a stay of proceedings be desired, a motion therefor should accompany the motion for transmission.

When the motion has been decided by the Examiner in charge of Trademarks, the files and papers, with his decision, will be sent at once to the docket clerk.

Motions to shift the burden of proof should be made before, and will be determined by, the Examiner in charge of Interferences. No appeal from the decision on such motion will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority.

50. The decision of the Examiner in charge of Trademarks, upon a motion for dissolution, will be binding upon the Examiner in charge of Interferences unless reversed or modified on appeal. Unless appeal be taken within the time limited for appeal, the Examiner in charge of Trademarks will return the files and papers with his decision to the Examiner in charge of Interferences.

Act of Feb. 20, 1905, secs. 6 and 14; Act of Mar. 2, 1907, sec. 2.

51. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing a written

notice of opposition, stating the grounds therefor, within 30 days after the publication of the mark sought to be registered, which notice of opposition shall be accompanied by the fee required by law and shall be verified by the person filing the same before one of the officers mentioned in sec. 2 of the Act of February 20, 1905. An opposition may be filed by a duly authorized attorney, but such opposition shall be null and void unless duly verified by the opposer, within a reasonable time after such filing. A duplicate copy of the notice of opposition must be filed, either with the notice of opposition or within a reasonable time after the filing of the same.

Act of Feb. 20, 1905, sec. 13.

52. Any person, deeming himself to be injured by the registration of a trademark in the Patent Office, may, at any time, make application (see Form 13, p. 618) to the Commissioner to cancel the registration thereof. Such application shall be filed in duplicate, shall state the grounds for cancellation, and shall be verified by the person filing the same, before one of the officers mentioned in sec. 2 of the Act of February 20, 1905. (See Rule 34.)

Act of Feb. 20, 1905, sec. 13.

53. If it shall appear, after a hearing before the Examiner of Interferences, that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the Examiner in charge of Interferences shall so decide, the Commissioner shall cancel the registration of the mark, unless appeal be taken within the limit fixed.

54. In cases of opposition, and of applications for cancellations, the Examiner in charge of Trademarks shall forward the files and papers to the Examiner in charge of Interferences, who shall give notice thereof to the applicant or registrant. The applicant or registrant must make answer at such time, not less than 30 days from the date of the notice, as shall be fixed by the Examiner in charge of Interferences.

55. The proceedings, on oppositions, and on applications for cancellation, shall follow, as nearly as practicable, the practice in interferences between applications for patents.

APPEALS.

56. Every applicant whose mark has been twice refused registration by the Examiner of Trademarks for the same reasons, upon grounds involving the merits of the application, may appeal to the Commissioner in person upon payment of the fee required by law. Such refusal may be considered by the Examiner of Trademarks as final.

There must have been two refusals to register the mark as originally filed, or, if amended in matter of substance, the amended mark, and, except in cases of division, all preliminary and intermediate questions relating to matters not affecting the merits of the application must have been settled before the case can be appealed to the Commissioner.

Upon receiving a petition stating concisely and clearly any proper question which has been acted upon by the Examiner in charge of Trademarks and which does not involve the merits of the trademark claimed, the refusal of registration of the trademark, or a requirement for division, and also stating the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the Commissioner, and directing the Examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within five days after being notified of the order fixing the day of hearing. The Examiner shall, at the time of making such statement, furnish a copy thereof to the petitioner. No fee is required for such a petition.

Act of Feb. 20, 1905, sec. 9.

57. From the adverse decision of the Commissioner of Patents upon the right of an applicant to register a trademark, or from the decision of the Commissioner in cases of interference, opposition, or cancellation, an appeal may be taken to the Court of Appeals of the District of Columbia in the manner prescribed by the rules of that court.

ABANDONED APPLICATIONS.

57a. An abandoned trademark application is one which has not been prosecuted within one year prior to November 1, 1911, or completed and prepared for examination within one year after the filing of the petition, or which the applicant has failed

to prosecute within one year after any action therein of which notice has been duly given or which the applicant has expressly abandoned by filing in the office a written declaration of abandonment, signed by himself and assignee, if any, identifying his application by serial number and date of filing.

57b. Prosecution of an application to save it from abandonment must include such proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

57c. Before an application abandoned by failure to complete or prosecute can be revived as a pending application it must be shown to the satisfaction of the Commissioner that the delay in the prosecution of the same was unavoidable.

57d. When a new application is filed in place of an abandoned or rejected application, a new petition, statement, declaration, drawing and fee will be required.

ISSUE, DATE, AND DURATION OF CERTIFICATE.

Act of Feb. 20, 1905, sec. 11.

58. When the requirements of the law and of the rules have been complied with, and the office has adjudged a trademark registrable, a certificate will be issued, signed by the Commissioner, under the seal of the Patent Office, to the effect that the applicant has complied with the law and that he is entitled to registration of his trademark. The certificate shall state the date on which the application for registration was received in the Patent Office. Attached to the certificate will be a photolithographed copy of the drawing of the trademark and a printed copy of the statement and of the declaration.

Act of Feb. 20, 1905, sec. 12.

59. A certificate of registration shall remain in force 20 years from its date, except that, in case a trademark be previously registered in a foreign country, such certificate shall cease to be in force on the day on which the trademark ceases to be protected in such foreign country, and shall in no case remain in force more than 20 years unless renewed.

Act of Feb. 20, 1905, secs. 12 and 14.

60. A certificate of registration may be, from time to time, renewed for like periods on payment of the renewal fees required, upon request by the registrant, his legal representatives, or transferees of record in the Patent Office, and such request may be made at any time not more than six months prior to the expiration of the period for which the certificate of registration was issued or renewed.

Act of Feb. 20, 1905, sec. 12.

61. Certificates of registration in force on the 1st day of April, 1905, shall remain in force for the periods for which they were issued, and shall be renewable on the same conditions and for the same periods as certificates issued under the provisions of the Act of February 20, 1905, and, when so renewed, shall have the same force and effect as certificates issued thereunder.

Act of Feb. 20, 1905, sec. 4.

62. A certificate of registration shall not be issued to an applicant located in a foreign country for any trademark, for registration of which he has filed an application in such foreign country, until such mark has been actually registered by him in the country in which he is located.

ASSIGNMENTS.

Act of Feb. 20, 1905, sec. 10.

63. Every registered trademark and every mark for the registration of which application has been made, together with the application for registration thereof, shall be assignable in connection with the goodwill of the business in which the mark is used. Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or state in which the same is executed. Provision is made for recording such assignments in the Patent Office; but no such assignment will be recorded unless it is in the English language, nor unless an application for the registration of the mark shall have been first filed in the Patent Office, and such assignment must identify the application by serial number and date of

filing, or, when the mark has been registered, by the certificate number and the date thereof. No particular form of assignment is prescribed.

Act of Feb. 20, 1905, sec. 10.

64. An assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it be recorded in the Patent Office within three months from the date thereof.

Act of Feb. 20, 1905, sec. 11.

65. The certificate of registration may be issued to the assignee of the applicant, but the assignment must first be entered of record in the Patent Office.

COPIES AND PUBLICATIONS.

Act of Feb. 20, 1905, secs. 11 and 14.

66. After a trademark has been registered, printed copies of the statement and declaration in each case, with a photolithographed copy of the drawing of the trademark, may be furnished by the office upon the payment of the fee. (See Rule 69.)

67. An order for a copy of an assignment must give the liber and page of the record, as well as the name of the applicant; otherwise an extra charge will be made for the time consumed in making a search for such assignment.

68. The Official Gazette of the Patent Office will contain a list of all trademarks registered, giving, in each case, a statement of the goods to which the trademark is applied, the name and address of the applicant, the date of filing and serial number of the application, and the date of the publication of the trademark in the Official Gazette.

FEES.

69.

On filing each original application for registration of a trademark.	$10.00
On filing each application for renewal of the registration of a trademark	10.00
On filing notice of opposition to the registration of a trademark..	10.00

On appeal from the Examiner in charge of Trademarks to the Commissioner of Patents	15.00
On appeal from the decision of the Examiner in charge of Interferences, awarding ownership of a trademark or cancelling the registration of a trademark, to the Commissioner of Patents	15.00
On appeal from the decision of the Examiner in charge of Trademarks, on a motion for the dissolution of an interference on the ground of non-interference in fact or non-registrability of a mark, to the Commissioner of Patents	15.00
For manuscript copies, for every 100 words or fraction thereof	.10
For recording every assignment, power of attorney, or other paper of 300 words or under	1.00
Of over 300 and under 1,000 words	2.00
And for each additional thousand words or fraction thereof	1.00
For abstracts of title:	
For the search, one hour or less, and certificate	1.00
Each additional hour or fraction thereof	.50
For each brief from the digest of assignments of 200 words or less	.20
Each additional hundred words or fraction thereof	.10
For searching titles or records, one hour or less	.50
Each additional hour or fraction thereof	.50
For a single printed copy of statement, declaration, and drawing	.05
If certified, for the grant, additional	.50
For the certificate	.25

Rev. Stat., 4935.

70. All payments of money required for office fees must be made in specie, treasury notes, national bank notes, treasury certificates of deposit, post-office money orders, bank drafts, or certified checks. Money orders and checks should be made payable to the "Commissioner of Patents." Payment may also be made to the Treasurer, or to any of the Assistant Treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor. The duplicate receipt or certificate of deposit must be filed in the Patent Office within ten days after the money is paid.

71. Money sent by mail to the Patent Office will be at the risk of the sender. Letters containing money should be registered.

REPAYMENT OF MONEY.

Rev. Stat., 4936; Act of Feb. 20, 1905, sec. 15.

72. Money paid by actual mistake, such as a payment in excess, or when not required by law, or by neglect or misinformation on the part of the office, will be refunded; but a mere change of purpose after the payment of money, as when a party desires to withdraw his application for the registration of a trademark, or to withdraw an appeal, will not entitle a party to demand such a return.

NOTICE OF REGISTRATION.

Act of Feb. 20, 1905, sec. 28.

73. It shall be the duty of the registrant to give notice to the public that a trademark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or "Reg. U. S. Pat. Off.," or, when from the character and size of the trademark, or from its manner of attachment to the article to which it is appropriated, this can not be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; otherwise, on a suit for infringement, no damages shall be recovered except on proof that the defendant was duly notified of infringement, and continued the same after such notice.

AMENDMENTS OF THE RULES.

74. All amendments of the foregoing rules will be published in the Official Gazette.

QUESTIONS NOT SPECIFICALLY PROVIDED FOR.

75. All cases not specifically defined and provided for in these rules will be decided in accordance with the merits of each case under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

THOMAS EWING,
Commissioner of Patents.

The foregoing rules were approved October 14, 1911, by the Secretary of the Interior.

RECORDING TRADEMARKS WITH COLLECTORS OF CUSTOMS.

TREASURY DEPARTMENT, *September 7, 1909.*

To Collectors of Customs and Others Concerned:

The attention of officers of the customs and others is invited to the following provisions of sec. 27 of the Act approved February 20, 1905, effective April 1, 1905:

Section 27. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any customhouse of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provision of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trademarks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trademark, issued in accordance with the provisions of this act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the department *fac-similes* of his name, the name of the locality in which his goods are manufactured, or of his registered trademark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

The provisions of this section give to manufacturers and traders located in foreign countries, which, by treaty stipulations, give similar privileges to the United States, the same advantages as are given to domestic manufacturers and traders. The act does not affect names or trademarks heretofore recorded in the Treasury Department, and as to them the protection granted so far as concerns prohibition of importation will continue. Nor does the act appear to make it compulsory on the part of domestic manufacturers or traders, or foreign

manufacturers or traders, to register names (not trademarks), with the Commissioner of Patents, in order to prevent illegal importations.

Domestic manufacturers and traders and foreign manufacturers and traders, to avail themselves of the privileges of the act, so far as concerns trademarks, are required to register their trademarks with the Commissioner of Patents before the Treasury Department can act.

Applications for recording the names and trademarks in this department under sec. 27 will state the name of the owner, his residence, and the locality in which his goods are manufactured, and in the case of trademarks should be accompanied with a certified copy of the certificate of registration of his trademark issued in accordance with the provisions of the act and the names of the ports to which *fac-similes* should be sent. In the case of the name of a domestic manufacture, manufacturer, or trader (not registered as a trademark in the Patent Office), the application must be accompanied by the proper proof of ownership and proof as to the country or locality in which his goods are manufactured, which must consist of the affidavit of the owner or one of the owners, certified by an officer entitled to administer oaths and having a seal.

On the receipt by a customs officer of any such *fac-similes*, with information from the department that they have been recorded therein, he will properly record and file them and will exercise care to prevent the entry at the customhouse of any article of foreign manufacture copying or simulating such mark.

No fees are charged for recording trademarks in the Treasury Department and customhouses.

A sufficient number of *fac-similes* should be forwarded to enable the department to send one copy to each port named in the application, with ten additional copies for the files of the department.

Especial attention is invited to the provision in said section prohibiting the entry of articles "which shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured," and collectors

and other officers of the customs are instructed to use due diligence to prevent violations of this provision.

The provisions of the act also apply to Porto Rico, the Philippine Islands, Hawaii, and any other territory under the jurisdiction and control of the United States.

Attention is also invited to the following provisions of sec. 3 of the Act approved May 4, 1906, effective July 1, 1906:

Section 3. That any owner of a trademark who shall have a manufacturing establishment within the territory of the United States shall be accorded, so far as the registration and protection of trademarks used on the products of such establishment are concerned, the same rights and privileges that are accorded to owners of trademarks domiciled within the territory of the United States by the act entitled "An act to authorize the registration of trademarks used in commerce with foreign nations or among the several states or with Indian tribes, and to protect the same," approved February 20, 1905.

This department has ruled that affidavits accompanying applications for recording the names of foreign manufactures, manufacturers, or traders (not registered as trademarks in the Patent Office), may be certified by American consular officers.

JAMES B. REYNOLDS,
Acting Secretary.

PATENT OFFICE FORMS.

The following forms illustrate the manner of preparing papers for applications for registration of trademarks. Applicants will find their business facilitated by following them.

(1) PETITION.

To the Commissioner of Patents:

The undersigned presents herewith a drawing and five specimens [*or facsimiles*] of his trademark, and requests that the same, together with the accompanying statement and declaration, may be registered in the United States Patent Office in accordance with the law in such cases made and provided.

———,
[*Signature of applicant.*]

Dated ——— [*date of execution*].

(2) STATEMENT FOR AN INDIVIDUAL.

To all whom it may concern:

Be it known that I, ———, [*name of applicant*] a ——— [*citizenship of applicant*] residing at ———, [*applicant's address*] and doing business at ———, [*business address*] have adopted and used the trademark shown in the accompanying drawing [*see Rule 22b*] for ———, [*particular description of goods*] in class No. ——— [*number and title of class—see classification*].

The trademark has been continuously used in my business (and in the business of my predecessor, ———), [*name of predecessor, if any; if applicant has had no predecessors, omit this clause*] since ——— [*earliest date of use*].

The trademark is applied or affixed to the goods, or to the packages containing the same, by placing thereon a printed label on which the trademark is shown [*or state other mode or modes of application*].

———,

[*Signature of applicant; first name must be given in full*].

(3) DECLARATION FOR AN INDIVIDUAL.

State of ———,

County of ———, ss:

———, [*name of applicant*] being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the trademark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trademark in the United States, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trademark is used by him in commerce among the several states of the United States (and between the United States and foreign nations or Indian tribes, and particularly with ———); [*names of foreign countries or Indian tribes; if applicant does not have commerce with foreign nations or Indian tribes, this clause should be omitted*] that the description and drawing presented, truly represents the trademark sought to be registered; and that the specimens [*or fac-similes*] show the trademark as actually used upon the goods.

———,

[*Signature of applicant.*]

Subscribed and sworn to before me, a ———, [*official title*] this ——— [*date of execution*].

[L. S.]

———,

——— [*Official title.*]

(4) STATEMENT FOR A FIRM.

To all whom it may concern:

Be it known that we, ———, [*firm name*] a firm domiciled in ———, [*domicile*] doing business at ———, [*business address*] and composed of the following members, ———, [*names of members of the firm*] citizens of ———, [*citizenship of members of the firm*] have adopted and used the trademark shown in the accompanying drawing [*see rule 22b*] for ———, [*particular description of goods*] in class No. ——— [*number and title of class—see classification*].

The trademark has been continuously used in our business (and in the business of our predecessors, ———), [*name of predecessors, if any; if applicant has had no predecessors, omit this clause*] since ——— [*earliest date of use*].

The trademark is applied or affixed to the goods, or to the packages containing the same, by placing thereon a printed label on which the trademark is shown [*or state other mode or modes of application*].

———,
[*Firm name*].
By ———,
[*Signature of a member of the firm.*]
A Member of the Firm.

(5) DECLARATION FOR A FIRM.

State of ———,
County of ———, ss:

———, [*name of affiant*] being duly sworn, deposes and says that he is a member of the firm, the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said firm is the owner of the trademark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trademark in the United States, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trademark is used by said firm in commerce among the several states of the United States (and between the United States and foreign nations or Indian tribes, and particularly with ———); [*names of foreign countries or Indian tribes; if applicant does not have commerce with foreign nations or Indian tribes, this clause should be omitted*] that the description and drawing presented truly represent the trademark sought to be registered; and that the specimens [*or facsimiles*] show the trademark as actually used upon the goods.

———,
[*Signature of affiant*].

Subscribed and sworn to before me, ———, [*official title*] this ——— [*date of execution*].

[L. S.]

———,
——— [*Official title.*]

(6) STATEMENT FOR A CORPORATION OR ASSOCIATION.

To all whom it may concern:

Be it known that ———, [*name of applicant*] a corporation [*if the applicant be an association, the word "association" should be substituted for the word "corporation"*] duly organized under the laws of ——— [*state or country under the laws of which organized*] and located in ———, [*location of corporation*] and doing business at ———, [*business address*] has adopted and used the trademark shown in the accompanying drawing [*see rule 22b*] for ———, [*particular description of goods*] in class No. ——— [*number and title of class—see classification*].

The trademark has been continuously used in the business of said corporation [*if the applicant be an association, the word "association" should be substituted for the word "corporation"*] (and in the business of its predecessors, ———), [*name of predecessors, if any; if applicant has had no predecessors, omit this clause*] since ——— [*give earliest date of use*].

The trademark is applied or affixed to the goods, or to the packages containing the same, by placing thereon a printed label on which the trademark is shown [*or state other mode or modes of application*].

———,
[*Name of applicant.*]

———, ———,
[*Signature of officer—official title.*]

(7) DECLARATION FOR A CORPORATION OR ASSOCIATION.

State of ———,
County of ———, ss:

———, [*name of affiant*] being duly sworn, deposes and says that he is the ——— [*official title*] of the corporation, [*if applicant be an association, the word "association" should be substituted for the word "corporation"*] the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes said corporation [*if applicant be an association, the word "association" should be substituted for the word "corporation"*] is the owner of the trademark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trademark in the United States, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trademark is used by said corporation [*if applicant be an association, the word "association" should be substituted for the word "corporation"*] in commerce among the several states of the United States (and between the United States and foreign nations or Indian tribes and particularly with ———); [*names of foreign nations or Indian tribes; if the applicant does not have*

commerce with foreign nations or Indian tribes, this clause should be omitted] that the description and drawing presented truly represent the trademark sought to be registered; and that the specimens [*or fac-similes*] show the trademark as actually used upon the goods.

———,
[*Signature of affiant.*]

Subscribed and sworn to before me, a ———, [*official title*] this ——— [*date of execution*].

[L. S.] ———,
——— [*Official title.*]

(8) DECLARATION FOR APPLICANTS UNDER THE TEN-YEAR PROVISO.

[In case the applicant is a firm, corporation, or association, the declaration should be modified accordingly.]

State of ———,
County of ———, ss:

———, [*name of applicant*] being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the mark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said mark in the United States, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said mark is used by him in commerce among the several states of the United States (and between the United States and foreign nations, or Indian tribes, and particularly with ———); [*names of foreign nations or Indian tribes; if applicant does not have commerce with foreign nations or Indian tribes, this clause should be omitted*] that the description and drawing presented truly represent the mark sought to be registered; that the specimens *or fac-similes*] show the mark as actually used upon the goods; and that the mark has been in actual use as a trademark of the applicant (and applicant's predecessors from whom title was derived) [*if applicant has had no predecessors, this clause should be omitted*] for ten years next preceding February 20, 1905, and that, to the best of his knowledge and belief, such use has been exclusive.

———,
[*Signature of affiant.*]

Subscribed and sworn to before me, a ———, [*official title*] this ——— [*date of execution*].

[L. S.] ———,
——— [*Official title.*]

(9) DECLARATION FOR FOREIGNER.*

United States Consulate,
London, England, ss:

———, [*name of affiant*] being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the trademark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trademark in the United States, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; (that said trademark has been registered in ———, [*name of county*] on ———, [*date*] No. ———); [*number of registration; if the trademark has not yet been registered, but an application for registration has been filed in the country where applicant resides or is located, this clause should be omitted and the following substituted therefor: "that an application for registration of said trademark was filed by him on the* ———, (date of filing) *in* ——— (name of country)]: that the description and drawing presented truly represent the trademark sought to be registered; and that the specimens [*or fac-similes*] show the trademark as actually used upon the goods.

———,
[*Signature of affiant.*]

Subscribed and sworn to before me, a ———, [*official title*] this ——— [*date of execution*].

[Seal.]

———,
——— [*Official title.*]

(10) STATEMENT FOR AN INDIVIDUAL UNDER SECTION 3 OF THE ACT OF MAY 4, 1906.

[In case applicant be a firm, corporation, or association, the statement should be modified accordingly.]

To all whom it may concern:

Be it known that I, ———, [*name of applicant*] a ———, [*citizenship of applicant*] residing at ———, [*applicant's residence*] and doing business at ———, [*business address*] and having a manufacturing establishment at ———, [*location of business*] have adopted and used the trademark shown in the accompanying drawing [*see rule 22b*] for the following products of such manufacturing establishment, namely, ———, [*particular description of goods*] in Class No. ——— [*number and title of class—see classification*].

The trademark has been continuously used in my business (and in the business of my predecessor, ———, [*name of predecessor, if any; if appli*

* In case the applicant is a firm, corporation, or association, the declaration should be modified accordingly.

ant has had no predecessor, omit this clause] since ——— [*earliest date of use*].

The trademark is applied or affixed to the goods, or to the packages containing the same, by placing thereon a printed label on which the trademark is shown [*or state other mode or modes of application*].

———,

[*Signature of applicant.*]

(11) DECLARATION FOR FOREIGNERS UNDER SECTION 3 OF THE ACT OF MAY 4, 1906.

[In case applicant be a firm, corporation, or association, the declaration should be modified accordingly.]

United States Consulate,
London, England, ss:

———, [*name of affiant*] being duly sworn, deposes and says that he is the applicant named in the foregoing statement; that he believes the foregoing statement is true; that he believes himself to be the owner of the trademark sought to be registered; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use said trademark in the United States, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that said trademark is used by him in commerce among the several states of the United States (and between the United States and foreign nations or Indian tribes, and particularly with ———); [*names of foreign countries or Indian tribes; if applicant does not have commerce with foreign nations or Indian tribes this clause should be omitted*] that the description and drawing presented truly represent the trademark sought to be registered; that the specimens [*or fac-similes*] show the trademark is actually used upon the goods; that his manufacturing establishment is located at ———; [*location of manufacturing establishment*] and that the goods for which the trademark is claimed in this application are the products of such establishment.

———,

[*Signature of affiant.*]

Subscribed and sworn to before me, a ———, [*official title*] this ——— [*date of execution*].

[Seal.]

———,

[*Official title*].

(12) NOTICE OF OPPOSITION.

[If the opposing party be a firm, corporation, or association, the notice of opposition should be modified accordingly.]

To the Commissioner of Patents:

In the matter of an application for the registration of a trademark for ———, [*particular goods*] Serial No. ———, [*number of application*]

filed ———, [*date of application*] by ———, [*name of applicant*] of ———, [*location or residence of applicant*] which was published on page —, Vol. —, No. —, [*page, volume and number*] of the Official Gazette of ———, [*date of the Official Gazette*] I, ———, [*name of party opposing*] residing at ———, [*residence or location of party opposing*] believe I would be damaged by such registration and I hereby give notice of my intention to oppose the registration of said trademark.

The grounds for opposition are as follows: [*here state the grounds for opposing registration*].

———,

[*Signature of opposing party.*]

State of ———,
County of ———, ss:

On this ———, [*date of execution*] before me, a ———, [*official title*] in and for ——— County, State of ———, personally appeared ———, [*name of party opposing*] who, being by me duly sworn [*or affirmed*], deposes and says that he has read the foregoing notice of opposition, and knows the contents thereof, and that the same is true of his own knowledge, except as to the matters therein stated on information and belief, and as to those matters he believes it to be true.

[L. S.]

———,

[*Official title.*]

(13) APPLICATION FOR CANCELLATION OF TRADEMARK.

[If the party applying for cancellation be a firm, corporation, or association, the application for the cancellation should be modified accordingly.]

To the Commissioner of Patents:

In the matter of trademark No. ———, [*number of registration*] registered ———, [*date of registration*] by ———, [*name of registrant*] of ———, [*residence or location of registrant*] I, ———, [*name of party applying for cancellation*] residing at ———, [*residence or location*] deem myself injured by said registration and I hereby apply for the cancellation thereof.

The grounds for cancellation are as follows: [*here state the grounds for cancellation*].

———,

[*Signature of party applying for cancellation.*]

State of ———,
City of ———, ss:

On this ———, [*date of execution*] before me, a ———, [*official title*] in and for city of ———, State of ———, personally appeared ———, [*name of party applying for cancellation*] who, being by me duly sworn [*or affirmed*], deposes and says that he has read the foregoing application for cancellation, and knows the contents thereof, and that the same is true of his own knowledge, except as to the matters therein stated on information and belief, and as to those matters he believes it to be true.

[L. S.]

———,

[*Official title*]

The size of the sheet must be exactly 10 x 15 inches. See rule 36 (2).

This space must be thirteen inches.

Proprietor.

By.

Attorney.

This space must be eight inches.

APPENDIX F.

TRADEMARK STATUTES OF THE STATES AND TERRITORIES.

ALABAMA.

No registration law.

Article 8, c. 196, Code, 1896, an act relating to the unauthorized use or defacement of the bottles, siphons, kegs, etc., of manufacturers, bottlers and venders of soda water and other beverages.

Act of March 1, 1901. An act for the protection of labels of labor unions.

ALASKA.

Carter's Annotated Alaska Codes, Page 18.

SECTION 84. Knowingly Using or Counterfeiting Trademarks, etc. That if any person shall wilfully and knowingly use or cause to be used any private brand, label, stamp, or trademark of another, either by counterfeiting the same or using any impression, or copy thereof made or prepared by the proprietor thereof, or shall wilfully and knowingly use or cause to be used any colorable imitation of such brand, label, stamp, or trademark, with intent to deceive any one, such person, upon conviction thereof, shall be punished by imprisonment in the county jail not less than one month nor more than six months, or by fine not less than twenty nor more than three hundred dollars.

ARIZONA.

REVISED STATUTES, 1913—PENAL CODE.

Title 9.

CHAPTER XII.

Sec. 316; P. C. 1901.

SECTION 357. Every such association, union or corporation that has heretofore adopted, or shall hereafter adopt, a label, trademark or form of advertisement, as aforesaid, shall file the

same in the office of the Secretary of State by leaving two copies, counterparts or *fac-similes* thereof, with the Secretary of State. Said Secretary shall deliver to such corporation, association or union so filing the same, a duly attested certificate of the record of the same, for which he shall receive a fee of three dollars; such certificate of record shall in all suits and prosecutions under this chapter be sufficient proof of the adoption of such label, trademark, or form of advertisement, and of the right of said union, corporation or association to adopt the same.

Sec. 319; P. C. 1901.

It shall be the duty of the Secretary of State to see that all associations, unions or corporations enjoying the benefits of labels, trademarks, or forms of advertisements herein described shall comply with the provisions of this section in all respects.

Fees of Secretary of State, $3.00 for the certificate, plus 25 cents for filing.

ARKANSAS.

REGISTRATION OF TRADEMARKS.

SECTION.

7960. Protection in use of, how secured.
7961. Declaration under oath of party claiming.
7962. Secretary of State not to record name unaccompanied by marks distinguishable from others.
7963. Copies of trademark, etc., under seal of Secretary of State, may be used as evidence.
7964. Trademarks to remain in force twenty-five years; exception.
7965. Penalty for violating trademark.
7966. No action allowed to protect trademark used in unlawful business or obtained by fraud, etc.
7967. Persons obtaining trademark by fraud liable for damages.
7968. Construction of act.
7969. For bottles, boxes, siphons, etc., how obtained. Fee of clerk.
7970. Unlawful for persons other than owner to fill bottles or deface mark.
7971. Or to have in possession, sell or destroy bottles, etc.
7972. Penalties for violation of act.
7973. Search warrant may be issued for. Party having arrested.
7974. Purchaser of contents to return bottles, casks, etc.
7975. Fines collected to go to general revenue fund of county.

SECTION 7960. Any person or firm in this state, or any of the United States or territories thereof, and any corporation created by the authority of this state, or the United States or

any of the states or territories thereof, and any person, firm or corporation, resident, or located in any foreign country, which, by treaty or convention, affords similar privileges to citizens of the United States, and who may be entitled to the exclusive use of any lawful trademark or device, or who may intend to adopt and use any trademark or device for exclusive use in this state, may obtain protection for such lawful trademark or device by complying with the following requisites and requirements:

First—By making out and filing in the office of the Secretary of State of this state, to be there registered or recorded, a statement specifying the names of the parties and their residence and place of business who desire the protection of the trademark, the class of merchandise, and particular description of goods comprised in such class, by which or to which the trademark has been or is intended to be appropriated; a description of the trademark itself or device, or combination of words, letters or figures or characters used or intended to be used as such, and the mode in which it has been or is intended to be applied and used, and the length of time, if any, during which the trademark has been in use.

Second—By making payment to the Secretary of State, for the use of the state, of a fee of not less than twenty-five nor more than one hundred dollars, to be determined by the Secretary according to a schedule of fees arranged with reference to the number of words, figures, characters, etc., contained in such statement, which schedule it is made the duty of the Secretary to make and keep posted up in his office.

Section 7961. The certificate prescribed in the preceding section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration, verified by the person or by some member of the firm or officer of the corporation by whom it is filed, to the effect that the party claiming the protection for the trademark has a right to the use of the same, and that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive, and that the *fac-similes* presented for record are true copies of the trademark sought to be protected.

SECTION 7962. The Secretary shall not receive and record any proposed trademark which is not and can not become a lawful trademark, or which is merely the name of a person, firm or corporation, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons, or which is identical with a trademark appropriated to the same class of merchandise and belonging to a different owner, and already registered or received for registration, or which so nearly resembles such last-mentioned trademark as to be likely to deceive the public. But this section shall not prevent the registry of any lawful trademark rightfully in use on the first day of May, 1883.

SECTION 7963. The time of the receipt of any trademark at the office of the Secretary of State, for registration or record, shall be noted and recorded. Copies of the trademark, and of the date of receipt thereof, and of the statement filed therewith, under the seal of the Secretary of State shall be furnished by the Secretary to any person who may apply therefor, and pay the fee therefor fixed by the Secretary, not exceeding the fee required for the original registration thereof, and such copies shall be evidence in any suit or proceeding in which such trademark shall be brought in controversy.

SECTION 7964. A trademark registered as above prescribed shall remain in force for twenty-five years from the date of such registration, except in case where such trademark is claimed for, and applied to, articles not manufactured in this state, and in which it receives protection under the laws of some other state, territory or foreign country for a shorter period, in which case it shall cease to have any force in this state, by virtue of this act, at the same time that it becomes of no effect elsewhere.

SECTION 7965. Such trademark, during the period it remains in force, shall entitle the person, firm or corporation registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath, as aforesaid, and no other party shall lawfully use the same trademark, or substantially the same or so nearly resembling it as to be calculated to deceive, on substantially

the same description of goods, or obtain, use or employ any article or thing whatever upon which such trademark, or substantially the same, or one so nearly resembling it as to be calculated to deceive, has been printed, painted, stamped, woven, branded or in any manner put or placed, for the purpose of putting up, shipping, selling, or otherwise disposing of substantially the same description of goods as those to which the same has been appropriated by the party rightfully entitled to the use of such trademark; and any person or member of any firm, or agent, or officer of any corporation, not entitled so to do, who shall knowingly use such trademark, or obtain, use or employ, as aforesaid, any such article or thing, or shall reproduce, counterfeit, copy or imitate any recorded trademark, and affix the same to, or, for the purpose of having the same used or disposed of, to affix to goods of substantially the same descriptive properties and qualities as those referred to in the registration, or who shall, with intent to defraud, deal in or sell, or keep, or offer for sale, or cause or procure the sale of, any goods of substantially the same descriptive properties as those referred to in the registration of any trademark registered in pursuance of this act, to which, or to the package in which the same are put up, is fraudulently affixed said trademark, or any colorable imitation thereof, calculated to deceive the public, knowing the same to be counterfeit, or not the genuine article, or goods referred to in said registration, shall be deemed guilty of a high misdemeanor, and upon conviction thereof, shall be punished by a fine not exceeding one thousand dollars, or imprisonment not exceeding one year, or both such fine and imprisonment, and such person, and also the firm of which he is a member, or the corporation of which he is an agent or officer, and which may have countenanced or connived at his act, shall moreover be liable to an action for damages for such wrongful act, at the suit of the owner of such trademark, and the party aggrieved shall also have his remedy according to the course of equity, to enjoin the wrongful use of his trademark, and to recover compensation therefor in any court of competent jurisdiction, and in any such action or suit such owner or aggrieved party shall be entitled to recover a reasonable amount for attorney's fees, to be paid by the party or parties held liable therein.

SECTION 7966. No action shall be maintained under the provisions of this act by any person claiming the exclusive right to any trademark which is used or claimed in any unlawful business, or upon any article which is injurious in itself, or upon any trademark which has been fraudulently obtained, or which has been formed and used with the design of deceiving the public in the purchase or use of any article of merchandise.

SECTION 7967. Any person who shall procure the registry of any trademark, or of himself as the owner of a trademark, by making false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence thereof to the person injured thereby.

SECTION 7968. Nothing in this act shall prevent, lessen, impeach or avoid any remedy at law, or in equity, which any party aggrieved by any wrongful use of any trademark might have, if the provisions of this act had not been enacted, and nothing in this act contained shall be construed by any court as abridging, or in any manner affecting unfavorably, the claim of any person to any trademark after the expiration of the term for which such trademark was registered.

Act March 31, 1883.

FOR BOTTLES, CASKS, BARRELS, ETC.

SECTION 7969. All manufacturers or dealers in carbonated goods, mineral waters, soda waters, wine, cider or other beverages, or manufacturers of medicine or other compounds requiring the use of kegs, casks, barrels, boxes, siphons, bottles or any other vessels, or containers, upon which the names, brands, marks or trademarks, or other designations of ownership or proprietorship stamped, engraved, etched, blown, impressed or otherwise produced upon such boxes, siphons, bottles, or any other vessels for containers, may file in the office of the county clerk of the county in which the principal place or office of business is situated, a *fac-simile* or description of the name or names, marks or devices so used by such manufacturer or dealer in such wares herein enumerated, and such description to be published in a public newspaper published in such county for

three successive weeks, and the act of so filing and causing it to be recorded by the county clerk, and publishing, shall operate as a trademark, securing to the said manufacturer the full protection of the law as a trademark, entitling the said manufacturer to the sole and exclusive use in the state of Arkansas of said marks, name or device. The county clerk shall receive for his services for so recording, one dollar to be paid by party having such record made.

SECTION 7970. It is hereby declared unlawful for any persons, corporate or otherwise, other than the proprietor, or by his written consent, to fill for the purpose of traffic, or for sale, with any compound whatever, any box, siphon, bottle or other container so marked, recorded in the office of the county clerk and published as aforesaid, or to deface, erase, obliterate, cover up or otherwise remove or cancel any such mark or device.

SECTION 7971. To have in possession otherwise than by contract with the proprietor of the goods herein enumerated, or with his duly accredited agents, of any of the vessels herein enumerated, or to use, buy, sell or dispose of any such vessels with or without contents of any kind, except by authority from the proprietor, or to wilfully or maliciously break, damage, mar, injure or destroy any such vessel, is declared hereby to constitute a misdemeanor, punishable by a fine upon conviction in a court of competent jurisdiction, an employe being equally liable with the principal so offending.

SECTION 7972. Any person violating any of the provisions of this act shall be deemed guilty of a misdemeanor, and upon conviction before a justice of the peace shall be fined for such unlawful use of each and every box, five dollars; for each and every siphon, five dollars; for each and every bottle, one dollar; and for every other receptacle, except a fountain, five dollars; and for each fountain, twenty-five dollars. The fines so designated to be the minimum in each case, the maximum not to exceed double the minimum.

SECTION 7973. Prosecutions under the provisions of this act may be maintained upon the information of the owner or proprietor of any of the vessels or containers mentioned herein

or of his agent, made under oath before a justice of the peace or any other officer having the same jurisdiction, setting forth that he has good reason to believe and does believe that another person than the rightful owner, without lawful authority is using or has used any of such vessels or receptacles contrary to the provisions of this act. Upon filing of such information the justice of the peace or any other officer having the same jurisdiction shall issue his search warrant and cause the same to be executed by a qualified officer upon the premises to be designated by the persons making the complaint, and if the said officer, acting under the said search warrant, shall discover any of such property as herein specified, he shall at once arrest the party named in such warrant and bring him before the justice of the peace, who shall proceed at once to hear and determine such case, and if the accused be found guilty he shall be fined as provided in sec. 7972.

SECTION 7974. Any merchant or dealer purchasing goods contained in such registered retainers paying only for the contents thereof, shall be liable for the value of said retainers, and shall, when demanded, return to the owner thereof all such containers when empty, or within a reasonable time after the goods have been delivered. If containers are demanded before empty by the owner thereof, he shall refund the price received for the contents thereof.

SECTION 7975. All moneys collected as fine or penalty under the provisions of this act, shall be returned by the constable unto the county treasurer to become a part of the general county revenue fund.

Act April 20, 1895.

TRADEMARK APPLICATION.

STATE OF ARKANSAS.

To the Secretary of State:

[Sworn application accompanying a trademark and label.]

Be it known, that ——— has heretofore adopted and used a certain trademark and label and herewith files the same for record in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof with said Secretary, and by filing therewith this sworn application.

(1) The name of the person so filing such trademark and label is ———.

(2) The class of merchandise upon which the same has been used is ———, and a particular description of the goods comprised in such class is ———.

(3) Said trademark and label, as here shown, has been used by applicant since ———.

(4) Said trademark and label is as follows: ———, the essential feature of which ———.

———,

By ———.

State of ———,
County of ———, ss:

I, ———, being first duly sworn, depose and say that I am ——— of ——— the applicant herein, and make this affidavit and verification in ——— behalf. That I have read the above and foregoing application and know the contents thereof, and that the facts set out therein are true; that said ——— so filing said trademark and label has the right to the use of the same and that no other person, firm, association, union, corporation or organization has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the two copies, counterparts or fac-similes filed herewith are true and correct.

———,

Subscribed and sworn to before me this ——— day of ———, 191—.

———,

Notary Public.

Fee $25.00 enclosed.

(To be filed in duplicate.)

CALIFORNIA.

TRADEMARK LAWS OF CALIFORNIA—POLITICAL CODE.

SECTION 3196. The phrase "trademark" as used in this chapter includes every description of word, letter, device, emblem, stamp, imprint, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to denote any goods to be goods imported, manufactured, produced, compounded or sold by him, other than any name, word, or expression generally denoting any goods to be of some particular class or description, and also any name or names, marks or devices, branded, stamped, engraved, etched,

blown, or otherwise attached or produced upon any cask, keg, bottle, vessel, siphon, can, case, or other package, used by any mechanic, manufacturer, druggist, merchant or tradesman, to hold, contain or inclose the goods so imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description. [Amendment approved March 3, 1903.]

SECTION 3196a. Any person may adopt a name for any farm or estate owned or leased by him, and register it in the manner provided for the registration of trademarks. Such registration shall have the same effect as the registration of a trademark. [Approved March 8, 1909.]

SECTION 3196b. Any person selling or marketing the products grown on any particular farm or estate may use the name of such farm or estate as a trademark on such products, in the same manner as provided for other trademarks in sec. 3196 of this code, and subject to the same rights and duties as provided in this article. [Approved March 8, 1909.]

SECTION 3197. Any person may record any trademark or name by filing with the Secretary of State his claim to the same, and a copy or description of such trademark or name, with his affidavit attached thereto, certified to by an officer authorized to take acknowledgments of conveyances, setting forth that he (or the firm or corporation of which he is a member), is the exclusive owner, or agent of the owner of such trademark or name. [Amendment approved March 21, 1911.]

SECTION 3198. The Secretary of State must keep for public examination a record of all trademarks or names filed in his office, with the date when filed and name of claimant; and must at the time of filing issue to the claimant a certificate of such filing under the great seal of the state, and collect from such claimant, a fee of five dollars, as provided for in section four hundred and sixteen of this code; *provided, however,* the Secretary of State shall refuse to file any trademark or name identical with, or so similar to any trademark or name already filed as to be calculated or liable to deceive. [Amendment approved March 6, 1909.]

SECTION 3199. Any person who has first adopted and used a trademark or name, whether within or beyond the limits of this state, is its original owner. Such ownership may be transferred in the same manner as personal property, and is entitled to the same protection by suits at law; and any court of competent jurisdiction may restrain, by injunction, any use of trademarks or names in violation of this chapter. [Amendment approved March 21, 1911.]

SECTION 3200. Any trade union, labor association, or labor organization, organized and existing in this state, whether incorporated or not, may adopt and use a trademark and affix the same to any goods made, produced, or manufactured by the members of such trade union, labor association, or labor organization, or to the box, cask, case, or package containing such goods, and may record such trademark by filing or causing to be filed with the Secretary of State its claim to the same, and a copy or description of such trademark, with the affidavit of the president of such trade union, labor association, or labor organization, certified to by any officer authorized to take acknowledgments of conveyances, setting forth that the trade union, labor association, or labor organization, of which he is the president, is the exclusive owner, or agent of the owner, of such trademark; and all the provisions of Article III, Chapter VII, Title VII, Part III, of the Political Code, are hereby made applicable to such trademark. [Approved March 17, 1889.]

SECTION 3201. The president or other presiding officer of any trade union, labor association, or labor organization, organized and existing in this state, which shall have complied with the provisions of the preceding section, is hereby authorized and empowered to commence and prosecute in his own name any action or proceedings he may deem necessary for the protection of any trademark adopted or in use under the provisions of the preceding section, or for the protection or enforcement of any rights or powers which may accrue to such trade union, labor association, or labor organization by the use or adoption of said trademark. [Approved March 17, 1889.]

CIVIL CODE.

SECTION 655. There may be ownership of all inanimate things which are capable of appropriation or of manual delivery; of all domestic animals, of all obligations, of such products of labor or skill as the composition of an author, the goodwill of a business, trademarks and signs, and of rights created or granted by statute. [Approved March 14, 1885.]

126 Cal. 119; 133 Cal. 71.

SECTION 991. One who produces or deals in a particular thing, or conducts a particular business, may appropriate to his exclusive use, as a trademark, any form, symbol, or name, which has not been so appropriated by another, to designate the origin or ownership thereof; but he can not exclusively appropriate any designation, or part of a designation, which relates only to the name, quality, or the description of the thing or business, or the place where the thing is produced, or the business is carried on. [In effect July 1, 1874.]

63 Cal 46; 100 Cal. 677; 103 Cal. 73.

SECTION 1772. One who sells or agrees to sell any article to which there is affixed or attached a trademark, thereby warrants that mark to be genuine and lawfully used.

PENAL CODE.

SECTION 350. Every person who wilfully reproduces, copies, imitates, forges, or counterfeits, or procures to be reproduced, copied, imitated, forged, or counterfeited, any trademark usually affixed by any person to his goods, which has been duly recorded in the office of the Secretary of State, or with the Commissioner of Patents in the United States Patent Office, or any label or brand, composed in whole or in part of a reproduction of said trademark, or who affixes the same to goods of essentially the same descriptive properties and qualities as those referred to in the registration of such trademark, with intent to pass off, or to assist other persons to pass off, any goods to which such reproduced, copied, imitated, forged, or counterfeited trademark, or label, or brand is affixed, or intended to be affixed, as the goods of the person, firm, company, or corporation owning the said trademark, is guilty of a misdemeanor. [Approved March 27, 1897.]

SECTION 351. Every person who sells, or keeps for sale, or manufactures or prepares, for the purpose of sale, any goods upon, or to which any reproduced, copied, imitated, forged, or counterfeited trademark, or label, or brand, composed in whole or in part of such a reproduced, copied, imitated, forged, or counterfeited trademark has been affixed, after such trademark has been recorded in the office of the Secretary of State, or with the Commissioner of Patents in the United States Patent Office, intending to represent such goods as the genuine goods of the person, firm, company, or corporation owning the said trademark, knowing the same to be reproduced, copied, imitated, forged, or counterfeited, is guilty of a misdemeanor. [Approved March 27, 1897.]

SECTION 352. The phrases "forged trademark" and "counterfeited trademark;" or their equivalents, as used in this chapter, include every alteration or imitation of any trademark so resembling the original as to be likely to deceive.

SECTION 353. The phrase "trademark," as used in the three preceding sections, includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper, usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman, to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him, other than any name, word, or expression generally denoting any goods to be of some particular class or description.

SECTION 354. Every person who has in his possession, or who uses any cask, bottle, vessel, case, cover, label, brand, or other thing bearing, or having in any way connected with it, the trademark of another, which has been duly recorded in the office of the Secretary of State, or with the Commissioner of Patents in the United States Patent Office, or the tradename of another, for the purpose of disposing of any article other than that which such cask, bottle, vessel, case, cover, label, brand, or other thing originally contained, or is connected with by the owner of such trademark or tradename, with intent to deceive or defraud, is guilty of a misdemeanor. [Approved March 27, 1897.]

SECTION 354½. Every person who wilfully sells, or traffics in any cask, keg, bottle, vessel, siphon, can, case, or other package bearing the duly filed trademark or name of another, printed, branded, stamped, engraved, etched, blown, or otherwise attached or produced thereon, or refills any such cask, keg, bottle, vessel, siphon, can, case, or other package with intent to defraud the owner thereof, without the consent of the owner thereof, or unless the same shall have been purchased from the owner thereof, is guilty of a misdemeanor. [Approved March 14, 1899.]

SECTION 354¾. Every person who shall wilfully deface, erase, obliterate, cover up, or otherwise remove, destroy, or conceal the duly filed trademark or name of another, printed, branded, stamped, engraved, etched, blown, impressed, or otherwise attached to, or produced upon any cask, keg, bottle, vessel, siphon, can, case, or other package, for the purpose of selling or trafficking in such cask, keg, bottle, vessel, siphon, can, case, or other package, or refilling such cask, keg, bottle, vessel, siphon, can, case, or other package, with intent to defraud the owner thereof, without the consent of the owner, or unless the same shall have been purchased from the owner, is guilty of a misdemeanor. [Approved March 3, 1899.]

AN ACT to protect the owners of bottles, boxes, siphons, and kegs used in the sale of soda waters, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, beer, white beer, or other beverages.

(Approved March 31, 1891; as amended, approved March 5, 1903.)

The people of the State of California, represented in Senate and Assembly, do enact as follows:

SECTION 1. Any and all persons engaged in manufacturing, bottling, or selling soda waters, mineral or aerated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer, or other beverages in bottles, siphons, or kegs, with his, her, its, or their name or names, or other marks or devices, branded, stamped, engraved, etched, and blown, impressed, or otherwise produced upon such bottles, siphons, or kegs, or the boxes used by him, her, it, or them, may file in the office of the clerk of the county in which his, her, or their

principal place of business is situated, and also in the office of the Secretary of State, a description of the name or names, marks or devices, so used by him, her, it, or them, respectively, and cause such description to be printed once in each week for three weeks successively, in a newspaper published in the county in which said notice may have been filed aforesaid.

SECTION 2. It is hereby declared to be unlawful for any person or persons, corporation or corporations, to fill with soda waters, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, beer, lager beer, weiss beer, white beer, or other beverages, or with medicine, compounds, or mixtures, any bottle, box, siphon, or keg, so marked or distinguished as aforesaid, with or by any name, mark, or device of which a description shall have been filed and published, as provided in section one of this act, or deface, erase, obliterate, cover up, or otherwise remove or conceal any such name, mark, or device thereon, or to sell, buy, give, take, or otherwise dispose of or traffic in the same, without the written consent of, or unless the same shall have been purchased from, the person or persons, corporation or corporations, whose mark or device shall be or shall have been in or upon the bottle, box, siphon, or keg so filled, trafficked in, used, or handled as aforesaid. Any person or persons or corporation offending against the provisions of this section shall be deemed guilty of a misdemeanor, and shall be punished for the first offense by imprisonment not less than ten days nor more than six months, or by fine of fifty cents for each and every such bottle, box, siphon, or keg so filled, sold, used, disposed of, bought, or trafficked in, or by both such fine and imprisonment; and for each subsequent offense by imprisonment not less than twenty days nor more than one year, or by a fine of not less than one dollar nor more than five dollars, for each and every bottle, siphon, and keg so filled, sold, used, disposed of, bought, or trafficked in, or by both such fine and imprisonment, in the discretion of the magistrate before whom the offense shall be tried.

SECTION 3. The use by any person other than the person or persons, corporation or corporations, whose device, name, or mark shall be or shall have been upon the same, without such written

consent or purchase, as aforesaid, of any such mark or distinguished bottle, box, siphon, or keg, a description of the name, mark, or device whereon shall have been filed and published, as herein provided, for the sale therein of soda waters, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer, or other beverages, or any article of merchandise, medicines, compounds, or preparations, or for the furnishing of such or similar beverages to customers, or the buying, selling, using, disposing of, or trafficking in of any such bottles, boxes, siphons, or kegs, by any person other than said persons or corporations, having a name, mark, or device thereon, or such owner, without such written consent, or the having by any junk-dealer, or dealer in secondhand articles, possession of any such bottles, boxes, siphons, or kegs, a description of the marks, names, or devices wherein shall have been so filed and published as aforesaid, without such written consent, shall and is hereby declared to be presumptive evidence of the said unlawful use, purchase, or traffic in of such bottles, boxes, siphons, or kegs.

SECTION 4. Whenever any person, or persons, or corporations, mentioned in section one of this act, or his, her, its, or their agent, shall make oath before any magistrate that he, she, or it has reason to believe, and does believe, that any of his, her, or their bottles, boxes, siphons, or kegs, a description of the names, marks, or devices whereon has been so filed and published, as aforesaid, are being unlawfully used or filled, or had by any person or corporation manufacturing or selling soda, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer, and other beverages, or that any junk-dealer, or dealer in secondhand articles, vendor of bottles, or any other person or corporation, has any such bottles, boxes, siphons, or kegs, in his, her, or its possession or secreted in any place, the said magistrate must thereupon issue a search warrant to discover and obtain the same, and may also cause to be brought before him the person in whose possession such bottles, boxes, siphons, or kegs may be found, and then inquire into the circumstances of such possession; and if said magistrate finds that such person has been guilty of a violation of section two of this act, he must

impose the punishment therein prescribed, and he shall also award possession of the property taken upon such search warrant to the owner thereof.

SECTION 5. The requiring, taking or accepting of any deposit for any purpose, upon any bottle, box, siphon, or keg shall not be deemed or constitute a sale of such property, either optional or otherwise, in any proceeding under this act. [Amendment approved March 5, 1903.]

SECTION 6. Any person or persons, corporation or corporations, that has or have heretofore filed in the offices mentioned in section one of this act, a description of the name or names, marks, or devices, upon his, her, their, or its property therein mentioned, and has caused the same to be published according to the laws existing at the time of such filing and publication shall not be required to again file and publish such description to be entitled to the benefits of this act; and any person or persons, corporation or corporations, having complied with the provisions of this act may as a part of the sale, assignment or transfer of all his, her, their or its said bottles, boxes, siphons, or kegs, used as aforesaid, with his, her, their or its name or names or other marks or devices, branded, stamped, engraved, etched, and blown, impressed or otherwise produce upon such bottles, boxes, siphons and kegs, to any other person or persons, corporation or corporations, engaged in manufacturing, bottling, or selling soda waters, mineral or aerated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer or other beverages, sell, assign, and transfer the sole and exclusive right of using said name or names, marks and devices in said business. And in the event of such sale, transfer or assignment as aforesaid, or in the event of the transfer by operation of law or by sale under order of any court of the entire business of such person or persons, corporation or corporations, or of the entire stock of bottles, boxes, siphons or kegs belonging to them, him, her or it, to any person or persons, corporation or corporations, engaged in manufacturing, bottling or selling soda waters, mineral or aerated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer or other beverages, such

person or persons, corporation or corporations, shall not be again required to file and publish a description of said name or names, marks or devices, hereunder, but shall be entitled to all the benefits of this act immediately upon acquiring such bottles, siphons or kegs or such business as aforesaid. [Amendment approved March 5, 1903.]

SECTION 7. All acts and parts of acts inconsistent herewith are for the purpose of this act hereby repealed. [Re-numbered; approved March 5, 1903.]

CASES DECIDED BY THE SUPREME COURT OF CALIFORNIA RELATIVE TO USE, PROTECTION, ETC., OF TRADEMARKS.

Definition and object of trademarks.—Burke v. Cassin, 45 Cal. 467; *Eggers v. Hink*, 63 Cal. 445.

Recording trademark with secretary of state.—Whittier v. Dietz, 66 Cal. 78; *Spieker v. Lash*, 102 Cal. 52.

Common law applicable as to right to.—Derringer v. Plate, 29 Cal. 292; *Falkinburg v. Lucy*, 35 Cal. 52.

Territorial limits of trademark.—Derringer v. Plate, 29 Cal. 292.

What constitutes trademark.—Right to use what as.—Woodward v. Lazar, 21 Cal. 448; *Falkinburg v. Lucy*, 35 Cal. 52; *Choynski v. Cohen*, 39 Cal. 501; *Burke v. Cassin*, 45 Cal. 467; *Eggers v. Hink*, 63 Cal. 445; *Schmidt v. Brieg*, 100 Cal. 674; *Spieker v. Lash*, 102 Cal. 38; *Weinstock, Lubin & Co. v. Marks*, 109 Cal. 529; *Castle v. Siegfried*, 103 Cal. 71; *Nolan Bros. Shoe Co. v. W. H. Nolan*, 131 Cal. 271.

Infringements of trademark.—Woodward v. Lazar, 21 Cal. 448; *Derringer v. Plate*, 29 Cal. 292; *Falkinburg v. Lucy*, 35 Cal. 52; *Graham v. Plate*, 40 Cal. 593; *Burke v. Cassin*, 45 Cal. 467; *Pierce v. Guittard*, 68 Cal. 68; *Sperry v. Percival Milling Co.*, 81 Cal. 252; *Schmidt v. Brieg*, 100 Cal. 672; *Spieker v. Lash*, 102 Cal. 38; *Castle v. Siegfried*, 103 Cal. 71; *Weinstock, Lubin & Co. v. Marks*, 109 Cal. 529; *Nolan Bros. Shoe Co. v. W. H. Nolan*, 131 Cal. 271.

The Secretary of State has prescribed the following form for applications for registration:

State of California,
County of ———.

———, being duly sworn, deposes and says that he is ——— located and doing business in the ———, State of California. That the said

———— is the exclusive owner of the trademark described in the specification accompanying this affidavit, and he petitions that the said trademark may be filed in the office of the Secretary of State of the State of California, in accordance with the law in such cases made and provided.

———— ————.

Subscribed and sworn to before me, this ——— day of ———, 19—.

———— ————.

Notary Public in and for the said ———, State of California.

SPECIFICATION.

To all whom it may concern:

Be it known that ——— of ———, State of California, being engaged in the business of ———, ——— adopted for ——— use a trademark, of which the following is a description:

This trademark consists ———.

It has generally been arranged as shown in the accompanying *facsimile*, ———.

(Space for attaching label.)

This trademark has been used in its business since the ——— day of ———, ———.

The class of merchandise and the particular goods upon which the trademark is used is ———.

It has been the custom to imprint it upon ———.

———— ————.

Witnesses:

———— ————.

———— ————.

COLORADO.

AN ACT to confer exclusive rights to the use of labels, trademarks, terms, designs, devices or forms of advertisement and provide for the recording of the same, to provide a remedy for the violation of such right, and the penalty for the unlawful use of labels, trademarks, terms, designs, devices and forms of advertising, and to repeal all acts and parts of acts inconsistent herewith.

Be it enacted by the General Assembly of the State of Colorado:

SECTION 1. Whenever any person, or any association or union of workingmen, has heretofore adopted or used, or shall hereafter adopt or use, any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured,

produced, prepared, packed or put on sale by such person or association or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device or form of advertisement, or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

SECTION 2. Whoever counterfeits or imitates any such labels, trademark, term, design, device or form of advertisement; or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other products of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed shall be punished by a fine of not more than five hundred dollars ($500), or by imprisonment for not more than three months, or by both such fine and imprisonment.

SECTION 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement as provided in sec. 1 of this act, may file the same for record in the office of the Secretary of State by leaving two copies, counterparts or *fac-similes* thereof, with said secretary and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed; the class of merchandise and description of the goods to which it has been or is intended to be appropriated

stating that the party so filing or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right of such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive and that the *fac-simile* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said Secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said Secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said Secretary of State shall not record for any person, union or association any label, trademark, term, design, device or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association. But the said Secretary shall file and record under this act any label, trademark, term, design, device or form of advertisement, which may have been previously filed by any person, or any association or union of workingmen, provided the person, association or union seeking to file and record under this act is the same person, association or union that previously filed or recorded the same label, trademark, term, design, device or form of advertisement.

SECTION 4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trademark, term, design, or form of advertisement in the office of the Secretary of State under the provisions of this act, by making any false or fraudulent representations, or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be

punished by a fine not exceeding five hundred dollars ($500) or by imprisonment not exceeding three months, or by both such fine and imprisonment.

SECTION 5. Every such person, association or union adopting or using a label, trademark, term, design, device or form of advertisement as aforesaid, may proceed by suit for damages to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and all courts of competent jurisdiction shall grant injunction to restrain such manufacture, use, display or sale and award the complainant in any such suit damages resulting from such manufacture, use, sale or display as may be by the said court deemed just and reasonable, and shall require the defendant to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant to be destroyed.

SECTION 6. Every person who shall use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than five hundred dollars ($500).

In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

SECTION 7. Any person or persons who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than five hundred dollars ($500).

SECTION 8. In case the plaintiff is successful in maintaining his action either for damages or for permanent relief by injunction, or for nominal damages only, he shall be entitled to recover a reasonable attorney's fee, to be taxed by the court as a part of the costs, and merged in the judgment.

SECTION 9. All acts and parts of acts inconsistent herewith are hereby repealed; *provided*, that this act shall not be construed as impairing any rights heretofore accrued, nor as affecting the remedies therefor heretofore existing.

Approved, April 10, 1899.

FORM FOR APPLICATION FOR REGISTRATION.

———, 19—.

To the Honorable the Secretary of State of the State of Colorado:

I, ———, being desirous of availing myself of the provisions of an act of the Legislature of the State of Colorado, in relation to trademarks and labels, approved April 10, 1899, have adopted a certain trademark for the purpose of designating and distinguishing a certain article in manner and form as follows, viz: ———

That the said ——— has the right to use the same and that no other person, firm, association, union or corporation has the right to use the same, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac-similes* or counterparts filed herewith are true and correct.

——— ———.

State of ———,
——— ———, ss:

On this ——— day of ———, A. D. 19—, before me personally appeared the above named ———, to me personally known, and made oath that the foregoing statement by him subscribed is true and correct.

My commission expires ———.

——— ———,
Notary Public.

The Secretary of State of Colorado gives the following:

NOTICE—In making your application for Trademark, it is important that you furnish this office with two counterparts or *fac-similes* of Label or Trademark desired. Should certified copies of this filing be desired, it will be necessary for you to forward as many additional counterparts or *fac-similes* of Label or Trademark as copies required.

CONNECTICUT.

General Statutes, Revision of 1902.

SECTION 4899. RECORD OF CERTIFICATE. Every person entitled to the exclusive use of any trademark, or who intends to adopt and use any trademark not previously adopted or used by another, may file for record in the office of the Secretary of State a certificate setting forth: his name, residence and place of business; the class of merchandise, and the particular description of goods comprised in such class, to which such trademark has been or is to be appropriated; a description of such trademark, and of the mode in which it is to be applied and used; the date when such trademark was first used or adopted; that he has a right to the use of it; and that no other person has the right to such use, either in the identical form, or having such near resemblance thereto as might be calculated to deceive. A *fac-simile* of such trademark shall be incorporated in or annexed to such certificate, and a duplicate shall be filed therewith, to be pasted or bound into the record-book, if practicable. Such certificate shall be signed by the person in which behalf it is filed, or by his agent, and the person so signing it shall make oath or affirm that all the statements therein contained are true to the best of his knowledge and belief.

SECTION 4900. LIABILITY FOR FALSE SWEARING. Every person who shall wilfully swear or affirm falsely, in any such affirmation or affidavit, as to any matter therein required to be set forth, shall be guilty of perjury, and shall pay treble damages to every party injured thereby.

SECTION 4901. MANDAMUS TO COMPEL RECORD. If the Secretary of State has reason to apprehend, on the filing of any such certificate, that the statements therein contained, or any of them, are untrue, he may decline to record the same, unless the party filing it shall obtain a writ of mandamus to compel such recording. Such writ may be granted, but without costs to the Secretary, by any proper court, on due proof that all the statements in such certificate are true, but no final hearing on the application therefor shall be had until such notice thereof as said court may order has been advertised in one or more newspapers published in the county where the party filing such

certificate resides. Any persons who desire may appear and intervene as defendants and oppose the granting of such writ, and shall be liable to judgment for any costs occasioned by such intervention.

SECTION 4902. EFFECT OF RECORDING. Every person having the right to make and file such a certificate and affidavit, upon the recording of the same in said office, shall be entitled to the exclusive use of the trademark therein described for so long as he or his assigns shall continue to be engaged in the manufacture or sale of the merchandise or description of goods to which it is appropriated; and such right shall be assignable in writing, but all assignments thereof shall be good only against the assignor and his personal representatives until lodged for record in said office.

SECTION 4903. COPIES PRIMA FACIE EVIDENCE. The Secretary shall retain all such certificates on file, and cause the same and all assignments of trademark rights to be recorded at length in his office. Copies of the record of any such certificate attested by him under the seal of the state, shall be *prima facie* evidence of the right of the party filing such certificate to the exclusive use of the trademark therein described for the periods limited in sec. 4902.

SECTION 4904. COUNTERFEIT OR IMITATION. Every person who shall reproduce, copy, counterfeit, or imitate any such recorded trademark, knowing the same to have been recorded, and affix such reproduction, copy, counterfeit, or imitation to goods resembling or designed to resemble those to which such trademark is so appropriated, shall pay to the owner of such trademark double damages, and also such sum, not more than five hundred dollars, as the court before which the action is brought may order to be added to the damages found by the verdict or judgment.

SECTION 4905. EXISTING RIGHTS NOT AFFECTED. The provisions of this chapter shall not abridge any rights to any trademarks existing on the twenty-second day of April, 1880, whether the same shall be recorded or not, nor any remedies or rights of action otherwise or theretofore existing in favor of owners of trademarks.

SECTION 4906. USE WITH INTENT TO DECEIVE. Every person who fraudulently and with intent to deceive, affixes any trademark recorded under this chapter, or any such imitation thereof as is calculated to deceive, to any goods, receptacle, or package similar in descriptive properties to those to which such trademark is appropriated; or who fraudulently and with intent to deceive places in any receptacle or package to which is lawfully affixed a recorded trademark, goods other than those which said trademark is designed and appropriated to protect; or who fraudulently and with intent to deceive, deals in or keeps for sale any goods with a trademark fraudulently affixed as above described in this section, or any goods contained in any package or receptacle having a lawful trademark, which are not such goods as such trademark was designed and appropriated to protect, shall be fined not more than five hundred dollars, or imprisoned not more than thirty days, or both.

DEVICES ON BOTTLES, CANS, JARS, SIPHONS, TOWELS, COATS, APRONS, AND TOILET CABINETS.

(As amended by Chapter 208, Public Acts of 1911.)

SECTION 1. DESCRIPTION MAY BE FILED. Sec. 4913 of the general statutes as amended by ch. 115 of the public acts of 1903 is hereby amended to read as follows: Any person engaged in manufacturing, bottling, or selling soda waters, mineral or aerated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer, or other beverages, or medicines, medical preparations, perfumery, oils, compounds, or mixtures in bottles, cans, jars, or siphons, with his name or other marks or devices branded, stamped, engraved, etched, blown, impressed, or otherwise produced upon such bottles, cans, jars, siphons or the boxes used by him, or any person engaged in the business of supplying towels, coats, aprons, or toilet cabinets to others, for hire or compensation, with his name or other marks or devices branded, stamped, marked, sewed, or otherwise impressed thereon, may file in the office of the clerk of the superior court of the county in which his principal place of business is situated, or if such place of business shall be situated out of the state, then in any county in the state, and also in the office of the Secretary of State, a description of the name or names, marks, or devices so used by him, and may

cause such description to be printed once in each week, for three weeks successively, in a newspaper published in the county in which such notice has been filed as aforesaid.

SECTION 2. UNLAWFUL USE OF DEVICES; PENALTY. Sec. 4914 of the general statutes as amended by ch. 115 of the Public Acts of 1903 is hereby amended to read as follows: No person, other than the owner of such name, mark, or device, shall fill with soda water, mineral or aerated water, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer, or other beverage, or with any medicine, medical preparation, perfumery, oil, compound or mixture, any bottle, can, jar, box, or siphon, or shall use any towel, coat, or apron, or toilet cabinet, by supplying, furnishing, or renting the same to others for hire or compensation, which is so marked or distinguished, as aforesaid, with or by any name, mark, or device, a description of which shall have been filed and published as provided in sec. 4913 and amendments thereof, or shall deface, erase, obliterate, cover up, or otherwise remove or conceal any such name, mark, or device thereon, or shall sell, buy, give, take, or otherwise dispose of or traffic in the same, without the written consent of the person whose mark or device shall be or shall have been in or upon the bottle, can, jar, box, or siphon so filled, trafficked in, used, or handled as aforesaid, or whose name, mark, or device shall be or shall have been upon the towel, coat, apron, or toilet cabinet so unlawfully used, except that the use of such towels, coats, aprons, and toilet cabinets, at the places where the same are supplied or delivered by the owner, under an agreement with or lease or license from such owner, shall not be unlawful. Every person, acting for himself or as the agent of any person, firm, or corporation, who shall violate any provision of this section shall, for the first offense be fined not more than fifty cents for each such bottle, can, jar, box, siphon, towel, coat, apron, or toilet cabinet so filled, sold, used, supplied, disposed of, bought, or trafficked in, or imprisoned not more than thirty days, or both; and for each subsequent offense shall be fined not more than one dollar for each such bottle, can, jar, box, siphon, towel, coat, or apron, or toilet cabinet so filled, sold, used, supplied, disposed of, bought, or trafficked in, or imprisoned not more than one year or both.

SECTION 3. PRESUMPTION OF UNLAWFUL USE. Sec. 4915 of the general statutes, as amended by chapter 115 of the Public Acts of 1903, is hereby amended to read as follows: The use by any person other than the person whose device, name, or mark shall be or shall have been upon the same, without such written consent or purchase as aforesaid, of any such marked or distinguished bottle, can, jar, box, or siphon, a description of the name, mark, or device whereon shall have been filed and published as provided in sec. 4913 and amendments thereof for the sale therein of soda waters, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer, or other beverage, or any article or merchandise, medicine, medical preparation, perfumery, oil, compound, mixture, or preparation, or for the furnishing of such or similar beverages to customers, or the use, by any person other than the owner whose name, mark, or device shall have been upon the same and those exempt by the proviso of sec. 4914 as amended, of any such marked or distinguished towel, coat, or apron, or toilet cabinet, a description of the name, mark, or device whereon shall have been filed and published as provided in said sec. 4913 as amended, or the buying, selling, or disposing of, or trafficking in any such bottles, cans, jars, boxes, siphons, towels, coats, aprons, or toilet cabinets by any person other than the person having a name, mark, or device as such owner thereon without such written consent, or the possession by any junk dealer, or dealer in rags or second-hand articles, or person engaged in the business of supplying or renting towels, aprons, coats, or toilet cabinets, of any such bottles, cans, jars, boxes, or siphons, whether whole or broken, or any such marked or distinguished towel, coat, or apron, or toilet cabinet, a description of the marks, names, or devices whereon shall have been so filed and published as aforesaid, without such written consent, shall be presumptive evidence of such unlawful uses, purchase, and traffic in such bottles, cans, jars, boxes, siphons, towels, coats, aprons or toilet cabinets.

SECTION 4. ISSUANCE OF SEARCH WARRANTS. Sec. 4916 of the general statutes, as amended by chapter 115 of the Public Acts of 1903 and chapter 48 of the Public Acts of 1905, is hereby amended to read as follows: Whenever any person mentioned

in sec. 4913 and amendments thereof, or his agent, shall make oath before any justice of the peace or the judge of any city, borough, town, or police court within the town, that he has reason to believe and does believe that any of his bottles, cans, jars, boxes or siphons, a description of the names, marks, or devices whereon has been so filed and published as aforesaid, are being unlawfully used or filled or had within the jurisdiction of such justice of the peace, or such court, by any person manufacturing or selling soda, mineral or aerated waters, porter, ale, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, or other beverage, or medical preparations, perfumery, oils, compounds, or mixtures, or that any junk dealer or dealer in second-hand articles, vendor of bottles, cans, jars, or siphons, or other person has, within such jurisdiction, any such bottles, cans, jars, boxes, or siphons in his possession or secreted in any place, or that any of his towels, coats, aprons, or toilet cabinets a description of the names, marks or devices whereon has been filed and published as aforesaid, are being unlawfully used or held within the jurisdiction of such justice of the peace or such court, said justice of the peace or court shall, if sufficient reason be shown therefor, issue forthwith a search warrant, directed to any police officer or other proper officer, to discover and obtain the same; and said justice of the peace or court shall issue a warrant for and cause to be brought before him the person in whose possession such bottles, cans, jars, boxes, siphons, towels, coats, aprons or toilet cabinets, may be found and shall inquire into the circumstances of such possession; and if such justice of the peace or court shall find that such person has been guilty of a violation of sec. 4914 as amended he shall award the property taken upon such warrant to the owner thereof, together with his costs for such search warrant and officer's fees thereon.

Section 5. Deposits for security. Sec. 4917 of the general statutes, as amended by Ch. 115 of the Public Acts of 1903, is hereby amended to read as follows: The requiring, taking, or accepting of any sum of money as a deposit for security for the safekeeping and return of any bottle, can, jar, box, siphon, towel, coat, or apron, or toilet cabinet shall not constitute a sale of such property, either optional or otherwise, in any proceeding under secs. 4913, 4914, 4915, or 4916 as amended.

(Approved, August 24, 1911.)

SECTION 4918. REFILING OF DEVICE NOT REQUIRED. Any person, firm, or corporation that has filed in the office mentioned in sec. 4913 a description of the name or names, mark, or devices upon his or its property, therein mentioned, and has caused the same to be published according to the law existing at the time of such filing and publication, shall, if no sale of any article of such property so marked has been made by such owner, not be required again to file and publish such description to be entitled to the benefits of secs. 4913, 4914, 4915 and 4916.

General Statutes, 1902.

FORM FOR APPLICATION FOR REGISTRATION.

Know all men by these presents:

That ———, residing in the town of ———, county of ———, and State of ———, and having ——— place of business in ——— and engaged in the ——— and sale of ———, ha— adopted the following trademark, to be applied by label, or by engraving, or stamping said trademark upon said goods or the packages containing them, or in advertising the same.

(Here insert trademark if possible, and send extra copies for record and certified copies, or accurately describe.)

And ——— further certify that said trademark was first used by ——— on or about the ——— day of ———, A. D. 19—, and that ——— have the exclusive right to the use of the same.

——— ———.

STATE OF ———, COUNTY OF ——— *ss:*

———, 19—.

Personally appeared, ———, and made oath to the truth of the foregoing certificate, before me,

——— ———,

Notary Public. Justice of the Peace.

DELAWARE.

Chapter 699, Volume 19, Laws of Delaware.

[Page 552, Code of 1893].

AN ACT to protect associations and unions of workingmen and persons in their labels, trademarks and forms of advertising.

Be it enacted by the Senate and House of Representatives of the State of Delaware in General Assembly met:

SECTION 1. Whenever any person, association or union of workingmen have adopted, or shall hereafter adopt for their

protection, any label, trademark, or form of advertisement announcing that goods to which such label, trademark, or form of advertisement shall be attached were manufactured by such person, or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trademark, or form of advertisement. Every person violating this section shall, upon conviction, be punished by imprisonment in the county jail for not less than three months nor more than one year, or by a fine of not less than fifty nor more than one hundred dollars ($100), or both.

SECTION 2. Every person who shall use any counterfeit or imitation of any label, trademark, or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for not less than three months nor more than one year, or by a fine of not less than fifty nor more [than] one hundred dollars ($100), or both.

SECTION 3. Every person, association or union, that has heretofore adopted, or shall hereafter adopt, a label, trademark, or form of advertisement as aforesaid, may file the same in the office of the Secretary of State, by leaving two copies, counterparts or *fac-similes* thereof with the Secretary of State; said Secretary shall deliver to such person, association or union so filing the same a duly attested certificate, for which he shall receive one dollar. Such certificate of filing shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark or form of advertisement, and of the right of such person, association or union to adopt the same. No label shall be received and filed by the Secretary of State that probably would [be] mistaken for a label already filed.

SECTION 4. Every such person, association or union adopting a label, trademark or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any such counterfeits or imitations, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display, or sale, and shall award the complainant in such suit such damages, resulting from such wrong-

ful manufacture, use, display or sale as may by said court be deemed just and reasonable, and shall require the defendants to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale; and said court shall also order that all such counterfeits or imitations in the possession, or under the control, of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

SECTION 5. Every person who shall use or display the genuine label, trademark, or form of advertisement of any such person, association or union in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than one year, or by fine of not less than fifty nor more than one hundred dollars, or both. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any member or officer of such association or union on behalf of and for the use of such association or union.

SECTION 6. Any person or persons who shall in any way use the name or seal or any such person, association, or union, or officer thereof, in and about the sale of goods, or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, punishable by imprisonment in the county jail of not less than three months nor more than one year, or by a fine of not less than fifty nor more than one hundred dollars, or both.

SECTION 7. The fines provided for in this act may be enforced before a justice of the peace in all cases where the party complainant shall so elect, and in case of conviction before such justice of the peace, the offender shall stand committed to the county jail until the fine and costs are fully paid.

SECTION 8. This shall be deemed and taken to be a public act.

Passed at Dover, March 29, 1893.

Delaware Rev. St., 1915, sec. 3594 (27 Del. Laws, c. 178), forbids use of milk bottles belonging to another; it is no defense that a particular bottle was left with defendant's customer in place of one of defendant's bottles; the offense must

be proved beyond a reasonable doubt. *State v. Boyd* (Del.), 95 Atl. Rep. 232.

Chapter 92, vol. 16, Laws of Delaware (Code 1893, p. 551), relates to the protection of manufacturers and vendors of mineral water, porter, ale, or other beverages against the unauthorized use of or injury to their bottles.

Chapter 226, p. 435, of the Laws of Delaware of 1898-1899, relates to the protection of any labor organization in the adoption and use of a label or seal.

FORM OF APPLICATION FOR REGISTRATION, DELAWARE.

To all whom it may concern:

Be it known, that ——— a corporation organized under the laws of the State of ———, and located and doing business in ———, county of ———, and State of ———, has adopted for its use as trademark for ———, of which the following is a description:

This trademark consists of ———.

The following is a copy, *fac-simile* or counterpart of the said trademark, to-wit: ———

The class and particular description of goods to which the said trademark has been and is intended to be appropriated is ———.

The said trademark has been continuously used in the business of said corporation since about the ——— day of ———.

The said trademark is usually applied by means of labels or by stamping or printing it upon the packages containing the goods.

——— ———,
——— ———.

State of ———,
County of ———, ss:

———, being duly sworn, says that he is ———, of the corporation, ——— the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said corporation at this time has the right to the use of the trademark therein prescribed; that no other person, firm, association or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive; and that the description and copy, *fac-simile* or counterpart filed therewith truly represent the trademark sought to be registered.

——— ———.

Subscribed and sworn to before me this ——— day of ———, A. D. 19—.

——— ———,

[Seal.] *Notary Public.*

FLORIDA.

Chapter 4974—(No. 90).

AN ACT to authorize any person, association or union of workingmen to adopt and use a label or trademark, to protect the same by law, to provide for its record, to prevent counterfeiting the same, or using the original or any package containing the same; and to prevent using the name or seal thereof without authority, and fixing penalties for violations thereof.

Be it enacted by the Legislature of the State of Florida:

SECTION 1. Whenever any person or any association or union of workingmen has heretofore adopted or used, or shall hereafter adopt or use, and has filed as hereinafter provided, any label, trademark, term, wording, design, device, color or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen, or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, wording, design, device, color or form of advertisements, or knowingly to use, sell, offer for sale, or in any other way utter or circulate any counterfeit, or imitation of any such label, trademark, term, wording, design, device, color or form of advertisement.

SECTION 2. Whoever counterfeits or imitates any such label, trademark, term, wording, design, device, color or form of advertisement, or knowingly sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, wording, design, device, color or form of advertisement; or knowingly purchases and keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly purchases with intent to sell or dispose of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or having knowingly

purchased, keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than five hundred dollars, or by imprisonment for not more than three months.

SECTION 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, wording, design, device, color or form of advertisement as provided in section 1 of this act, may file the same for record in the office of Secretary of State by leaving two copies, counterparts or fac-similes thereof, with said Secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, wording, design, device, color or form of advertisement shall be filed, the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing or on whose behalf such label, trademark, term, wording, design, device, color or form of advertisement shall be filed, has the right to the use of the same, that no other person, firm, association, union or corporation has the right to use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile or counterparts filed therewith are true and correct.

There shall be paid for such filing and recording a fee of two dollars. Said Secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, wording, design, device, color or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which the Secretary shall receive a fee of one dollar. Any such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trademark, term, wording, design, device, color or form of advertisement. Said Secretary of State shall not record for any person, union or association any label, trademark, term, wording, design, device, color or form of advertisement that would prob-

ably be mistaken for any label, trademark, term, wording, design, device, color or form of advertisement heretofore filed by or on behalf of any other person, union or association.

SECTION 4. Any person who shall, for himself or on behalf of any other person, association or union procure the filing of any label, trademark, term, wording, design, device, color or form of advertisement in the office of the Secretary of State, under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction, and shall be punished by a fine not exceeding five hundred dollars, or by imprisonment not exceeding three months.

SECTION 5. Every such person, association or union adopting or using a label, trademark, term, wording, design, device, color or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and may award the complainant in any such suit damages resulting from any such manufacture, use, sale or display, as may be by the said court deemed just and reasonable, and shall require the defendants to pay such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainants, to be destroyed.

SECTION 6. Every person who shall use or display the genuine label, trademark, term, wording, design, device, color or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by a fine of not more than five hundred dollars.

In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted

by an officer or member of such association or union on behalf of and for the use of such association or union.

SECTION 7. Any person or persons who shall, in any way, use the name or seal of any such person, association or union or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

SECTION 8. Any person using the trademark so adopted and filed by any other person, or any imitation of such trademark, or any counterfeit thereof; or who shall in any manner mutilate, deface, destroy or remove such trademark from any goods, wares, merchandise, article or articles, or from any package or packages containing the same, or from any empty or second-hand packages, which has contained the same or been used therefor, with the intention of using such empty or second-hand package, or of the same being used to contain goods, wares, merchandise, article or articles of the same general character as those for which they were first used; and any person who shall use any such empty or second-hand package for the purpose aforesaid, without the consent in writing of the person whose trademark was first applied thereto or placed thereon, shall, upon conviction thereof, be fined in any sum not less than five hundred dollars, or by imprisonment for not more than three months, and the goods, wares, merchandise, article or articles contained in any such second-hand package or packages shall be forfeited to the original user of such package or packages whose trademark was first applied thereto or placed thereon. The violation of any of the above provisions as to each particular articles or packages shall be held to be a separate offense.

SECTION 9. The word "person" in this act shall be construed to include a person, copartnership, corporation, association or union of workingmen.

SECTION 10. This act shall take effect immediately upon its passage and approval by the Governor.

Approved May 29, 1901.

GEORGIA.

Code 1895, and Supp., 1901.

SECTION 1736. Whenever any person, association or union of workingmen have adopted, or shall hereafter adopt for their protection, any label, trademark, or form of advertisement announcing that goods to which such label, trademark, and forms or advertisement shall be attached were manufactured by such person or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trademark, or form of advertisement with intent to use the same for the purpose of deceiving the public in the sale of the goods.

SECTION 1737. Every person who shall use any counterfeit or imitation of any label, trademark, or form of advertisement of any such person, union, or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor.

SECTION 1738. Every person, association, or union of workingmen that has adopted or shall hereafter adopt a label, trademark, or form of advertisement, may file the same for record in the office of the Secretary of State by leaving two copies, counterparts or fac similes thereof, with the Secretary of State. Said Secretary shall deliver to such person, association, or union, a duly attested certificate of the record of the same, for which he shall receive the fee of one dollar; such certificate of record shall, in all suits under this chapter, be sufficient proof of the adoption of such label, trademark, or form of advertisement, and of the right of said person, association, or union to adopt the same. No label shall be recorded that probably would be mistaken for a label already of record.

SECTION 1739. Every such person, association, or union adopting a label, trademark or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any such counterfeits or imitations, and all courts having jurisdiction thereof shall grant injunction to restrain such manufacture, use, display or sale, and shall award the complainant in such suits such damages resulting from such wrongful manufacture, use, display, or sale as may by said courts be deemed just and reasonable, and shall require the defendant to pay such

person, association, or union the profit derived from such wrongful manufacture, use, display, or sale, and such court shall also order that all counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

SECTION 1740. In all cases where such associations or unions are not incorporated, suits may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

SECTION 1741. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, knowing that such use is unauthorized, with the intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor.

SECTION 4035. Any attempt to encroach upon the business of a trader, or other person, by the use of similar trademarks, names or devices, with the intention of deceiving and misleading the public, is a fraud for which equity grants relief.

SECTION 6676. Whenever any person, firm, corporation or association shall adopt and use in their business, for their protection, any label, trademark, trade name or form of advertisement, it shall be unlawful for any person, firm, corporation or association to counterfeit or imitate such label, trademark, trade name or form of advertisement, with intent to use the same for the purpose of deceiving the public in the sale of goods. Every person violating this section shall be guilty of a misdemeanor and punished therefor.

SECTION 6677. Every person, firm, corporation or association who shall use any counterfeit or imitation of any label, trademark, trade name or form of advertisement of any person, firm, corporation or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor and punished therefor.

SECTION 6678. Every person, firm, corporation or association who shall use or display the genuine label, trademark, trade name or form of advertisement of any person, firm, corporation or

association, in any manner not authorized by law, such person, firm, corporation or association, knowing that such use is not authorized, with intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor and be punished therefor.

SECTION 6679. Any firm, person, corporation or association who shall use the name or seal of any other person, firm, corporation or association in and about the sale of goods or otherwise, not being authorized to use the same, knowing that such use is unauthorized, with intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor and punished therefor.

SECTION 6680. Any person, firm, corporation or association that shall be found guilty of violating the provisions of this act, or any of them as aforesaid, shall be punished as prescribed in section 1039 of the Penal Code.

UNION TRADEMARKS, ETC., PROTECTION OF.

No. 380.

AN ACT for the protection of union labels, trademarks and forms of advertisement, and providing penalties for counterfeiting the same.

SECTION 1. Whenever any person, association or union of workingmen have adopted, or shall hereafter adopt for their protection, any label, trademark or form of advertisement announcing that goods to which such label, trademark and form of advertisement shall be attached were manufactured by such person or by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trademark or form of advertisement with intent to use the same for the purpose of deceiving the public in the sale of the goods. Every person violating this section shall be punished upon conviction by a fine of not less than one hundred dollars nor more than two hundred dollars.

SECTION 2. Every person who shall use any counterfeit or imitation of any label, trademark or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor, and shall be punished by a fine of not less than one hundred dollars nor more than two hundred dollars.

SECTION 3. Every such person, association or union that has heretofore adopted or shall hereafter adopt a label, trademark or form of advertisement as aforesaid, may file the same for record in the office of the Secretary of State by leaving three copies counterpart or *fac-simile* thereof with the Secretary of State. Said Secretary shall deliver to such person, association or union so filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar; such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark or form of advertisement, and of the right of said person, association or union to adopt the same. No label shall be recorded that probably would be mistaken for a label already of record.

SECTION 4. Every such person, association or union adopting a label, trademark or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeits or imitations, and all courts having jurisdiction thereof shall grant injunction to restrain such manufacture, use, display or sale, and shall award the complainant in such suits such damages resulting from such wrongful manufacture, use, display or sale as may by said court be deemed just and reasonable, and shall require the defendant to pay to such person, association or union the profit derived from such wrongful manufacture, use, display or sale, and such court shall also order that all counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

Section 5 Every person who shall use or display the genuine label, trademark or form of advertisement of any such person, association or union, in any manner not authorized by such person, association or union, knowing that such use or display is not authorized, with intent to deceive the public in the sale of goods, shall be deemed guilty of a misdemeanor and shall be punished by a fine of not less than one hundred dollars nor more than two hundred dollars. In all cases where such associations or unions are not incorporated, suit under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

SECTION 6. *Be it further enacted*, That any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, knowing that such use is unauthorized, with the intent to deceive the public in the sale of goods, shall be guilty of a misdemeanor, punishable by a fine of not less than one hundred dollars nor more than two hundred dollars.

SECTION 7. *Be it further enacted by authority aforesaid*, That all laws and parts of laws in conflict with this act be, and the same are, hereby repealed.

Approved December 20th, 1893.

As to prosecutions under this act see *Comer v. State*, 103 Ga. 69, 29 S. E. Rep. 501; *Butler v. State*, ——Ga.——, 56 S. E. Rep. 1000.

IDAHO.

TO PROTECT LABELS AND TRADEMARKS.

SECTION 1. Whenever any person, or any association or union of workingmen, has heretofore adopted or used, or shall hereafter adopt or use any label, trade mark, term, design, device or form of advertisement, for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or other products of labor, as having been made, manufactured, produced, prepared, packed or put on sale, by such person, or association, or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade mark, term, design, device or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit, or imitation of any such label, trade mark, term, design, device or form of advertisement.

SECTION 2. Whoever counterfeits or imitates any such label, trademark, term, design, device or form of advertisement, or sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trade mark, term, design, device or form of advertisement; or keeps or has in his possession, with intent that the same shall be sold or disposed

of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which, any such counterfeit, or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be guilty of a misdemeanor and be punished by a fine of not more than one hundred dollars, or by imprisonment for not more than three months.

SECTION 3. Every such person, association, or union, that has heretofore adopted or used, or shall hereafter, adopt or use, a label, trade mark, term, design, device or form of advertisement, as provided in section 1 of this act, may file the same for record in the office of the Secretary of State, by leaving two copies, counterparts or *fac-similes* thereof, with said Secretary and by filing therewith, a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be, appropriated, stating that the party so filing or on whose behalf such label, trademark, design, device, or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation, has a right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac-simile* or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of three dollars. Said Secretary shall deliver to such person, association, or union, so filing or causing to be filed any such label, trade mark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said Secretary shall receive a fee of three dollars. Any such certifi-

cate of record shall, in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trade mark, term, design, device or form of advertisement. Said Secretary of State shall not record for any person, union, or association, any label, trademark, term, design, device or form of advertisement that would probably be mistaken for any label, trade mark, term, design, device, or form of advertisement theretofore filed by, or on behalf of any other person, union, or association.

SECTION 4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trade mark, term, design or form of advertisement in the office of the Secretary of State under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by, or on behalf of the party injured thereby, in any court having jurisdiction and shall be guilty of misdemeanor, and be punished by a fine not exceeding one hundred dollars, or by imprisonment not exceeding three months.

SECTION 5. Every such person, association or union adopting or using a label, trademark, term, design, device or form of advertisement as aforesaid may proceed by suit, to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture and may award the complainant in any such suit, damages resulting from such manufacture, use, sale or display, as may be by the said court, deemed just and reasonable, and shall require the defendants to pay to such persons, association, or union, all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant to be destroyed.

SECTION 6. Every person who shall use or display the genuine label, trade mark, term, design, device or form of advertisement of any such person, association or union, in any manner,

not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than one hundred dollars ($100.00). In all cases where such association or union is not incorporated, suits under this act may be commenced, and prosecuted by an officer or member of such association or union on behalf of, and for the use of such association or union.

SECTION 7. Any person or persons who shall in any way use the name or seal of any such person, association, or union or officer thereof in, and about the sale of goods or otherwise not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months or by a fine of not more than one hundred dollars. (Approved March 12, 1897. As amended March 12, 1907.)

ILLINOIS.

Starr & C. St. 1896, Vol. 3, Pages 3955-3957.

AN ACT to protect associations, unions of workingmen and persons in their labels, trademarks and forms of advertising.

PARAGRAPH 6, § 1. Whenever any person or any association or union of workingmen has heretofore adopted or used or shall hereafter adopt or use any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known or distinguishing any goods, wares, merchandise or other product of labor as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen, or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

PARAGRAPH 7, § 2. Whoever counterfeits or imitates any such label, trademark, term, design, device or form of advertisement, or sells, offers for sale or in any way utters, or circulates any counterfeit or imitation of any such label, trademark, term, de-

sign, device or form of advertisement, or knowingly uses any such counterfeit or imitation, or knowingly sells or disposes of or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which any such counterfeit or imitation is attached or affixed, or on which any such counterfeit or imitation is printed, painted, stamped or impressed, or knowingly sells, or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not less than one hundred (100) dollars, nor more than two hundred (200) dollars, or by imprisonment for not less than three (3) months nor more than one (1) year, or by both such fine and imprisonment.

PARAGRAPH 8, § 3. LABEL, TRADEMARK, ETC. TO BE FILED WITH SECRETARY OF STATE. Every such person, association, or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement as provided in section one (1) of this act, shall file the same for record in the office of the Secretary of State, by leaving two (2) copies, counterparts or fac-similes thereof with said Secretary, and by filing therewith a sworn statement specifying the name or names of the person, association or union on whose behalf such description of the goods to which it has been or is intended to be appropriated; that the party so filing, or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, has the right to use the same, and that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile copies or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one (1) dollar. Any person who shall for himself, or

on behalf of any other person, association or union, procure the filing of any label, trademark, term, design, device or form of advertisement in the office of the Secretary of State, under the provisions of this act by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding two hundred (200) dollars or by imprisonment not exceeding one year or both such fine and imprisonment. The Secretary of State shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said Secretary shall receive a fee of one (1) dollar. Any such certificates of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said Secretary of the State shall not record for any person, union or association any label, trademark, term, design, device or form of advertisement that would reasonably be mistaken for any label, trademark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association. (As amended by Act approved June 13, 1895. In force July 1, 1895, L. 1895, p. 320; Legal News Ed., p. 232.)

Paragraph 9, § 4. Every such person, association or union adopting a label, trademark, or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeits or imitations; and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant in such suit, such damages, resulting from such wrongful manufacture, use, display or sale, as may by said court be deemed just and reasonable, and shall require the defendants to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale; and said court shall also order that all such counterfeits or imitations in

the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant to be destroyed.

PARAGRAPH 10, § 5. Every person who shall use or display the genuine label, trademark, or form of advertisement of any such person, association or union, in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

PARAGRAPH 11, § 6. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, punishable by imprisonment in the county jail of not less than three months nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both.

SUPPLEMENT 1902 (VOL. 4, STARR & C. ST.)

PARAGRAPH 1, § 7. The fines provided for in this act may be enforced before a justice of the peace in all cases where the party complaining shall so elect, and in case of conviction before such justice of the peace, the offender shall stand committed to the county jail until the fine and costs are fully paid, under the provisions of section 8, article IX, of an act to revise the law in regard to criminal jurisprudence, in force July 1, 1874, or otherwise. The first process under this section in all prosecutions for the recovery only of the fines, shall be a summons: *provided*, however, that a warrant for the arrest of the offender, as in other cases when justices of the peace have original criminal jurisdiction, may issue upon the affidavit of any person that any of the provisions of this act have been violated, and that the person

making the complaint has just and reasonable grounds to believe the party charged is guilty thereof. (Section as amended by Act approved April 22, 1902.)

An Act of May 11, 1901, Hurd's Revised Stat., 1901, p. 1793, relating to the unlawful buying and selling of receptacles, and for the registration of marks in connection with such articles. This act has been held to be unconstitutional, as being beyond the police power of the state and in contravention of section 22, article IV of the Illinois Constitution of 1870, in *Horwich v. Walker-Gordon Laboratory Co.*, 205 Ill. 497, 68 N. E. Rep. 938. A similar statute passed in 1873 (Rev. Stat. 1874, p. 1084, Ch. 140) was held unconstitutional in *Lippman v. People*, 175 Ill. 101, 51 N. E. Rep. 872.

That union labels are properly within the protection of paragraph 6, sections 1 to 6, see *Cohn v. People*, 149 Ill. 486, 37 N. E. Rep. 60, and see *Vogt v. People*, 57 Ill. App. 684.

Section 2, Ch. 32, Rev. Stat. 1893, forbidding the incorporation of two companies under the same name, does not prevent the incorporation of separate concerns under the corporate names, "Elgin Creamery Company" and "Elgin Butter Company;" the word "Elgin" being geographical, and there being no proof of any intent, act or artifice to mislead the public as to the identity of the corporation. *Elgin Butter Co. v. Sands*, 155 Ill. 127, 40 N. E. Rep. 616.

That a warrant in aid of a suit for trademark infringement was improperly issued under the general search warrant act, see *White v. Wagar*, 185 Ill. 195; *White v. Wagar*, 83 Ill. App. 592.

APPLICATION FOR REGISTRATION OF TRADEMARK.

State of ———,
County of ———, ss:

The undersigned ——— being duly sworn on oath, says that ——— makes this statement in ——— behalf, in pursuance of Chapter 140 of "Hurd's" Revised Statutes of the State of Illinois.

That he files herewith two copies which are counterparts or facsimiles of a certain ——— which ——— has adopted and intends to appropriate for the purpose of designating, making known or distinguishing the following described goods, wares, merchandise or products of labor, to-wit: ———

That he has the right to use the said ——— and that no other person, firm or association has a right to use, either in the identical form

herein set forth or in any such near resemblance thereto as may be calculated to deceive. And that the fac-simile copies or counterparts filed herewith are true and correct.

The essential part of said ———.

Subscribed and sworn to before me by the said ——— this ——— day of ———, A. D. 19—.

[Seal.] ——— ———,
Notary Public.

Fee for filing is $1.00 and $1.00 additional for a certificate. Three facsimiles of the trademark should accompany the affidavit.

INDIANA.

Burns Annotated Indiana Statutes, Revision of 1901.

SECTION 8681. That any firm, person, corporation or voluntary association that are citizens of the state of Indiana, except foreign corporations, and who are entitled to the exclusive use of any lawful trademark, label, brand, stamp or wrapper, may obtain protection for such lawful trademark, label, brand, stamp or wrapper by complying with the following requirements: First, by causing to be filed with the Secretary of State a statement specifying the names of the parties, and the residences and places of business, who desire the protection of the trademark, label, brand, stamp or wrapper, the class of merchandise and the particular description of goods comprised in such class, by which the trademark, label, brand, stamp or wrapper has been, or is intended to be protected. A description of trademark, label, brand, stamp or wrapper, with *fac-simile* thereof, showing the mode in which it has been and is intended to be applied and used, and the length of time, if any, during which the trademark, label, brand, stamp or wrapper has been in use. Second, by making a payment of a fee of two dollars to the Secretary of State, whose duty it will be to file and record said statement in a book kept for the purpose to be procured by him as other books in his office of like nature are procured.

SECTION 8682. Any certificate or statement prescribed in the preceding section must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration verified by the person, or some member of the firm or

officer of the corporation or voluntary association by whom it is filed, to the effect that the party claiming the protection for the trademark, label, brand, stamp or wrapper, has a right to the same, and that no other person, firm, corporation or voluntary association has the right to such use either in the identical form or in any such near resemblance as might be calculated to deceive; and that the description and *fac-simile* presented for record are true copies of the trademark, label, brand, stamp or wrapper sought to be protected.

SECTION 8683. The time of the receipt of any trademarks, label, brand, stamp or wrapper at the office of the Secretary of State for registration shall be noted and recorded. Certified copies of the trademark, label, brand, stamp or wrapper, and the date of the receipt thereof, and of the statement and affidavit filed therewith shall be *prima facie* evidence of the facts and statements and affidavit record in any suit in which such trademark, label, brand, stamp or wrapper shall be brought into controversy.

SECTION 8684. A trademark, label, brand, stamp or wrapper shall remain in force so long as it is used continuously; after a disuse of six months it shall be deemed out of existence. Such trademark, label, brand, stamp or wrapper may be sold or assigned, or pass to personal representatives by will, or become assets of an estate. In any case where ownership changes of such trademark, label, brand, stamp or wrapper, before it can be used by the successor in title, a statement of such change of ownership shall be filed with the Secretary of State, and he shall record the same in the book kept for the purpose of recording trademarks, labels, brands, stamps and wrappers, and such Secretary shall receive two dollars for recording such statement; and it shall be unlawful to use such trademark, label, brand, stamp or wrapper till such change of ownership has been filed as aforesaid.

SECTION 8685. Such trademark, label, brand, stamp or wrapper shall entitle the person, firm, corporation, or voluntary association registering the same to the exclusive use thereof, so far as regards the description of goods to which it is appropriated in the statement filed under oath as aforesaid, and no other

person, firm, corporation or voluntary association can lawfully use the same trademark, label, brand, stamp or wrapper, or substantially the same, or so nearly resembling it as to be calculated to deceive upon substantially the same description of goods.

SECTION 8686. For a violation of any rights created by this act, the person, firm, corporation or voluntary association aggrieved, shall have all common law remedies and actions for damages, and shall be entitled to an injunction to prevent further use of any trademark, label, brand, stamp or wrapper by this act secured to the injured person, firm, corporation, or voluntary association; and, if an injunction is made final and perpetual, the injured firm, corporation or voluntary association shall recover reasonable attorney's fees.

SECTION 8687. Any owner of a trademark, label, brand, stamp or wrapper, who has complied with the provisions of this act, shall have the right to grant to others the authority to use such trademark, label, brand, stamp or wrapper; but such authority to so use must be in writing, signed by the owner of such trademark, label, brand, stamp or wrapper, with two witnesses to such signature, and no one but the owner shall have the right to use such trademark, label, brand, stamp or wrapper, unless such written authority has been given.

SECTION 8688. If it becomes necessary for any voluntary association to assert any right to any trademark, label, brand, stamp or wrapper, it shall be sufficient to use the name of president or chief officer of such association either in action at law, suit in equity, or indictment for the violation of the provisions of this act.

SECTION 8689. This act shall not be construed to lessen, impair or abridge any rights or remedies that have heretofore existed in favor of any one owning or rightfully claiming a trademark, label, brand, stamp or wrapper.

SECTION 8690. That any person or persons, who shall knowingly or wilfully cast or engrave, or manufacture, or have in his, her or their possession, or buy, sell or offer for sale, or deal in any die or dies, plate or plates, brand or brands, engraving or engravings on wood, stone, metal or other substances, molds or any false representations, likeness, copy or colorable imita-

tion of any die, plate, brand or mold of any private trademark, label, brand, stamp, wrapper, engraving on paper or other substance, registered and recorded pursuant to this act, shall, upon conviction thereof, be punished by imprisonment in the penitentiary for not less than one year, or more than two years, or be fined in a sum not less than one thousand dollars, or more than two thousand dollars.

SECTION 8691. That any person or persons (who shall) knowingly and wilfully make, forge or counterfeit, or have in his, her or their possession, or buy, sell, offer for sale or deal in any representation, likeness, similitude, copy or colorable imitation of any private label, brand, stamp, wrapper, engraving, mold or trademark, registered and recorded pursuant to this act, shall, upon conviction thereof, be punished by imprisonment in the penitentiary for a period of years not more than two nor less than one, or be fined in any sum not less than one thousand dollars nor more than two thousand dollars.

SECTION 8692. It shall be unlawful for any person, firm, corporation or voluntary association doing business in this state to have in his or its possession, or to sell, or offer for sale or trade, any goods, wares, merchandise or other article upon which he or it knows is placed or affixed a false, forged or spurious trademark, label, brand, stamp, or wrapper in likeness or imitation of some trademark, label, brand, stamp, or wrapper registered as provided for in this act; and any such person, firm, corporation or voluntary association so having in his or its possession or selling, or offering for sale or trade, any goods, wares or merchandise upon which he or it knows is placed or affixed a false, forged or spurious trademark, label, brand, stamp or wrapper in likeness or imitation of some trademark, label, brand, stamp or wrapper registered as aforesaid shall, upon conviction thereof, be punished by fine in a sum of not less than fifty dollars ($50.00) nor more than two hundred dollars ($200.00), or imprisoned in the county jail six months, or both.

Sections 8678-8680c relate to the protection of manufacturers, bottlers, and sellers of mineral waters, cider, ale, beer, ginger pop, soda water, distilled water, ginger ale, seltzer water, fermented liquors, and other beverages in the unauthorized use of their bottles or siphons.

Sections 8693-8703, inclusive, relate to the labels, names and stamps of labor unions and associations.

Under sec. 8680b an indictment which failed to charge the defendant filled or caused to be filled any bottle or siphon with any liquid mentioned in the act, was held to be fatally defective. *State v. Wright*, 159 Ind. 394, 65 N. E. Rep. 190.

When, under the Act of 1891, page 317, the "Cigarmaker's International Union of America," a national labor union, registered their label, the benefit of the act being by its terms limited to, "any firm, person, corporation, or voluntary association that is a citizen of the state," it was held that the label could not be protected by a criminal prosecution, notwithstanding the fact that members of the association were citizens of the state. *State v. Hagen*, 6 Ind. App. 167, 33 N. E. Rep. 223.

The sufficiency of an indictment under sec. 8680b is discussed in *State v. Barnett*, 159 Ind. 432, 65 N. E. Rep. 515.

FORM FOR APPLICATION FOR REGISTRATION.

Certificate accompanying a ———, [*insert label, trademark, stamp, or form of advertisement, as the case may be*] filed in accordance with ———, an act to protect manufacturers from the use of counterfeit labels, stamps and trademarks.

Name or names of the person or association ———, [*follow regulations at a*].

Residence, location or place of business ———.

Class of merchandise and the particular description of goods comprised in such class to which the ———, [*insert label, trademark, stamp, or form of advertisement, as the case may be*] has been or is intended to be appropriated ———, [*follow regulations at b*].

Length of time, if any, during which the ———, [*insert label, trademark, stamp, or form of advertisement, as the case may be*] has been in use. Since ———, [*give month, day of month and year when adopted, or give date since when in use*].

REGULATIONS.

a. If a corporation, state under the laws of what state incorporated. If one or more persons are doing business under a proprietary or company name, state the name of such person or persons and add the words "doing business under the name and style of," then give the proprietary or company name under which the business is conducted.

b. State, *first*, as near as possible in one or two words, the general class of merchandise to which the label, trademark, stamp or form of advertisement has been or is intended to be appropriated;

Second, as near as possible in one or two words, the particular description or designation in such general class of merchandise. Do not describe the composition, or name the parts which comprise the formula of which the merchandise is composed;

Third, by using the following words: "The essential feature of the (label, trademark, stamp or form of advertisement) is," giving what is considered to be the essential feature or features thereof. If an illustration or pictorial representation is used for a trademark, it is very desirable that a word or words shall also form a part of the "essential features" of such trademark;

Fourth, by using the following words, that: "The style and size of type and the color of ink and paper may be varied at pleasure."

* I, ———, do hereby declare, in accordance with the provisions ——— has a right to the use of the ——— [*insert label, trademark, stamp or form of advertisement, as the case may be*] referred to in the foregoing certificate, and that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and

I further declare that the fac-similes, copies or counterparts filed with the foregoing certificate are true and correct.

In witness whereof, I have hereunto signed my name this ——— day of ———, in the year one thousand ———.

——— [*Sign here*].

County of ———,
State of ———, ss: ———, 19—.

Then personally appeared the above-named ——— and made oath that the foregoing declaration by him subscribed is true.

Before me, ——— ———

IOWA.

Code 1897, Ch. 13, Tit. 24.

SECTION 5049. FALSELY USING LABEL OF LABOR UNION. Every person, or association or union of workingmen or others, that has adopted or shall adopt for their protection any label, trademark or form of advertisement may file the same for record in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof with the Secretary of State. Said Secretary shall thereupon deliver to such person, association or

* If a person, insert name; if an officer of an association, union or corporation, insert name, title of office, and name of the association, union or corporation.

union so filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar. Such certificate of record shall in all actions and prosecutions under the following six sections be sufficient proof of the adoption of such label, trademark or form of advertisement, and the right of said person, association or union to adopt the same.

SECTION 5050. INJUNCTION. Every person, association or union adopting a label, trademark or form of advertisement, as specified in the preceding section, may proceed by action to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof; and all courts having jurisdiction of such actions shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the complainant therein such damages resulting from such wrongful manufacture, use, display or sale, and a reasonable attorney's fee to be fixed by the court, and shall require the defendant to pay to such person, association or union the profits derived from such wrongful manufacture, use, display or sale, and a reasonable attorney's fee to be fixed by the court, and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court to be destroyed. Such actions may be prosecuted for the benefit of any association or union by any officer or member thereof.

SECTION 5051. IMITATION OF SUCH LABEL. It shall be unlawful for any person or corporation to imitate any label, trademark or form of advertisement adopted as provided in the second preceding section, or to knowingly use any counterfeit or imitation thereof, or to use or display such genuine label, trademark or form of advertisement, or the name or seal of such person, union or association, or of any officer thereof, unless authorized so to do, or in any manner not authorized by him or it. Any person violating any provision of this section shall be imprisoned in the county jail not more than thirty days, or be fined not less than twenty-five nor more than one hundred dollars.

RULES GOVERNING REGISTRATION OF LABELS, TRADEMARKS OR FORMS OF ADVERTISING.

A label, trademark, or form of advertising, may be registered in either or several of the above forms, but if in more than one form, a separate registration must be had for each of the forms for which registration is desired. Duplicate fac-similes or counterparts for each form must be furnished and a fee of $1.00 paid for each registration certificate issued.

Applicant must designate in enclosed blank application the form in which registration is desired, whether as a label, trademark, or form of advertising.

No certificate will be issued covering more than one of above forms.

If application is made by a corporation, union, or association, the application should be signed by the proper officer thereof, with official title, giving the full name of the firm, corporation, union or association.

If by a firm, the firm name should be given, signed by a member of the firm, or all the members of such firm.

Remit $1.00 in payment for each certificate.

All remittances should be made by draft, express or money orders.

Please do not send personal checks.

APPLICATION FOR REGISTRATION.
OF A

——— by ——— of ——— filed in the office of the Secretary of State, of the State of Iowa, in accordance with sections 5049, 5050, 5051, Code of 1897.

The said ——— has been or is intended to be appropriated for use in connection with ———.

The style and size of type and the color of ink and paper may be varied at pleasure.

If used as a label, or trademark, it is usually applied by painting or stenciling, by labels, or by forming on the material of which the product is made.

If, as a form of advertising, it is used in advertisements, in newspapers, circulars, on letter-heads, on invoices, and other printed matter ———.

The said ——— has been in use since ——— and consists of the arbitrarily selected word, mark, symbol or character herewith illustrated.

The essential features of the ——— consists of ———.

In witness whereof, I have hereunto signed my name this ——— day of ——— A. D. 19—.

Name ———.
By ———.

State of ———,
County of ———, ss:

Subscribed and sworn to before me this ——— day of ———, A. D. 19—.

———,
Notary Public.

STATE OF KANSAS.

OFFICE OF SECRETARY OF STATE.

Topeka, January 11, 1915.

Dear Sir:

There are two provisions of law under which trademarks may be registered in Kansas, extracts from which follow:

First. Section 9670, Chapter 119, General Statutes of 1909, provides that

"any and all persons or corporations who may be the owners of cans, tubs, firkins, boxes, bottles, casks, barrels, kegs, siphons, cartons, tanks, fountains, vessels, or containers, with his, her, its or their names, brands, designs, trade-marks, devices or other marks of ownership stamped, impressed, labeled, blown in or otherwise marked thereon, may file with the Secretary of State a written statement or description verified by affidavit of such owner, or his, her or its agent, of the names, designs, brands, trade-marks, devices or other marks of ownership so used by him, her, it or them, and of the said articles upon which the same are used.

"Said statement shall be published once a week for three successive weeks in a newspaper printed in the English language and of general circulation *in the county where such persons shall have their principal place of business*, and the publication be paid for by the party applying for registration, a copy of which publication, proved in the same manner as proof of publication is now required to be made by law, shall also be filed with the Secretary of State. * * * "

The above section applies only to such cans, boxes and other containers as are specifically mentioned therein, and *no other articles can be registered under its provisions.*

Persons wishing to register trademarks under the above section should carefully prepare a written description of the same,

verified by affidavit, have such description published as provided therein, and forward the *original written description* with proof of publication to this office, with a fee of *one dollar*, upon receipt of which such trademark will be registered and certificate of registration furnished.

Second. Section 9675, Chapter 119, General Statutes of 1909, provides that

"whenever any association or union of workingmen have adopted or shall hereafter adopt for their protection any label, trade-mark, or form of advertisement, announcing that goods to which (such) label, trade-mark or form of advertisement shall be attached were manufactured by a member or members of such association or union, it shall be unlawful for any person or corporation to counterfeit or imitate such label, trade-mark or form of advertisement. * * * "

Section 9677 of the same chapter provides that

"every such association or union that has heretofore adopted or shall hereafter adopt a label, trade-mark or form of advertisement as aforesaid, may file the same for record in the office of the Secretary of State by *leaving two copies, counterparts or fac-similes thereof* with the Secretary of State. * * * "

Sections 9675 and 9677 apply only to such goods as have been manufactured by a member or members of an association or union of workingmen, and *no other goods or merchandise can be registered under their provisions.*

Persons wishing to register labels, trademarks or forms of advertisement under section 9675 have only to file two copies, counterparts or *fac-similes* with the Secretary of State with a fee of *one dollar*, upon receipt of which such label, trade-mark or form of advertisement will be registered and certificate of registration furnished.

Unless articles of merchandise on which trade-marks are sought to be registered come under the provisions of one or the other of the above sections no protection would be given the owner by their registration. No blank applications for registration of trademark will be furnished, as none are needed.

J. T. BOTKIN,
Secretary of State.

KENTUCKY.

No general trademark law. General Statutes, 1899.

SECTION 4749. Every union or association of workingmen or women adopting a label, mark, name, brand or device intending to designate the products of the labor of members of such union or association of workingmen or women shall, in order to obtain the benefits of this act, file duplicate copies of such label, mark, name, brand or device in the office of the Secretary of State, who shall, under his hand and seal, deliver to the party filing or registering the same, a certified copy and a certificate of the filing thereof.

It has been held by the Court of Appeals of Kentucky that union labels will be protected against infringement in the absence of a statute. *Hetterman v. Powers*, 102 Ky. 133, 43 S. W. Rep. 180.

Sections 1279 and 1279a relate to the protection of packages of manufacturers and bottlers of soda water, etc.

The following form has been prescribed for application for registration under section 4749:

Be it remembered,

That the ——— has adopted the following label, mark, name, brand or device, which is intended to designate the products of the labor of members of said ——— to-wit: ———; and hereby files duplicate copies thereof in the office of the Secretary of State, pursuant to the provisions of Section 4749, Chapter 130, Kentucky Statutes, title "Union and Labor Associations."

Witness the signatures of the President, Secretary and Treasurer, and the corporate seal of the said ———, this ——— day of ———, 19—.

——— ———,

——— ———.

LOUISIANA.

Act No. 49 of 1898.

AN ACT to protect labels, trademarks, terms, designs, devices or forms of advertisement, and to provide a penalty for violation thereof.

SECTION 1. *Be it enacted by the General Assembly of the State of Louisiana:* Whenever any person, or any association or union of workmen, has heretofore adopted or used or shall hereafter adopt or use any label, trademark, term, design, device or form of advertisement for the purpose of designating, making

known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device or form of advertisement, or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

SECTION 2. *Be it further enacted, etc.*, Whoever counterfeits or imitates any such label, trademark, term, design, device or form of advertisement; or sells, offers for sale or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other products of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than three months.

SECTION 3. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement as provided in section 1 of this act, may file the same for record in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof, with said Secretary and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed; the class of merchandise and a description of the goods

to which it has been or is intended to be appropriated, stating that the party so filing or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said Secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said Secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said Secretary of State shall not record for any person, union or association any label, trademark, term, design, device or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement heretofore filed by or on behalf of any other person, union or association.

SECTION 4. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trademark, term, design, device or form of advertisement in the office of the Secretary of State under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writing or by any fraudulent means, shall be liable to pay any damage sustained in consequence of any such filing to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months.

SECTION 5. Every such person, association or union adopting or using a label, trademark, term, design, device or form of advertisement as aforesaid may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeits or imitations thereof, and all courts of competent jurisdiction shall

grant injunctions to restrain such manufacture, use, display or sale and may award the complainant in any such suit damages resulting from such manufacture, use, sale or display as may be by said court deemed just and reasonable, and shall require the defendants to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

SECTION 6. Every person who shall use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by a fine of not more than one hundred dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

SECTION 7. Any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

SECTION 8. This act shall take effect and be in force from and after its passage.

Approved July 8, 1898.

FORM FOR APPLICATION FOR REGISTRATION.

To all whom it may concern:

Be it known, That ———, a corporation organized under the laws of the State of ———, domiciled in the City of ———, County of ———, and doing business in said city and county, has adopted for its use a trademark for ——— of which three copies, counterparts or fac-similes,

are herewith filed for record in the office of the Secretary of State, to-wit ———:

This application is filed on behalf of the ——— aforesaid. The class of merchandise, and description of goods to which said trade-mark has been appropriated and is intended to be appropriated is ———, the said —— has the sole right to the use of the same. No other person, firm, association, union or corporation has the right to such use, either in the identical form herein above described, or in any such resemblance thereto as may be calculated to deceive, and the fac-similes or counterparts herewith filed are true and correct.

Thus done and signed at the City of ——— this ——— day of ———, 19—.

AFFIDAVIT.

State of ———,
County of ———, ss:

——— being duly sworn, deposes and says that he is the President of the ———, the applicant named in the foregoing instrument, and that the facts alleged in said instrument are true.

Sworn to and subscribed before me, this ——— day of ———, 19—.

———,
Notary Public

STATE OF MAINE.

TRADE-MARKS.

Extracts from Chap. 40, Revised Statutes, 1903.

SECTION 22. Any person, entitled to the exclusive use of any trade-mark, or who intends to adopt and use any trade-mark not previously adopted or used by another, may file for record in the office of the Secretary of State a certificate setting forth his name, residence and place of business; the class of merchandise and the particular description of goods comprised in such class to which such trade-mark has been or is to be appropriated; a description thereof, and of the mode in which it is to be applied and used; the date when it was first used or adopted; that he has a right to the use of it, and that no other person, firm or corporation has the right to such use, either in the identical form, or having such near resemblance thereto as is calculated to deceive. A fac-simile of such trade-mark shall be incorporated in or annexed to said certificate, and a duplicate shall be filed therewith, to be pasted or bound into the record book, if practicable. Such certificate shall be signed and sworn to by such person, or his agent.

SECTION 23. Whoever wilfully swears or affirms falsely to any such certificate, is guilty of perjury, and shall pay treble damages to every party injured thereby. If the Secretary of State has reason to apprehend, on the filing of such certificate, that any statement therein contained is untrue, he may decline to record the same unless the party filing it obtains a writ of mandamus to compel him. Such writ may be granted by any proper court, but without cost to the Secretary, on proof that all the statements in such certificate are true, but no final hearing on the application therefor, shall be had until such notice thereof as said court orders has been advertised in one or more newspapers published in the country where the party filing said certificate resides; and any persons who desire may appear and intervene as parties defendant, and oppose the granting of such writ, and shall be liable to judgment for any costs occasioned by such intervention.

SECTION 24. Every party entitled to make and file such certificate and affidavit, upon recording the same in said office, becomes entitled to the exclusive use of the trade-mark therein described, so long as he or his assigns continue to be engaged in the manufacture or sale of the merchandise or description of goods to which it is appropriated; and such right is assignable in writing; but all assignments thereof are good only against the assignor and his personal representatives, until lodged for record in said office.

SECTION 25. The Secretary of State shall retain all such certificates on file, and cause the same and all assignments of trade-mark rights to be recorded at length in his office. Copies of the record of any such certificate, attested by him under the seal of the state, are prima facie evidence of the right of the party filing such certificate to the exclusive use of the trade-mark therein described for the periods limited in the preceding section.

SECTION 26. Whoever knowingly and wilfully counterfeits, or causes to be counterfeited, any private stamps, labels or trade-marks, used by a mechanic or manufacturer about the sale of his goods, with intent to defraud the purchaser or manufacturer; or sells such goods with such counterfeit stamps labels or

trademarks thereon, knowing them to be counterfeit, without disclosing the fact to the purchaser, shall be punished by imprisonment for not less than one year, or by a fine not exceeding two hundred dollars.

SECTION 27. Whoever reproduces, copies, counterfeits or imitates any such recorded trademark, knowing the same to imitates any such recorded trade-mark, knowing the same to feit or imitation to goods resembling, or designed to resemble, those to which such trade-mark is so appropriated, shall pay the owner of such trade-mark double damages, besides such sum, not exceeding five hundred dollars, as the court, before which the action is brought, orders to be added to the damages found by the verdict or judgment.

SECTION 28. Whoever fraudulently and with intent to deceive, affixes any trade-mark recorded under section twenty-five or any such imitation thereof as is calculated to deceive, to any goods, receptacle or package similar in descriptive properties to those to which such trade-mark is appropriated, or who fraudulently and with intent to deceive, places in any receptacle or package to which is lawfully affixed a recorded trade-mark, goods other than those which said trade-mark is designed and appropriated to protect; or who fraudulently and with intent to deceive, deals in or keeps for sale any goods with a trade-mark fraudulently affixed, as above described, or any goods contained in any package or receptacle having a lawful trade-mark, but not being such goods as said trade-mark was designed and appropriated to protect, shall be fined not more than five hundred dollars, or imprisoned not more than thirty days.

SECTION 29. This chapter does not abridge rights to any existing trade-marks, whether the same are hereafter recorded or not, nor any remedies or rights of action otherwise or heretofore existing in favor of owners of trade-marks.

Sec. 17, Chap. 117, R. S. 1903.

The Secretary of State shall receive for filing and recording a certificate of trade-mark, three dollars; for recording assignment of trade-mark rights, one dollar.

Maine also has an act for the protection of the bottles used in the manufacture and sale of mineral water, soda water, and

similar packages; secs. 35-36, c. 39, Revised Statutes of 1883, as amended with an additional section in Chap. 125, General Laws 1891.

FORM OF APPLICATION FOR REGISTRATION.

Sworn Statement accompanying a ———, filed in accordance with the laws of the State of ———:

I, ———, do hereby certify that the ———, counterparts or fac-similes of which are filed herewith, is filed on behalf of ———, doing business in ———, in the State of ———. That the particular class of merchandise and the particular description of the goods to which it has been or is intended to be appropriated is ———.

That the essential feature of the said ——— consists of ———.

That said ——— has been in use by the above named ———, since ———.

That the said ——— has the right to the use of the same, and that no other person, firm, association or corporation has the right to such use, either in the identical form, or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile copies or counterparts filed herewith are true and correct.

(Signature) ——— ———.

State of ———,

County of ———, ss:

On this ——— day of ——— A. D. 19—, ——— personally appeared the above named ——— and made oath that the foregoing statement by him subscribed is true.

Before me.

MARYLAND.

AN ACT to protect associations and unions of workingmen and persons in their labels, trademarks and forms of advertising and to punish offenders for a violation of the same.

SECTION 1. *Be it enacted by the General Assembly of Maryland*, That whenever any person, association or union of workingmen have adopted, or shall hereafter adopt for their protection any label, trademark or form of advertisement announcing and denoting that goods to which such label, trademark or form of advertisement shall or may be attached, were manufactured by such person or by a member or members of such association or union, it shall not be lawful for any person or corporation to counterfeit or imitate such label, trademark or form of advertisement, every person violating this section shall be deemed guilty of a misdemeanor and shall upon conviction by any court having criminal jurisdiction be punished by imprison-

ment in the city or county jail for not less than three months nor more than one year or by a fine of not less than one hundred dollars nor more than five hundred dollars, or both, in the discretion of the court.

SECTION 2. *And be it enacted*, That every person, corporation or association who shall use any counterfeit or imitation of any label, trademark or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation, (he) shall be guilty of a misdemeanor and shall on conviction by any court having criminal jurisdiction be punished by imprisonment in the city or county jail for a term of not less than one month nor more than one year, or by a fine of not less than one hundred dollars nor more than two hundred dollars, or both, in the discretion of the court, and the burden of proving that the defendant did not know the true character of the said label, trademark or form of advertisement, and that he used the same in good faith shall be on the defendant.

SECTION 3. *And be it enacted*, That every such person, association or union that has heretofore adopted, or shall hereafter adopt, a label, trademark or form of advertisement as aforesaid, may file the same for record, in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof, with the Secretary of State and said Secretary shall deliver to such person, association or union so filing the same a duly attested certificate of the record of the same for which he shall receive a fee of one dollar, such certificate of record shall be in all suits and prosecutions under this act sufficient proof of the adoption of such label, trademark or form of advertisement, and of the right of said person, association or union to adopt the same, no label shall be recorded, that probably would be mistaken for a label already of record, of which question the said Secretary shall be the judge.

SECTION 4. *And be it enacted*, That every such person, association or union adopting a label, trademark or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any such counterfeit or imitation, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale,

and shall award the complainant in such suit such damage resulting from such wrongful manufacture, use, display or sale, as may by said court be deemed just and reasonable, according to the evidence in the case, and shall require the defendants to pay such persons, associations or unions, the profits derived from such wrongful manufacture, use, display or sale, and in addition to court costs, such reasonable attorney's fees as the court may allow, and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant to be destroyed.

SECTION 5. *And be it enacted*, That every person who shall use or display the genuine label, trademark of form of advertisement, of any such person, association or union, in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor and shall, on conviction be punished by imprisonment in the city or county jail not less than one month nor more than one year, or by a fine of not less than fifty dollars or more than two hundred dollars, or both, in the discretion of the court.

SECTION 6. *And be it enacted*, That any person or persons who shall in any way use the name or seal of any such person, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, punishable on conviction by imprisonment in the city or county jail for a term of not less than one month nor more than one year, or by a fine of not less than fifty dollars nor more than three hundred dollars, or both, in the discretion of the court.

SECTION 7. *And be it enacted*, That all the acts and parts of acts inconsistent with this act are hereby repealed.

SECTION 8. *And be it enacted*, That this act shall take effect from the date of its passage.

Approved April 4th, 1892.

Maryland also has an act for the protection of the bottles, jugs, kegs, etc., of manufacturers and dealers in mineral water and other beverages; secs. 201-206, Article 27, General Laws, amended by Acts of 1892, Chapter 262.

As to the requisites of a bill in equity founded on registration under the Act of 1892, see *Smith-Dixon Co. v. Stevens*, 59 Atl. Rep. 401.

APPLICATION FOR THE REGISTRATION OF A TRADE-MARK, LABEL, OR FORM OF ADVERTISEMENT.

To the Secretary of State, ———:

The ——— whose address is ———, in the State of ———, and whose business or trade is ———, has adopted a trade-mark, label or form of advertisement and hereby makes application to the Secretary of State of the State of Maryland, for the registration of the same, in compliance with the provisions of Chapter 357 of the Laws of Maryland of 1892.

The said applicant herewith files two fac-similes of said trade-mark, label or form of advertisement and announces that the same is to be attached to ———, which goods are manufactured by the said applicant.

In witness whereof, I, ——— Vice-President [*or other proper officer*] of said corporation, have hereunto set my hand and affixed the seal of said corporation, this ——— day of ———, 19—.

[Seal.]

State of ———,
County of ———, ss:

Personally appeared before me, the undersigned, a Notary Public in and for the State and county aforesaid, the above named ———, who has signed the aforegoing application, and made oath in due form of law that he is the proper officer to sign the same, and that the matters and facts stated in said application, are true.

Witness, my hand and Notarial Seal, this ——— day of ———, 19—.

———— ————,

[Seal.] *Notary Public.*

MASSACHUSETTS.

Chapter 72, Revised Laws.

DEFINITIONS.

SECTION 1. The following words shall, in addition to their ordinary meaning, have the meaning herein given:

The word "name" or "names" in sections two, three, six, ten, twelve, fourteen, fifteen, sixteen, eighteen, nineteen and twenty-one of this chapter includes "letters," "marks," "devices" and "figures."

The word "person" or "persons" in sections two, seven, nine, fourteen to twenty, inclusive, and twenty-three, includes "firm," "association," "union," and "corporation."

The word "boots" in section four includes "half boots," "shoes," "pumps," "sandals," "slippers" and "overshoes."

The word "label" or "labels" in sections six to twelve, inclusive, includes "trademark," "stamp" or "form of advertisement."

The word "beverage" or "beverages" in sections fifteen to eighteen, inclusive, includes also "milk," "cream," "soda water," "mineral" or "aerated waters," "ale," "beer," "ginger ale" or "similar beverages."

The word "vessel" or "vessels" in sections fifteen to eighteen, inclusive, includes "cans," "bottles," "siphons," "fountains" and "boxes."

The word "can" or "cans" in sections nineteen to twenty-three, inclusive, includes "jugs," "bottles" and "jars."

LABELS AND TRADEMARKS.

SECTION 2. When a person uses any peculiar name upon or connected with an article manufactured or sold by him to designate it as an article of a peculiar kind or quality, or as manufactured by him, no other person shall without his consent use the same or any similar name for the purpose of falsely representing an article to have been manufactured by or to be of the same kind or quality as those manufactured or sold by the person rightfully using such name.

SECTION 3. Whoever violates the provisions of the preceding section, and whoever knowingly sells or exposes for sale an article having a name upon or connected with it in violation of the provisions of the preceding section, shall be liable in an action of tort to any party aggrieved thereby for all damages actually incurred.

SECTION 4. Every manufacturer of leather or boots shall have the exclusive right of stamping the articles manufactured by him with his name and the name of the place of manufacture; and such stamping shall be considered as a warranty that the article stamped is merchantable, made of good materials and well manufactured; and such article shall not be considered merchantable unless so stamped.

SECTION 5. A person who carries on business in this commonwealth shall not assume or continue to use in his business the

name of a person formerly connected with him in partnership or the name of any other person, either alone or in connection with his own or with any other name or designation, without the consent in writing of such person or of his legal representatives.

SECTION 6. The supreme judicial court or the superior court shall have jurisdiction in equity to restrain the use of names or labels in violation of the provisions of this chapter.

SECTION 7. Any person may adopt a label, not previously owned or adopted by any other person, and file such label for record, by depositing two copies or fac-similes thereof in the office of the Secretary of the Commonwealth, one of which copies or fac-similes shall be attached by the Secretary of the Commonwealth to the certificate of record hereinafter referred to. The applicant shall file with the label a certificate specifying the name of the person so filing such label, his residence, situation or place of business, the kind of merchandise to which such label has been or is intended to be appropriated, and the length of time, if any, during which it has been in use. If such label has not been and is not intended to be used in connection with merchandise, the particular purpose or use for which it has been or is intended shall be stated in the certificate. Such certificate shall be accompanied by a written declaration, verified under oath by the person, or by a member of the firm or by an officer of the association, union or corporation, by which it is filed, that the party so filing such label has a right to use the same, and that no other person has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the copies or fac-similes filed therewith are true. The Secretary of the Commonwealth shall issue to the person depositing such label a certificate of record, under the seal of the commonwealth, and the Secretary shall cause the certificate to be recorded in his office. Such certificate of record or a certified copy of its record in the office of the Secretary of the Commonwealth, shall in all suits and prosecutions under the provisions of this section and of sections eight to fourteen, inclusive, be sufficient proof of the recording of such label and of the existence of the person named in the

certificate. The fee for filing the certificate and declaration and issuing the certificate of record shall be two dollars. No label shall be recorded which could reasonably be mistaken for a label already on record.

SECTION 8. The Secretary of the Commonwealth is authorized to make regulations, and prescribe forms for the filing of labels, under the provisions of the preceding section.

SECTION 9. The supreme judicial court or the superior court shall have jurisdiction in equity to restrain the manufacture, use or sale of counterfeits or imitations of a label, recorded as provided in section seven, shall award damages resulting from such wrongful manufacture, use or sale and shall require the defendant to pay the owner of such label the profits derived from such wrongful manufacture, use or sale; and may also order that all such counterfeits or imitations in his possession or control be delivered to an officer of the court, or to the complainant to be destroyed. If the complainant is not incorporated, suits under the provisions of sections seven, eight and ten to fourteen, inclusive, may be commenced and prosecuted by an officer thereof, on behalf of and for the use of the complainant. Every member of a complainant firm, association or union shall be liable for costs in any such proceeding.

SECTION 10. Whoever knowingly makes or uses any counterfeit or imitation of any lawful name or label or causes the same to be made or used, or sells, offers for sale, deals in or has in his possession with intent to use, sell, offer for sale or deal in the same, or affixes, impresses or uses such counterfeit or imitation upon any goods, shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

SECTION 11. Whoever, with intent to defraud, knowingly casts, engraves or manufactures, or has in his possession, or buys, sells, offers for sale, or deals in, a die, plate, brand, mold, or engraving on wood, stone, metal or other substance, of a label recorded pursuant to the statutes of this commonwealth, or a printing press, or types or other tools, machines or materials provided or prepared for making a counterfeit or imitation of

such label, shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

SECTION 12. Whoever knowingly sells or exposes for sale goods upon which any lawful name or label or any counterfeit or imitation thereof is unlawfully affixed, impressed, or used shall be punished by a fine of not more than two hundred dollars or by imprisonment for not more than one year, or by both such fine and imprisonment.

SECTION 13. Whoever, with intent to defraud, knowingly aids or abets in the violation of any of the provisions of the seven preceding sections shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than six months, or by both such fine and imprisonment.

SECTION 14. In any suit or prosecution under the provisions of the five preceding sections, the defendant may show that he was the owner of such name or label prior to its being filed under the provisions of section seven, and that it has been wrongfully filed by some other person.

Note.—In a prosecution under this act, the recital in the certificate of adoption that the mark had been in use "since about the year 1888," was held sufficient. *Commonwealth v. Rozen*, 176 Mass. 129, 57 N. E. Rep. 223.

Sections 15-23 relate to the protection of vessels used in the sale of beverages, and milk cans. Held to be a proper police regulation in *Commonwealth v. Anselvich*, 186 Mass. 376, 71 N. E. Rep. 790.

AN ACT to provide for registration of the insignia of societies, associations and labor unions, and to prohibit the unauthorized use thereof.

Be it enacted, etc., as follows:

SECTION 1. The insignia, ribbons, badges, rosettes, buttons and emblems of any society, association or labor union may be registered in the office of the Secretary of the Commonwealth in the manner and subject to the provisions, so far as they are applicable, set forth in section seven of chapter seventy-two of the Revised Laws in regard to labels; and the Secretary is

hereby authorized to make regulations and prescribe forms for such registration.

SECTION 2. Whoever, not being a member of a society, association or labor union, for the purpose of representing that he is a member thereof, wilfully wears or uses the insignia, ribbon, badge, rosette, button or emblem thereof, if the same has been registered in the office of the Secretary of the Commonwealth, shall be punished by a fine of not more then twenty dollars, or by imprisonment for not more than thirty days, or by both such fine and imprisonment.

SECTION 3. Chapter four hundred and thirty of the Acts of the year nineteen hundred and two and chapter two hundred and seventy-five of the Acts of the year nineteen hundred and three are hereby reappealed.

Approved May 13, 1904.

Section 4 of Chapter 462, Statutes 1895, is a penal section for using counterfeit trademarks upon cigars. Under this section when the defendants were shown to have a place of business within the state, a conviction was sustained in the absence of any proof as to where the defendants intended to sell the cigars bearing the counterfeit mark. *Commonwealth* v. *Rozen*, 176 Mass. 129, 57 N. E. Rep. 223.

Pub. Stat. Chap 76, sec. 1, providing that trademarks can not be used without the consent of the owner, does not apply to a mark that is the name of a machine upon which there has been a patent, after the expiration of the patent. *Dover Stamping Co.* v. *Fellows*, 163 Mass. 191, 40 N. E. Rep. 105.

Section 6, Chapter 76, Pub. Stat., forbidding any person to "assume or continue to use" in his business the name of a person formerly connected with him in partnership, or the name of any other person "without written consent," does not apply to a person advertising himself as "formerly with" or "successor to" another. *Martin* v. *Bowker*, 163 Mass. 461, 40 N. E. Rep. 766.

In a bill in equity brought by a labor union, under sec. 3, chap. 462, Stat. 1895, it has been held immaterial that the defendant's use of the spurious label antedated the passage of the act. *Tracy* v. *Banker*, 170 Mass. 266, 49 N. E. Rep. 308.

TRADEMARK REGISTRATION INSTRUCTIONS.

THE COMMONWEALTH OF MASSACHUSETTS.

Office of the Secretary.

The accompanying blank form of application is to be used for the registration of a label, trade-mark, stamp or form of advertisement in this office under the laws of this Commonwealth.

The regulations printed in small type upon said application are to be carefully followed and observed.

Two fac-similes of the label, trade-mark, stamp or form of advertisement, either in the press-printed form as used, or hand-printed in India ink after the manner of press printing upon bond or other substantial paper (not cardboard), and the statutory fee of two dollars for registration are to accompany the application.

Do not gum or fasten the fac-similes in any way to the application.

———— ————,

Secretary of the Commonwealth.

THE COMMONWEALTH OF MASSACHUSETTS.

Certificate accompanying a ———— [*insert the designation, label, trade-mark, stamp or form of advertisement, as the case may be*] filed for record in accordance with section 7 of chapter 72 of the Revised Laws, relative to the adoption and registration of labels, trade-marks, stamps, and forms of advertisement.

Name or names of the person, firm, association, union or corporation, ———— [*If a firm, state the fact, give the firm name and the names of the persons comprising it. If an association, union or corporation, name the state under the laws of which it is organized or incorporated. If one or more persons are doing business under a proprietary or company name, give the name of such person or persons and add the words "doing business under the name and style of," then give such proprietary or company name*] residence, situation or place of business, ————.

Kind of merchandise to which, or, if not used in connection with merchandise, then the particular purpose or use for which the [*insert the designation, label, trade-mark, stamp or form of advertisement, as the case may be*] has been or is intended to be appropriated, [*if the label, trade-mark, stamp or form of advertisement is applicable to merchandise, give, as nearly as possible, in one or two words, the kind of merchandise. Do not describe the composition or name the parts, nor give the chemical formula of which the merchandise is constituted. If the label, trade-mark, stamp or form of advertisement is not applicable to merchandise, then give, as nearly as possible, in one or two words, the particular purpose or use for which it has been or is intended to be utilized*].

The essential feature of the [*insert the designation, label, trade-mark, stamp or form of advertisement, as the case may be*] consists of [*give what is considered to be the essential feature or features thereof*].

The style and size of type, and color of ink and paper ——— be varied at pleasure [*use the word "may" or the words "will not" as the case may be*].

Length of time, if any, during which the [*insert the designation, label, trade-mark, stamp or form of advertisement, as the case may be*] has been in use. Since [*give month, day of month and year when adopted, or give date since when in use*].

I, ———, [*if a person, insert name; if a member of a firm, insert member's name and name of firm; if an officer of an association, union or corporation, insert the name of officer, title of office, and name of the association, union or corporation. Outside of Massachusetts, oath is to be administered by a Commissioner for Massachusetts or a Notary Public*] do hereby declare in accordance with the provisions of section 7 of chapter 72 of the Revised Laws that ———, ha— [*have or has*] a right to use the [*insert the designation, label, trade-mark, stamp or form of advertisement, as the case may be*] referred to in the foregoing certificate, and that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and

I further declare that the copies or fac-similes filed with the foregoing certificate are true.

In witness whereof, I have hereto signed my name this ——— day of ——— in the year nineteen hundred and ———.

——— [*Sign here*].

THE COMMONWEALTH OF MASSACHUSETTS.

———, ss. ———, 19—.

Then personally appeared the above-named ———, and made oath that the foregoing declaration by him subscribed is true.

Before me,

——— ———,

Justice of the Peace.

MICHIGAN.

§§ 11681-86, C. L. 1897.

AN ACT to provide for the protection of associations and unions of workingmen and artisans, or other persons in their Labels, Trade-marks, and forms of Advertisement, and to punish the counterfeiting and fraudulent use of such labels, trademarks and forms of advertising.

(11681) SECTION 1. That whenever any person or any association or union of workingmen has heretofore adopted or used, or shall hereafter adopt or use, any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known or distinguishing any goods, wares,

merchandise or other product of labor as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such labels, trademark, term, design, device or form of advertisement.

(11682) SECTION 2. Whoever counterfeits or imitates any such label, trademark, term, design, device or form of advertisement, or sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement; or knowingly uses any such counterfeit or imitation, or knowingly sells or disposes of, or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which any such counterfeit or imitation is attached or affixed, or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or shall use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association; or who shall in any way use the name or seal of any such person, association or union or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be deemed guilty of a misdemeanor, and shall be punished as hereinafter provided. In suits or proceedings for damage, or for equitable relief by or on behalf of any such person, association or union, on account of the violation of any provision of this

act, it shall not be necessary to prove that such violation was knowingly or wilfully committed.

(11683) SECTION 3. Any person, whether a member of a firm or corporation, or otherwise, who shall violate any of the provisions of section one of this act, or who shall knowingly or wilfully violate any provision of section two of this act, shall be deemed to have committed a misdemeanor thereby, and on conviction thereof shall be punished by a fine of not less than ten nor more than one hundred dollars, or by imprisonment in the county jail for a period not exceeding ninety days, or by both such fine and imprisonment, in the discretion of the court.

(11684) SECTION 4. In action at law or proceedings in equity brought on behalf of any such association or union which is not incorporated, the same may be brought in the name of any member of such association or union, who has been duly authorized so to do by such association or union, but for the use and benefit of all of the members of such association or union: *provided*, that before commencing such action or proceeding the member so authorized shall file with the justice or clerk of such court a certificate of the president and secretary of such association or union, showing that such authority has been granted. Any criminal proceeding brought for a violation of any provision of this act, may be prosecuted by the authorized attorney of such association or union, in the court where originally commenced, but in such case the fees and compensation of such attorney shall be borne and paid exclusively by such association or union: *provided*, that nothing herein shall be deemed to prevent the prosecuting attorney from conducting any such prosecution, or the said authorized attorney of such association or union from deputizing a duly qualified attorney at law to appear in his stead.

(11685) SECTION 5. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement, as provided in section one of this act, shall file the same for record in the office of the Secretary of State, by leaving two copies, counterparts or fac-similes thereof, with said Secretary and by filing therewith a sworn statement specifying

the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, the class of merchandise and a particular description of the goods to which it has been or is intended to be appropriated; that the party so filing, or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed has the right to the use of the same, and that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile copies or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Any person who shall for himself, or on behalf of any other person, association or union, procure the filing of any label, trademark, term, design, device or form of advertisement in the office of the Secretary of State, under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months, or by both such fine and imprisonment. Said Secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said Secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be *prima facie* proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said Secretary of State shall not record for any person, union or association, any label, trademark, term, design, device or form of advertisement that would reasonably be mistaken for any label, trademark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

(11686) SECTION 6. In no case shall the certificate from the Secretary of State, obtained in conformity with the fifth section

of this act, be assignable by the party to whom the same is issued.

(N. B.—If a certificate is wanted, send two dollars and three fac-similes.)

APPLICATION FOR REGISTRATION.

Sworn statement accompanying a ——— [*insert the word label, trade-mark, term, design, device or form of advertisement, as the case may be*] filed in accordance with Act No. 206 of the Public Acts of 1895, of Michigan.

I, ———, [*if a person, insert name; if a member of a company or firm, insert name and add the words "a member of the firm or co-partnership doing business under the name and style of," then give the company name, and add "composed of" giving names of the members; if an officer of an association, corporation, or union, insert name, title of office and name of the association, corporation or union*] do hereby declare that the [*insert the word label, trade-mark, term, design, device or form of advertisement, as the case may be*] counterparts or fac-similes of which are filed herewith is filed on behalf of ———, that the particular class of merchandise and a particular description of the goods to which it has been or is intended to be appropriated is ——— that the said ——— has the right to the use of the same and that no other person, firm, association, union or corporation has the right to such use, either in the identical form, or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile copies or counterparts filed herewith are true and correct.

——— [*Sign here*].

State of ———,
County of ———, ss:

On this ——— day of ———, A. D. 19—, before me a ———, personally appeared the above-named ———, and made oath that the foregoing statement by him subscribed is true. ——— ———

My commission expires ———, 19—.

MINNESOTA.

Chapter 122, General Laws, 1895.

TRADEMARKS.

AN ACT to amend an Act entitled an Act Relating to Labels, Trademarks and Advertisements, and to Provide for Their Protection and the Punishment for Counterfeiting the Same or for Using Counterfeits of the Same. Approved April Seventeenth (17th) being Chapter Twenty-four (24) of General Laws of Minnesota of 1893.

Be is enacted by the Legislature of the State of Minnesota:

SECTION 1. That section 1 of an act relating to labels, trademarks and advertisements, and to provide for their protection

and the punishment for counterfeiting the same, or for using counterfeits of the same being chapter twenty-four (24) of the General Laws of Minnesota of one thousand eight hundred ninety-three (1893), be, and the same is hereby amended to read as follows, namely:

"Section 1. PROTECTION. Whenever any person, or any association or union of workingmen has heretofore adopted or used or shall hereafter adopt or use any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device or form of advertisement or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement."

SECTION 2. That section two (2) of the act above named be, and is hereby amended, to read as follows namely:

"Section 2. PENALTY FOR COUNTERFEITING OR DEALING IN COUNTERFEITS. Whoever counterfeits or imitates any such label, trademark, term, design, device or form of advertisement, or sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement, or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other products of labor to which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed; or keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or

impressed; shall be punished by a fine of not more than one hundred ($100) dollars or by imprisonment for not more than three months."

SECTION 3. That section three (3) of said act be and the same is hereby amended so as to read as follows, namely:

"Section 3. REGISTRY. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use a label, trademark, term, design, device, or form of advertisement, as provided in section one (1) of this act, may file the same for record in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof with said Secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated; stating that the party so filing or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one (1) dollar. Any person who shall for himself or on behalf of any other person, association or union procure the filing of any label, trademark, term, design or form of advertisement in the office of the Secretary of State under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction and shall be punished by a fine not exceeding one hundred ($100) dollars or by imprisonment not exceeding three (3) months. Said Secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as

such person, association or union may apply for, for each of which certificates said Secretary shall receive a fee of one ($1.00) dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof to the adoption of such label, trademark, term, design, device or form of advertisement. Said Secretary of State shall not record for any person, union or association any label, trademark, term, design, device or form of advertisement that would reasonably be mistaken for any label, trademark, term, design, device or form of advertisement theretofore filed by or in behalf of any other person, union or association."

SECTION 4. That section four (4) of said act be and is hereby amended to read as follows:

"Section 4. PROHIBITING INFRINGEMENTS. Every such person, association or union adopting or using a label, trademark, term, design, device or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale as may be by the said court deemed just and reasonable, and shall require the defendants to pay to such person, association or union, all profits derived from such wrongful manufacture, use, display or sale, and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause, be delivered to an officer of the court, or to the complainant to be destroyed."

SECTION 5. That section five (5) of said act be and the same is hereby amended to read as follows:

"Section 5. PENALTY FOR APPROPRIATING. Every person who shall use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, association or union in any manner not authorized by such person, union or association, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three (3) months or by a fine of not more than one hundred ($100) dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by any

officer or member of such association or union on behalf of and for the use of such association or union."

SECTION 6. That section six (6) of this act may be and is hereby amended to read as follows:

SECTION 6. PENALTY FOR UNAUTHORIZED USE. Any person who shall in any way use the name or seal of any such person, association or union or officer thereof in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three (3) months, or for a fine of not more than one hundred (100) dollars."

SECTION 7. This act shall take effect and be in force from and after its passage.

Approved February 23rd, 1895.

General Statutes, 1894.

SECTION 6908. Any person or persons who shall knowingly and wilfully forge or counterfeit, procure to be forged or counterfeited, any representation, likeness, similitude, copy or imitation of the private stamps, brands, wrapper, label or trademark, usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to and upon the goods, wares, merchandise or preparation of said mechanic, manufacturer, druggist, merchant or tradesman, with intent to pass off any work, goods, manufacture, compound or preparation, to which such forged or counterfeited representation, likeness, similitude, copy, or imitation is affixed, or intended to be affixed, as the work, goods, manufacture, compound or preparation of such mechanic manufacturer, druggist, merchant or tradesman, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for a period [of] not less than six months, nor more than twelve months, or fined not more than five thousand dollars.

SECTION 6909. Any person or persons who shall, with intent to defraud any person or persons, body corporate or politic, have in his or their possession any die or dies, plate or plates, brand or brands, engraving or engravings or printed labels,

stamps, imprints, wrapper, or trademarks, or any representation, likeness, similitude, copy or imitation of the private stamps, imprint, brand, wrapper, label, or trademark usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to or upon articles made, manufactured, prepared or compounded by him or them, for the purpose of making impressions or selling the same when made, or using the same upon any other article made, manufactured, prepared or compounded, and passing the same off upon the community as the original goods, manufactures, preparations or compounds of any other person or persons, body corporate or politic, or who shall wrongfully and fraudulently sell or use the genuine stamp, brand, imprint, wrapper, label or trademark, with intent to pass off any goods, wares, merchandise, mixtures, compounds or other articles not the manufacture of the person or persons, body corporate or politic, to whom such stamp, brand, imprint, wrappers, label or trademark properly belongs, as genuine and original, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than six months, nor more than twelve months, or be fined not more than five thousand dollars.

SECTION 6910. Any person who shall vend or keep for sale any goods, wares, merchandise, mixture or preparation, upon which any forged or counterfeit stamps, brands, imprints, wrappers, labels or trademarks shall be placed or affixed, and intended to represent the said goods, wares, merchandise, mixture or preparation as the genuine goods, wares, merchandise, mixture or preparation of any other person or persons, knowing the same to be counterfeit, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by a fine not exceeding five hundred dollars in each case so offending, and shall also be liable in a civil action to the person or persons whose goods, wares, merchandise, mixture or preparation is counterfeited or imitated, or whose stamps, brands, imprints, wrappers, labels, or trademarks are forged, counterfeited, placed or affixed, for all damages such person or persons may or shall sustain by reason of any of the acts in this section mentioned, and may be restrained or enjoined by any court of competent

jurisdiction from doing or performing any of the acts above mentioned.

SECTION 6911. Any person or persons who shall, with intent to defraud any person or persons, body corporate or politic, knowingly affix or cause to be affixed to or upon any bottle, case, box or package containing any goods, manufacture, mixture, preparation or compound, any stamp, brand, label, wrapper, imprint or trademark, which shall designate such goods, manufacture, mixture, preparation or compound, either wholly or in part, the same to the eye or in sound to the ear, as the word or words, or some of the words, used by any other person or persons for designating any goods, manufacture, mixture, preparation or compound manufactured or prepared by or for such other person or persons, or who shall knowingly sell or expose, or offer for sale, any such bottle, case, box or package, with any such stamp, brand, label, wrapper, imprint or mark affixed to or upon it shall, provided such person or persons so affixing or causing to be affixed any such stamp, brand, label, wrapper, imprint or mark, or to selling or exposing, or offering for sale, any such bottle, case, box or package, shall not have been the first to employ or use such words, to designate, wholly or in part, any goods, manufacture, mixture, preparations or compound, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than six nor more than twelve months, or be fined not more than five thousand dollars, and shall also be liable to the party aggrieved in the penal sum of one hundred dollars for each and every offense, to be recovered by him in a civil action.

SECTION 6912. Any person or persons who, with intent to defraud, or to enable another to defraud, any person, shall manufacture or knowingly sell, or cause to be manufactured or sold, any article or articles, marked, stamped or branded, or incased or inclosed in any box, bottle or wrapper having thereon any engraving or engravings, or printed labels, stamps, imprints, marks, or trademarks, which article or articles are not the manufacture, workmanship or production of the person named, indicated or denoted by such marking, stamping or branding, or by or upon such engraving or engravings, printed labels,

stamps, imprints, marks or trademarks, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and for such offense shall forfeit and pay a fine of two hundred dollars, to be recovered, with costs, in a civil action to be prosecuted by the county attorney, of any county in the state, in the name of the county in which said action shall be commenced, and the one-half of such recovery shall be paid to the informer, and the residue shall be applied to the support of the poor in the county where such recovery is had.

SECTION 6913. A "trademark" is a mark used to indicate the maker, owner or seller of any goods, wares, merchandise, mixture, preparation or compound, and includes, among other things, any name of a person or corporation, or any letter, word, device, emblem, figure, seal, stamp, diagram, brand, wrapper, ticket, stopper, label, or other mark lawfully adopted by him and usually affixed to any goods, merchandise, mixture, preparation or compound to denote the same was imported, manufactured, produced, sold, compounded, bottled, packed or otherwise prepared by him.

SECTION 6914. A trademark is deemed to be affixed to any goods, wares, merchandise, mixture, preparation or compound when it is placed in any manner in or upon either—

(1) The article itself; or

(2) A box, bale, barrel, bottle, case, cask, or other vessel or package, or a cover, wrapper, stopper, brand, label, or other thing, in, by, or with which the goods are packed, inclosed or otherwise prepared for sale or disposition.

SECTION 6915. An imitation of a trademark, stamp, brand, wrapper, or label is that which so far resembles the genuine trademark, stamp, brand, wrapper or label as to be likely to induce the belief that it is genuine, either by the use of words or letters similar in appearance or in sound, or by any sign, device, or the names whatsoever.

SECTION 6916. No testimony or evidence given by any person in any civil action to which such person may be a party, or by any other witness in such action, or on any reference or proceeding which may be had in such action, nor any evidence or

testimony derived from the books or papers of such party or witness, produced by him as witness, or otherwise, in such action, or on any reference or other proceedings which may be had therein, can or shall be used in any criminal prosecution against such party or witness, under any of the provisions of this act; nor shall any party or witness refuse to testify or furnish evidence in any civil action by reason of any of the provisions of this act.

Minnesota also has an act entitled "An act to protect the owners of receptacles used in the sale of soda waters, mineral or aerated water, porter, ale, cider, ginger ale, small beer, lager beer, weiss beer, beer, white beer, malt extracts, other beverages, milk, cream, ice cream and butter," approved April 19, 1905.

The statutory penalty for the infringement of a trademark can only be recovered where the fraudulent intent of the defendant is shown. *Watkins v. Landon*, 52 Minn. 389, 54 N. W. Rep. 193.

APPLICATION FOR REGISTRATION OF TRADEMARK.

(Unofficial)

To all whom it may concern:

Be it known, that ———, a corporation organized under the laws of the State of ———, and located and doing business in the ——— and State of ———, has adopted for its use as trademark for ——— of which the following is a description.

The trademark consists of the word ———.

The following is a copy, fac-simile or counterpart of the said trademark, to-wit:

The class and particular description of goods to which the said trademark [illegible] and is intended to be appropriated is, the class, ———, the particular description of goods, ———.

The said trademark has been continuously used in the business of said corporation since about the ——— day of ———, 19—.

The said trademark is usually applied by means of ———.

——— [*Sign here*].

State of ——— ———,
County of ——— ———, ss:

———, being duly sworn, says that he is the ———, of the corporation, ———, the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said corporation at this time has the right to the use of the trademark therein prescribed; that no other person, firm, association or corporation has the

right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive; and that the description and copy, fac-simile or counterpart filed therewith truly represent the trademark sought to be registered.

——— [*Sign here*].

Subscribed and sworn to before me this ——— day of ———, 19—.

———, *Notary Public.*

MISSISSIPPI.

Ann. Code 1892.

SECTION 1306. Every person who shall knowingly and wilfully forge or counterfeit, or cause or procure to be forged or counterfeited, any representation, likeness, similitude, copy, or imitation of the private stamp, wrappers, or labels, usually affixed by any mechanic or manufacturer to, and used by such mechanic or manufacturer on, in, or about the sale of any goods, wares, or merchandise whatsoever, shall be guilty of a misdemeanor, and, upon conviction, shall be punished by a fine not exceeding five hundred dollars, or imprisonment in the county jail not less than three months nor more than one year.

SECTION 1307. Every person who shall have in his possession any die, plate, engraving, or printed label, stamp, or wrapper, or any representation, likeness, similitude, copy, or imitation of the private stamp, wrapper, or label usually affixed by any mechanic or manufacturer to and used by such mechanic or manufacturer on, in, or about the sale of any goods, wares or merchandise, with intent to use or sell the said die, plate, or engraving, or printed stamp, label, or wrapper, for the purpose of aiding or assisting in any way whatever in vending any goods, wares, or merchandise in imitation of, or intended to resemble and be sold for the goods, wares, or merchandise of such mechanic or manufacturer, shall be guilty of a misdemeanor, and, upon conviction, be punished by fine not exceeding five hundred dollars, or imprisonment in the county jail not less than three months nor more than one year.

SECTION 1308. Every person who shall vend any goods, wares, or merchandise, having thereon any forged or counterfeit stamp or label, imitating, resembling, or purporting to be

the stamp or label of any mechanic or manufacturer, knowing the same to be forged or counterfeited, and resembling or purporting to be imitations of the stamps or labels of such mechanic or manufacturer, without disclosing the fact to the purchaser thereof, shall be guilty of a misdemeanor, and, upon conviction, shall be punished by imprisonment in the county jail not exceeding three months, or by a fine not less than fifty nor more than five hundred dollars, or both.

MISSOURI.

Revised Statutes, 1909.

MARKS AND BRANDS OF FLOUR, ETC.

SECTION 6618. BRANDS NOT TO BE ALTERED. No person shall deface, remove, obliterate or destroy, or cause the same to be done, any brand or mark placed upon any package or barrel of flour, meal, grits or hominy by the manufacturer thereof, with intent to replace the brand so erased and removed by another and different brand from that of the manufacturer; and it shall not be lawful for any person to rebrand any such package or barrel, so long as the contents thereof remain the same.

SECTION 6619. TO BE RECORDED. No person shall manufacture any flour, grits, hominy or meal until he shall have filed with the Recorder of Deeds of the county in which his business is conducted, and acknowledged the same as deeds to lands are required to be acknowledged, a fac-simile of each of the brands he intends to use, which shall contain the colors to be used in applying the same, the weight and quality of the flour, grits, hominy or meal, and the name of the manufacturer thereof, or of some person in his employ, and the state or town or place and the mill where manufactured. Should any manufacturer claim any of his brands, or any part of the same, as a trademark, the said recorder shall record his claim, and thereafter, it shall not be lawful for any person to use such brand: *Provided*, always, that this section shall not be construed to interfere with the right to any brand or trademark copyrighted or patented in pursuance of an act of congress.

SECTION 6620. THE USING OF BRANDS OF OTHERS PROHIBITED. No person within this state shall use the name of a mill or a

brand upon any barrel or package containing flour made from grains, or the admixture of grains, unless the same shall belong, *bona fide*, to the person using the same, nor unless the flour upon which the same may be used was manufactured by the owner of such mill or brand.

SECTION 6621. RECORDER'S CERTIFICATES, EVIDENCE. It shall be the duty of each Recorder of Deeds within the state to keep a book in his office, in which to record the flour brands provided for in section 6619, and a certified copy of any such record, by the Recorder, shall be evidence in all courts of the making and filing and contents thereof.

SECTION 6622. PENALTY. Any person doing any of the acts in this article prohibited, or omitting to do any of the acts hereby commanded, shall be guilty of a misdemeanor, and for each and every offense shall be punished by a fine of not less than twenty nor more than two hundred dollars, one-half of which shall be paid to the person who shall be named as prosecuting witness.

TRADEMARKS.

SECTION.

11789. Who may adopt a trademark and how.
11790. Penalty for counterfeiting trademarks.
11791. Penalty for using false die, brand, etc.
11792. Penalty for keeping or selling goods with false brand.
11793. Penalty for affixing false labels, etc., with intent to defraud.
11794. What courts have jurisdiction.
11795. Articles bearing false trademarks to be destroyed.
11796. What evidence shall not be used in criminal prosecutions.

SECTION 11789. WHO MAY ADOPT A TRADEMARK AND HOW. If any mechanic, manufacturer, association or union of workingmen, or other person, shall wish to adopt any particular name, term, design or device as his or their trademark, to designate, make known or distinguish any article of goods, wares or merchandise by him or them manufactured or prepared, or any union of workingmen desiring to designate or make known the place in which union labor is employed, he or they may write out a description of such name, term, design or device,

describing the same accurately, and sign and acknowledge the same before some officer competent to take the acknowledgment of deeds, and file the same, together with a fac-simile of the name, term, design or device for registration in the office of the Secretary of State; said Secretary shall deliver to such mechanic, manufacturer, association or union of workingmen or other persons so filing the same, a duly attested certificate of the filing of the same, for which he shall receive a fee of one dollar; such certificate shall in all suits and prosecutions under this chapter, be sufficient proof of the adoption of such label, trademark or form of advertisement, and of the right of such mechanic, manufacturer, association or union of workingmen or other persons to adopt the same. No label, trademark or form of advertisement shall be registered that in any way resembles, or would probably be mistaken for a label or trademark already registered; and no trademark duly registered in the office of the Commissioner of Patents of the United States shall be registered under this section by any person other than the owner thereof. As amended March 27, 1913 (Laws, 1913, p. 764), and March 22, 1915 (Laws, 1915, p. 404).

Note.—The amendment of sec. 11789 by the Act of March 18, 1913, substituted $5.00 as the registration fee (Laws, 1913, p. 763). That amendment was repealed, though not in express terms, by the Act of March 27, 1913 (Laws, 1913, p. 764), which restored the fee of $1.00, and that fee is now charged by the Secretary of State.

Section 11790. Penalty for counterfeiting trademarks. Any person or persons, association or union of workingmen, who shall knowingly and wilfully make, forge or counterfeit any representation, likeness, similitude, copy or imitation of the private label, stamp, brand, wrapper, engraving, mold or trademark usually affixed by any manufacturer, mechanic, merchant, tradesman, druggist, person or body corporate, association or union of workingmen, or body politic to, upon or used in connection with the goods, wares, merchandise, compound or preparation of such manufacturer, mechanic, merchant, tradesman, druggist, person, association or union of workingmen, body corporate or politic, with intent to pass off any goods, wares, merchandise, compound or preparation, to which said

forged or counterfeit representation, likeness, similitude, copy or imitation is affixed, or in connection with which the same may be used or intended to be so affixed or used, as the work, goods, wares, implements, merchandise, compound or preparation of such manufacturer, mechanic, merchant, druggist, tradesman, person, association or union of workingmen, or body corporate or politic, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for a period of not less than three months nor more than twelve months, or fined not less than one hundred dollars nor more than five thousand dollars, or both such fine and imprisonment. (R. S. 1899, sec. 10366.)

SECTION 11791. PENALTY FOR USING FALSE DIE, BRAND, ETC. Any person or persons, association or union of workingmen, who shall, with intent to defraud any person or persons, or body corporate or politic, have in his, her or their possession any die or dies, plate or plates, brand or brands, engraving or engravings, printed labels, stamps, imprints, molds, wrappers or trademarks, or any representation, likeness, similitude, copy or imitation of the private label, brand, stamp or wrapper, engraving, mold or trademark usually affixed by any manufacturer, mechanic, merchant, tradesman, druggist, association or union of workingmen, person or body corporate or politic, to, upon or used in connection with articles made, manufactured, prepared or compounded by him, her or them, for the purpose of making impressions, or selling the same when made, or using the same upon or in connection with any other article made, manufactured, prepared or compounded, and passing the same off upon the community as the original goods, wares, implements, merchandise, compound or preparation of any other person or persons, association or union of workingmen, or body corporate or politic, or who shall in fact sell or use the same, or for the purpose of secreting the same from the rightful owner or owners, or who shall wrongfully or fraudulently use the genuine label, brand, stamp, wrapper, imprint, engraving, mold or trademark, with intent to pass off any goods, wares, implements, merchandise, compound or preparation, or other article not the manufacture of the person, persons, association or union of workingmen, or body corporate or politic, to whom

such label, brand, stamp, wrapper, engraving, imprint, mold or trademark properly belongs, as genuine and original, shall, upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail not less than three months nor more than twelve months, or fined not less than one hundred dollars nor more than five thousand dollars, or both such fine and imprisonment. (R. S. 1899, sec. 10367.)

SECTION 11792. PENALTY FOR KEEPING OR SELLING GOODS WITH FALSE BRANDS. Any person, persons, association or union of workingmen, or body corporate or politic, who shall vend or keep for sale any goods, wares, merchandise, compounds or preparations upon which or in connection with which any forged, imitation or counterfeit label, brand, stamp, wrapper, imprint, engraving, bottle or trademark shall be placed, affixed or used, and intended to represent the said goods, wares, implements, merchandise, compounds or preparations as the genuine goods, wares, implements, merchandise, compound or preparation of any other person or persons, association or union of workingmen, or body corporate or politic, knowing the same to be imitation or counterfeit, shall be deemed guilty of a misdemeanor, and, upon conviction thereof, shall be punished by a fine or not less than one hundred dollars nor more than five thousand dollars, or by imprisonment in the county jail not less than one month nor more than twelve months, or both, and shall also be liable to a civil action to the person or persons, association or union of workingmen, or body corporate or politic, whose goods, wares, implements, merchandise, compounds or preparations is imitated or counterfeited, or whose label, stamp, wrapper, engraving, imprint, bottle, or trademark is imitated, forged or counterfeited, placed, affixed or used, for all damages such person or persons, association or union of workingmen, or body corporate or politic, may or shall sustain, both by virtue of the loss of profits and the damage done to the reputation of the said genuine article, goods, wares, implements, merchandise, compound or preparation, by reason of any of the acts in any section of this chapter mentioned, and may be restrained or enjoined by any court of competent jurisdiction from doing or performing any of the acts herein mentioned. (R. S. 1899, sec. 10368.)

SECTION 11793. PENALTY FOR AFFIXING FALSE LABELS, ETC., WITH INTENT TO DEFRAUD. Any person or persons who shall, with intent to defraud any person or persons, association or union of workingmen, or body corporate or politic, knowingly affix or cause to be affixed to or upon any case, box, web, package or bottle containing any goods, wares, merchandise, compound or preparation, any label, brand, stamp, wrapper, engraving, imprint or mark which shall designate such goods, wares, merchandise, compound or preparation, either wholly or in part by a word or words, or by general design, which shall be wholly or in part the same to the eye, or in sound to the ear, as the word or words or the general design used by any person or persons, association or union of workingmen, or body corporate or politic, for designing any goods, wares, merchandise, compound or preparation, manufactured or prepared by or for some other person or persons, association or union of workingmen, or body corporate or politic, or who shall knowingly sell or expose or offer for sale any such case, box, web, package, or bottle, with any such label, brand, stamp, wrapper, engraving, imprint or mark affixed to or upon it, shall, provided such person or persons affixing or causing to be affixed any such label, brand, stamp, wrapper, engraving, imprint or mark or so selling or offering for sale any such case, box, web, package or bottle, shall not have been the first to employ or use such word or words or general design to designate, wholly or in part, any goods, wares, merchandise, compound or preparation, and upon conviction thereof be deemed guilty of a misdemeanor, and shall be liable to the party aggrieved in the penal sum of five hundred dollars, and for a further sum equal to the amount which the aggrieved party might have received for the same amount of genuine goods, wares, merchandise, compounds or preparations, and shall be guilty of a misdemeanor, and on conviction may be punished by imprisonment in the county jail for a period of not less than one month nor more than twelve months or fined not less than one hundred dollars, nor more than five thousand dollars, or both such fine and imprisonment. (R. S. 1899, sec. 10369.)

SECTION 11794. WHAT COURTS HAVE JURISDICTION. All courts of this state having jurisdiction of criminal cases shall have

jurisdiction of proceedings for violation of this chapter. All suits brought under this chapter shall be brought by the person or persons injured or defrauded by such parties; and if brought by any association or union of workingmen, the suit may be brought in the name of the president and secretary, to the use and benefit of association or corporation, and may thus sue and be sued. (R. S. 1899, sec. 10370.)

SECTION 11795. ARTICLES BEARING FALSE TRADEMARKS TO BE DESTROYED. It shall be the duty of any officer within the jurisdiction of the court having authority, to whom there shall be delivered any warrant for the arrest of any person alleged to have committed any offense created by this chapter, to seize any and all goods, wares, merchandise, compounds, preparations, labels, brands, implements, stamps, wrappers, imprints, engravings, plates, bottles, dies or molds, mentioned or referred to in the complaint, or affidavit or information, upon which said warrant issued, and upon final conviction of the offender, the court shall direct such of same as may be counterfeit to be destroyed, and they shall be so destroyed accordingly: *Provided, however,* That if said property consists of wares and merchandise, which, in the judgment of the court, are independent of any trademark, of genuine and intrinsic value, and capable of being applied to a useful and beneficial purpose, then and in such case all counterfeit words, marks, wrappers, labels, emblems, stamps, brands, bottles, imprints and signs used in connection therewith shall be first erased, obliterated and destroyed, and said property shall be sold within ten days next succeeding the decision of the court thereon, in such manner as the court shall direct, and the proceeds of said sale, less the expense thereof, be applied to the benefit of the school fund of the county in which said seizure was effected. (R. S. 1899, sec. 10371.)

SECTION 11796. WHAT EVIDENCE SHALL NOT BE USED IN CRIMINAL PROSECUTIONS. No testimony or evidence given by any person in any civil action to which said person may be a party, or by any other witness in such action, or in any reference or proceeding which may be had in such action, nor any testimony or evidence derived from the books or papers of such party or witness, or otherwise, in such action, or in any reference or other

proceeding which may be had therein, can or shall be asked in any criminal prosecution against such party or witness, under any of the provisions of this chapter, nor shall any party or witness refuse to testify or furnish evidence in any civil action by reason of any of the provisions of this chapter. (R. S. 1899, sec. 10372.)

SECTION 11796a. Any person or persons, employer, association who shall knowingly and wilfully keep or display in his business any union card or label without a contract with such union for the use of its union card or label, or who shall refuse to return said card or label at the expiration of such contract with such union, or who shall display such union card or label in his place of business wherein he does not employ members of such union or who shall knowingly and wilfully make, forge or counterfeit any representation, likeness, copy or imitation of the private card or label adopted by any union of workingmen, who shall knowingly display in his place of business any such forged, counterfeit, likeness, copy of imitation of the private card or label or trademark adopted by any union of workingmen upon conviction thereof, be deemed guilty of a misdemeanor, and shall be punished by imprisonment in the county jail for a period of not less than three months nor more than twelve months, or fined not less than one hundred dollars nor more than five hundred dollars, or both such fines and imprisonment. (Approved March 22, 1915.)

SECTION 2534. REMEDY BY INJUNCTION TO EXIST, IN WHAT CASES—PROHIBITION. The remedy by writ of injunction or prohibition shall exist in all cases where a cloud would be put on the title of real estate being sold under an execution against a person, partnership or corporation having no interest in such real estate subject to execution at the time of sale, or an irreparable injury to real or personal property is threatened, and to prevent the doing of any legal wrong whatever, whenever in the opinion of the court an adequate remedy can not be afforded by an action for damages.

Under this section it has been held that damages are recoverable in an action for unfair competition. *Joseph S. Baum Merc. Co. v. Levin* (Mo. App.), 174 S. W. Rep. 442.

Sections 4829-4833, Revised Statutes 1909, provide for the protection of boxes and other receptacles, used by manufacturers of bottles, bottlers, manufacturers of and dealers in mineral waters, soda waters, and other beverages, the description of the names, marks, or designations to be recorded with the recorder of deeds of the county or city. Sec. 4833 contains provisions for search warrants in such cases.

Under sec. 11793 an information which sets out and contains a copy of the defendant's label, and of the label which the defendant's label is alleged to imitate, and which alleges that the defendant's label imitates the other "in part," but does not state what part of the one is an imitation of the other, is fatally defective. *State v. Thierauf*, 167 Mo. 429, 67 S. W. Rep. 292; *State v. Bick*, 167 Mo. 272.

An information in a prosecution for selling cigars in boxes bearing a counterfeit union label, in which a genuine union label was pasted, was approved in *State v. Niesmann*, 101 Mo. App. 507, 74 S. W. Rep. 638.

An Act of 1893, for the protection of union labels has been held not to be in violation of article IV, sec. 53, of the Constitution of Missouri; and that to sustain a conviction, guilty knowledge by the defendant must be shown. *State v. Bishop*, 128 Mo. 373, 31 S. W. Rep. 9.

The early act against counterfeiting trademarks (Wag. St., p. 1330) was held to be designed for the protection of trademarks, regardless of the citizenship of their owners. It might, therefore, be invoked in a prosecution based upon a trademark owned by a citizen of another country. *State v. Gibbs*, 56 Mo. 133.

That a union label was used as a device or trademark for selling and delivering cards by a party who had no right to use it, such party was liable to prosecution and punishment under this section, see *State v. St. Clair*, 137 Mo. App. 183.

That the words "or other beverage," as used in sec. 4829, refer to beverages known as "mineral water" or "soda water," see *State v. Dinnisse*, 109 Mo. 434; *State v. Baskowitz*, 156 S. W. Rep. 945.

FORM OF APPLICATION FOR REGISTRATION OF TRADEMARK.

FORM FOR CORPORATIONS.

Know all men by these presents:

That the ———, a corporation duly organized and existing under the laws of the State of ———, and having its office in the City of ———, said State, desiring to avail itself of the provisions of chapter 120,

Revised Statutes of 1909, and more particularly of sec. 11789 thereof, has adopted for its use a trademark to designate, make known or distinguish a certain article of goods, ware or merchandise by it manufactured or prepared, of which the following is a description:

———, the essential feature ——— of which ——— the ———, as applied to ———; and that the fac-similes presented herewith are true and correct copies thereof.

In testimony whereof, the said corporation has caused this instrument to be signed by its ——— and the seal of said corporation to be hereto attached, at the City of ———, State of ———, this ——— day of ———, 19—.

[Seal.] ——— ———,

[*President or other duly authorized officer.*]

State of ——— ———,

County of ——— ———, ss:

On this ——— day of ———, 19—, before me appeared ———, to me personally known, who, being by me duly sworn did say that he is the ——— of the said ———, a corporation, and that the seal affixed to the foregoing instrument is the corporate seal of said corporation, and that said instrument was signed and sealed in behalf of said corporation by authority of its board of directors, and said ——— acknowledged said instrument to be the free act and deed of said corporation, for the purpose therein stated.

In testimony whereof, I have hereunto set my hand and affixed my seal at my office in the City of ——— the day and year last above written.

My commission expires ———. ——— ———,

Notary Public.

FORM FOR INDIVIDUALS OR PARTNERSHIPS.

Know all men by these presents:

That I, ———, residing in the City of ———, State of ———, have adopted for my use a trademark to designate, make known or distinguish a certain article of goods, wares or merchandise by me manufactured or prepared, of which the following is a description:

——— the essential feature ——— of which ——— the ———, as applied to ———; and that the fac-similes presented herewith are true and correct copies thereof.

In testimony whereof, I have hereunto set my hand at the City of ———, State of ———, this ——— day of ———, 19—.

——— ———.

State of ——— ———,

County of ——— ———, ss:

On this ——— day of ———, 19—, before me personally appeared ———, to me known to be the person described in and who executed

the foregoing instrument, and acknowledged that he executed the same as his free act and deed.

In testimony whereof, I have hereunto set my hand and affixed my seal at my office in the City of ——— the day and year last above written.

My commission expires ———. ——— ———,

Notary Public.

NOTE—The application for registration *must be executed in duplicate. In other words, two originals. Fac-simile of trademark to be used attached.* Fee, $1.00.

MONTANA.

POLITICAL CODE.

SECTION 2037. Any person may record any trademark or name, by filing with the Secretary of State his claim to the same, and a copy or description of such trademark or name, with his affidavit attached thereto, certified to by an officer authorized to take acknowledgments of conveyances, setting forth that he or the firm or corporation of which he is a member, is the exclusive owner, or agent of the owner of such trademark or name.

SECTION 2038. The Secretary of State must keep for public examination a record of all trademarks or names filed in his office, with the date when filed and the name of the claimant, and must not record any two like trademarks or names. He must, at the time of filing and recording a trademark or name, collect from the claimant a fee of three dollars. Approved February 25, 1899.

PENAL CODE.

SECTION 642. Every person who shall use any counterfeit or imitate any label, trademark or form of advertisement of any such person, union or association, knowing the same to be counterfeit or imitation, shall be guilty of a misdemeanor. (Sec. 642, Act approved March 6, 1895.)

SECTION 643. Every such person, association or union that heretofore adopted, or shall hereafter adopt, a label, trademark or form of advertisement as aforesaid may file the same for record in the office of the Secretary of State, by leaving two

copies, counterparts or fac-similes thereof with the Secretary of State; said Secretary shall deliver to such person, association or union filing the same a duly attested certificate of the record of the same, for which he shall receive a fee of one dollar. Such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark or form of advertisement, and of the right of said person, association or union to adopt the same. No label shall be recorded, that, probably, would be mistaken for a label already of record. (Sec. 643. Act approved March 6, 1895.)

NEBRASKA.

Compiled Statutes 1901.

SECTION 6810. If any person shall falsely make, alter, forge, counterfeit, print or photograph * * * any private stamp, brand, wrapper, label, or trademark, usually affixed by any mechanic, manufacturer, druggist, merchant, or tradesman to or upon the goods, wares, merchandise, preparation or mixture of such mechanic, manufacturer, druggist, merchant, or tradesman; * * * with intent to damage or defraud any person or persons, body politic or corporate, or any military body organized under the laws of this state; or shall utter or publish as true and genuine, or cause to be uttered and published as genuine and true, and shall have in his possession with intent to utter and publish as true and genuine, any of the above named false, altered, forged, counterfeited, falsely printed, or photographed matter above specified and described, knowing the same to be false, altered, forged, counterfeited, falsely printed, or photographed, with intent to prejudice, damage or defraud any person or persons, body politic or corporate. Every person so offending shall be imprisoned in the penitentiary for any space of time not exceeding twenty years nor less than one year, and pay fine not exceeding five hundred dollars.

SECTION 6811. If any person shall have in his possession any die or dies, plate or plates, brand or brands, engraving, imprint, printed labels, wrappers, or any other instrument, thing or means whatever with intent therewith or thereby to falsely make, forge, or counterfeit any matter specified in the last preceding

section, or to cause or enable the same to be done; or shall have in his possession any such falsely made, forged, or counterfeited matter whether the same be completed or only partly executed, for the purpose of bartering, selling, or disposing thereof, knowing the same to be falsely made, forged or counterfeited, with intent thereby to prejudice, damage or defraud any person or persons, body politic or corporate, every person so offending shall be imprisoned in the penitentiary not less than six months nor more than ten years, and pay a fine not exceeding one thousand dollars.

SECTION 6814. Any person who shall vend or keep for sale any goods, merchandise, mixture or preparation, upon which any forged or counterfeit stamps, brands, imprints, wrappers, labels, or trademarks be placed or affixed, and intended to represent the said goods, merchandise, mixture or preparation, as the true and genuine goods, merchandise, mixture or preparation of any person or persons, knowing the same to be counterfeit, shall be punished by a fine not exceeding one hundred dollars.

Sections 6922, 6926, are directed to the protection of casks, barrels, kegs, bottles and boxes, used in the handling of soda water, mineral water and other beverages.

Sections 3549, 3553, relate to the protection of the labels of trade unions and their registration with the Secretary of State.

FORM OF APPLICATION FOR REGISTRATION.

Certificate accompanying a trademark or label, filed in accordance with the provisions of the laws of the State of Nebraska.

The said trademark or label has been or is intended to be appropriated for use in connection with ———.

The size and style of type and the color of ink and material on which the same is used may be varied at pleasure. It is usually applied by painting or stenciling, or by labels, or by forming it in, or on castings ———. It is also used in advertisements, on letter heads, in invoices and in other printed matter.

The said trademark or label has been in use since ———, and consists of the arbitrarily selected mark or character herewith illustrated:

———.

I, ———, do hereby declare that the *fac-similes*, copies or counterparts filed with the foregoing certificate are true and correct.

In witness whereof, I have hereunto signed my name this ——— day of ———, 19—.

State of ——— ———,
County of ——— ———, ss:

———, being first duly sworn deposes and says that the matters and facts above stated are true as he verily believes.

Witness my hand and seal this ——— day of ———, 19—.

——— ———,
——— ———.

NEVADA.

AN ACT to protect persons, associations and unions of workingmen and others in their labels, trademarks and forms of advertising and to provide a penalty for the violation of the provisions of this act.

(Approved March 29, 1907.)

The people of the State of Nevada, represented in Senate and Assembly, do enact as follows:

SECTION 1. (TRADE FILING.) Every person or association or union of workingmen or others that has adopted or shall adopt for their protection, any label, trademark or form of advertisement, may file the same for record in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof with the Secretary of State. Said Secretary shall thereupon deliver to such persons, association or union so filing the same, a duly attested certificate of the record of same, for which he shall receive a fee of five ($5.00) dollars. Such certificate of record shall, in all actions and prosecutions under the following three sections, be sufficient proof of the adoption of such label, trademark or form of advertisement, and the right of said person association or union to adopt the same.

SECTION 2. (SAME; EXCLUSIVE USE; DAMAGES.) Every person, association or union adopting a label, trademark, or form of advertisement, as specified in the preceding section, may proceed by action to enjoin the manufacture, use, display or sale of any counterfeit or imitation thereof; and all courts having jurisdiction of such actions shall grant injunctions to restrain such manufacture, use, display or sale and a reasonable attorney's fee, to be fixed by the court, and shall require the defendant to pay to such persons, association or union the profits derived from such wrongful manufacture, use, display or sale.

and a reasonable attorney's fee, to be fixed by the court, and said court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case to be delivered to an officer of the court to be destroyed. Such actions may be prosecuted for the benefit of any association or union by any officers or members thereof.

SECTION 3. (SAME. COUNTERFEITING.) It shall be unlawful for any person or corporation to imitate any label, trademark or form of advertisement adopted as provided in the second preceding section, or to knowingly use any counterfeit or imitation thereof, or to use or display such genuine label, trademark or form of advertisement or the name or seal of such person, union, or association or of any officer thereof, unless authorized so to do, or in any manner not authorized by him or it. Any person violating any provisions of this section shall be imprisoned in the county jail not more than thirty days, or be fined not less than twenty-five nor more than one hundred dollars.

NEW HAMPSHIRE.

AN ACT relating to the Use of Trademarks and Names.

Be it enacted by the Senate and House of Representatives in General Court convened:

SECTION 1. Persons engaged in buying, selling, or dealing in milk or cream in cans or bottles, or bottling or selling beverages in bottles or vessels with their name and the word "registered" branded, engraved, blown or otherwise produced thereon, or on the boxes used by them, may file in the office of the clerk of the city or town in which their principal place of business is situated, and also in the office of the Secretary of State, a description of the name so used by them, and shall publish such description once in each of four successive weeks in a newspaper, if any, published in the city or town in which said description has been filed, otherwise, in a newspaper published in the county in which said city or town is situated.

SECTION 2. Whoever fills with milk, cream, or any manufactured beverage, with intent to sell the same, any bottle, can, or

vessel, marked or distinguished as aforesaid, the description of which has been filed and published as provided in the preceding section, or defaces, erases, covers up or otherwise removes or conceals any such name, or the word "registered" thereon, or sells, buys, gives, takes, or otherwise disposes of, or traffics in the same, without the written consent of, or unless the same has been purchased from the person whose name is in or upon the can, bottle or vessel so filled, defaced, trafficked in or otherwise used or disposed of shall, for the first offense, be punished by a fine of fifty cents for each such can, bottle, or vessel, or by imprisonment for not less than ten days nor more than one year, or by both such fine and imprisonment; and for each subsequent offense, by a fine of not less than one dollar nor more than five dollars for each such vessel, or by imprisonment for not less than twenty days nor more than one year.

SECTION 3. The use by any person engaged in selling milk or cream, or in manufacturing, bottling or selling beverages, of a bottle, can, or vessel, marked or distinguished as aforesaid, the description of which has been filed and published as provided in section 1, without the written consent of, or purchase from, the owner thereof, or the buying, selling, disposing of or trafficking in such bottles, cans, or vessels by such persons without such written consent or purchase, or the possession by any junk dealer or dealer in second-hand articles of any such bottles, cans, or vessels, without the written consent of or purchase from, the owner thereof, shall be prima facie evidence of unlawful use, possession of or traffic in the same.

SECTION 4. Upon complaint of a person who has complied with the provisions of section 1, or his agent, to the justice of a police court, or to a justice of the peace in a town which has no police court, that he has reason to believe and does believe that any of his bottles, cans, or vessels, marked or distinguished as provided in said section, the description of the name, on which with the word "registered," has been filed and published as provided in said section, are being unlawfully used or filled by a person engaged in buying, selling or dealing in milk or cream, or in manufacturing, bottling, or selling beverages, or

that a junk dealer or dealer in second-hand articles, or a vendor of cans or bottles, has any such cans, bottles, or vessels in his possession, or secreted in any place, said justice may thereupon issue a search warrant; and may also cause the person in whose possession such cans, bottles, or vessels are found, to be brought before him, and shall thereupon inquire into the circumstances of such possession; and shall award possession of the property taken upon such search warrant to the owner thereof.

SECTION 5. All acts and parts of acts inconsistent herewith are hereby repealed, and this act shall take effect upon its passage. Approved April 2, 1903.

FORM OF APPLICATION.

To the honorable, the Secretary of State:

Sworn application accompanying a ———.

Be it known, That ———, ha— heretofore adopted and used a certain ———, and herewith files the same for record in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof, with said Secretary, and by filing therewith this sworn application.

(1) The name— of the person— so filing such ——— is ———.

(2) The class of merchandise upon which the same has been used is ——— and a particular description of the goods comprised in such class is ———.

(3) Said ——— has been used by applicant since ———.

(4) Said ——— is as follows: ——— and consists of ——— the essential feature of which ———.

State of ——— ———,
County of ——— ———, ss:

I, ———, being first duly sworn, depose and say that I am ——— the applicant herein, and make this affidavit and verification in ——— behalf. That I have read the above and foregoing application and know the contents thereof, and that the facts set out therein are true; that said ——— so filing said ——— has the right to the use of the same and that no other person, firm, association, union, corporation or organization has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the two copies, counterparts or fac-similes, filed herewith, are true and correct.

——— [*Sign here*].

Subscribed and sworn to before me this ——— day of ———, 19—.

——— ———,
——— ———.

Fee, $1.00, enclosed.

NEW JERSEY.

Laws 1898. Chapter 50.

AN ACT to provide for the registration of labels, trademarks, terms and designs, and protect and secure the rights, property and interests therein of the persons, associations, organizations and corporations adopting and filing the same.

Be it enacted by the Senate and General Assembly of the State of New Jersey:

SECTION 1. It shall be lawful for any person, association, organization or corporation to adopt for their protection and file for registry, or cause to be filed for registry, as herein provided, any label, trademark, term or design that has been used or is intended to be used for the purpose of designating, making known or distinguishing any goods, wares, merchandise or products of labor that have been or may be wholly or partly made, manufactured, produced, prepared, packed or put on sale by any person, association, organization or corporation, or to or upon which any work or labor has been applied or expended by any person or by any member or members of any association, organization or corporation that has adopted and filed for registry, or that may adopt and file for registry, any such label, trademark, term, or design as aforesaid, or announcing or indicating that the same have been made, in whole or in part, by any such person, association, organization or corporation or by any member or members thereof.

SECTION 2. Whenever any person, association, organization or corporation shall adopt and file for registry, or cause to be adopted and filed for registry, any label, trademark, term, or design pursuant to the provisions of this act, the property, privileges, rights, remedies and interests in and to any such label, trademark, term or design, and in and to the use of the same, provided or given by this act to, or otherwise conferred upon or enjoyed by, the person, association, organization or corporation filing the same, or causing the same to be filed for registry shall be fully and completely secured, preserved and protected as the property of those entitled to the same, before any such

label, trademark, term or design has been actually applied to any goods, wares, merchandise or product of labor and put upon the market, for sale or otherwise, and before any use or appropriation of any such label, trademark, term or design has been made in connection with any such goods, wares, merchandise or product of labor, as well as after the same has been used or applied to designate, make known or distinguish any such goods, wares, merchandise or product of labor and they have been put upon the market.

SECTION 3. Any person, association, organization or corporation that has heretofore adopted and used, or shall hereafter adopt and use, any label, trademark, term or design as herein provided, may file the same for registry in the office of the Secretary of State by leaving two copies, fac-similes or counterparts thereof, with the said Secretary, and filing therewith a statement in the form of an affidavit, subscribed and sworn to by any such person, or by any officer, agent or attorney of any such association, organization or corporation, specifying the person, association, organization or corporation by whom, or on whose behalf, any such label, trademark, term or design is filed, and the class or character of the goods, wares, merchandise or product of labor to which the same has been, or is intended to be, appropriated or applied, and that the person, association, organization or corporation so filing the same, or on whose behalf the same is so filed, has the right to the use of said label, trademark, term or design, and that no other person, firm, association, organization or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, without the permission or authority of the person, association, organization or corporation filing the same, or causing the same to be filed, and that the copies, fac-similes or counterparts filed therewith are true and correct copies, fac-similes or counterparts of the genuine label, trademark, term or design of the person, association, organization or corporation filing the same or causing the same to be filed; and there shall be paid for such filing and registry a fee of one dollar to the Secretary of State for the use of the state.

SECTION 4. The Secretary of State, upon the filing of any such label, trademark, term, or design that is not in conflict with the next section hereof, shall register the same, and shall deliver to the person, association, organization or corporation filing the same, or causing the same to be filed, as many certified copies thereof, with his certificate of such registry, as any such person, association, organization or corporation may request, and for every such copy and certificate there shall be paid to the Secretary of State, for the use of the state, a fee of one dollar; and any such certified copy and certificate shall be admissible in evidence and competent and sufficient proof of the adoption, filing and registry of any such label, trademark, term or design by any such person, association, organization or corporation, in any action or judicial proceeding in any of the courts of this state, and of due compliance with the provisions of this act; *Provided, however*, that such certificate shall not be assignable or transferable by the person, association, organization or corporation to whom the same is issued by the Secretary of State.

SECTION 5. It shall not be lawful for the Secretary of State to register, or permit to be registered, for any person, association, organization or corporation any label, trademark, term or design that is in the identical form of any other label, trademark, term or design theretofore filed by or on behalf of any other person, association, organization or corporation, or that bears any such near resemblance thereto as may be calculated to deceive, or that would be liable to be mistaken therefor; and any person, association, organization or corporation who shall file or procure the filing and registry of any label, trademark, term or design in the office of the Secretary of State, under the provisions of this act, by making any false or fraudulent representations or declarations, with fraudulent intent, shall be liable to pay any damages sustained in consequence of any such registry, to be recovered by or on behalf of the party injured thereby in any court of law of this state having jurisdiction in civil causes.

SECTION 6. Whenever any person, association, organization or corporation has heretofore adopted and filed for record or

registry, or shall hereafter adopt and file for registry, any label, trademark, term or design, or cause the same to be done, as herein provided, and the same shall have been registered pursuant to this act, it shall be unlawful, and a violation of this act, for any other person, association, organization or corporation to manufacture, use, sell, offer for sale, or in any way utter or circulate, any counterfeit or imitation of any such label, trademark, term or design; or have in possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or product of labor to which or on which any counterfeit or imitation of any such label, trademark, term or design is attached, affixed, printed, painted, stamped, impressed or displayed; or to sell or dispose of, or offer to sell or dispose of, or have in possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise or product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, impressed or displayed.

SECTION 7. Whenever any person, association, organization or corporation has heretofore adopted and filed for record or registry, or shall hereafter adopt and file for registry, any label, trademark, term or design as herein provided, it shall be unlawful, and a violation of this act, for any other person or persons, association, organization or corporation, to make any use, sale, offer for sale or display of the genuine label, trademark, term or design of any such person, association, organization or corporation, filing the same; or to have any such genuine label, trademark, term or design in possession with intent that the same shall be used, sold, offered for sale or displayed, or that the same shall be applied, attached or displayed in any manner whatever to or on any goods, wares or merchandise; or to sell, offer to sell, or dispose of or have in possession, with intent that the same shall be sold or disposed of, any goods, wares or merchandise in any box, case, can or package to or on which any such genuine label, trademark, term or design of any such person, association, organization or corporation is attached, affixed or displayed; or to make any use whatever of any such genuine label, trademark, term or design, without first obtain-

ing in every such case, the license, consent of authority of the person, association, organization or corporation adopting, filing and registering the same, or causing the same to be adopted, filed and registered; and any such license, consent or authority may be revoked and terminated at any time upon notice, and thereafter any use thereof shall be a violation of this act, and subject those violating the same to all the liabilities and penalties herein provided against any violation thereof.

Section 8. It shall be lawful for any person, association, organization or corporation that has adopted and filed, or caused to be filed and recorded or registered in the office of the Secretary of State, at any time before the passage of this act, any label, trademark, term or design, to refile the same for registration by the Secretary of State pursuant to the provisions of this act, upon payment of the fees herein provided for filing and registering any label, trademark, term or design, and for copies and certificates thereof, and any person, association, organization or corporation so refiling any such label, trademark, term or design shall have and be entitled to all the rights, remedies, privileges and protection given by this act to any person, association, organization or corporation originally filing any label, trademark, term or design under the provisions of this act and subject to the same liabilities.

Section 9. The court of chancery shall have jurisdiction in all cases arising or commenced therein under this act for the violation of any of the provisions thereof; and any person, association, organization or corporation filing, or causing to be filed, for registry, any label, trademark, term or design pursuant to the provisions of this act, shall have the right to an action in the said court against any person or persons, association, organization or corporations, for the violation of any of the provisions of this act; and upon the filing of any bill of complaint therefor, the law and practice regulating proceedings in that court shall be applicable thereto; and the said court is hereby empowered and required to enjoin the manufacture, counterfeiting, imitation, display, use, sale, offer of sale, circulating or uttering of any counterfeit or imitation of any such label, trademark, term or design of any such person,

association, organization or corporation; and the sale or disposal of any goods, wares, merchandise or product of labor to which, or on which, any such counterfeit or imitation label, trademark, term or design is attached, affixed, printed, painted, stamped, impressed or displayed; or any goods, wares, merchandise or product of labor contained in any box, case, can or package to or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, impressed or displayed; and further to enjoin the manufacture, use, sale, offer of sale, or display, of any genuine label, trademark, term or design of any such person, association, organization or corporation filing the same as aforesaid; or having in possession any such genuine label, trademark, term or design, with intent that the same shall be used, sold, offered for sale or displayed, or the same applied, attached or displayed in any manner whatever to or on any goods, wares, merchandise or product of labor; or the selling or offer to sell or dispose of, or having in possession, with intent that the same shall be sold, offered for sale or disposed of, any goods, wares or merchandise in any box, case, can or package to or on which any such genuine label, trademark, term or design of any such person, association, organization or corporation is attached, affixed or displayed; and from making any other, or any, use whatever of any such genuine label, trademark, term or design, without having first obtained, in any and every such case, the consent and authority of the person, association, organization or corporation adopting, filing and registering the same, or causing the same to be filed and registered, as herein provided; and the said court of chancery is hereby empowered to make such other orders and direct such other proceedings as the court may deem necessary and proper for the due protection of the rights of complainants, effecting the purposes of this act, the prevention of any violation of any of the provisions of the same; and secure and protect any and all persons, associations, organizations or corporations in all the rights, privileges, property and interests to which they or any of them are or may be entitled in any such label, trademark, term or design under any of the provisions of this act or otherwise; and it shall be the duty of the said court of chancery to award to the complainant or complainants in any

such action any and all damages resulting from any such wrongful use of any such label, trademark, term or design by any defendant or defendants, or for any violation of any of the provisions of this act; and to require any such defendant or defendants to pay to such complainants any and all such damages, together with all costs and expenses incurred by any such complainant in any such action or proceeding; and the said court shall also order and decree that the defendants pay to the complainant or complainants any and all profits obtained, received or derived from any such wrongful use or any violation of the provisions of this act; or both profits and any such damages, and that any and all such counterfeits or imitations of any such labels, trademarks, terms or designs in the possession or under the control of the defendant or defendants in any such action shall be delivered up to an officer of the court, or to the complainant, to be destroyed, and that any such genuine labels, trademarks, terms or designs in the possession or under the control of any such defendant or defendants shall be delivered up to the complainant.

Section 10. That, in addition to any other rights, remedies or penalties provided by this act, and as concurrent therewith, any person or persons, association, organization or corporation that shall violate any of the provisions of this act shall be liable to a penalty of not less than two hundred and not more than five hundred dollars, to be recovered in an action of debt in any court of law of this state having jurisdiction in civil causes, by any such person, association, organization or corporation that has adopted and filed, or caused the same to be done as aforesaid, any such label, trademark, term or design; which action may be commenced by summons as in ordinary cases, and shall be proceeded with therein as ordinary cases in said court; and in case any execution shall be issued upon any judgment obtained against the defendant or defendants in any such action and the same be returned unsatisfied, the court, on application and two days' notice to the defendant, may award an execution to take the body of the defendant or defendants as in other cases where a capias may issue out of the circuit or supreme courts of this state; and thereafter the rights, remedies and liabilities of the parties, and the proceedings in the case shall

be the same, or as nearly as may be, as in other actions in said courts where an execution to take the body of the defendant or defendants has been issued; and it shall be the duty of the court in which any such action may be brought to make all proper and necessary orders to restrain and prevent any defendant or defendants from continuing the committing of any violation of any of the provisions of this act.

SECTION 11. In any suit or proceeding in equity, or in any action at law, brought by or on behalf of any such association or organization that is not incorporated, for any violation of any of the provisions of this act, the same may be brought in the recognized name of any such association or organization, or in the proper name of the president or the secretary or the treasurer of any such association or organization who has been or may be given authority to bring any action or actions for or in behalf of any such association or organization, and if for any reason such authority is not given before the commencement of any such suit or action, the same may be given thereafter at any time before the trial of the same; and any such suit in equity or action at law may be brought as aforesaid in the recognized name of any branch or local sub-association, affiliated or connected with any national or international association or organization, or in the name of the president, or the secretary, or the treasurer thereof; and such authority to bring the same may be given by any board of directors, executive board, or executive committee, of any such association or organization, elected, chosen, or appointed by any such association or organization; and any such person or persons bringing any such action or proceeding in any court of law or equity in this state shall have the right to receive any and all moneys, property or other valuable thing recovered by or adjudged to the complainant or plaintiff in any such suit or action, for the use and benefit of the association or organization entitled to the same; and whenever any such suit or action shall be brought by or on behalf of any such branch or local or sub-association or organization as herein provided instead of by or on behalf of any such national or international association or organization, such branch or local or sub-association bringing the same

shall be entitled to the same rights, privileges, remedies and advantages, in the prosecution of such suit or action, as any other party or parties authorized by this act to bring such suit or action would have been entitled to if any such suit or action had been brought by them, or in their behalf, as herein provided.

SECTION 12. This act shall be construed by all courts at all times, in all suits, actions and proceedings, in the most liberal manner for effecting the objects and purposes thereof and protecting the claims, rights, interests, use and property of every person, association, organization or corporation in and to any label, trademark, term or design, filed and registered pursuant to the provisions of this act.

SECTION 13. All acts and parts of acts contrary to, or inconsistent with the provisions of this act, be and the same are hereby repealed.

SECTION 14. This act shall be deemed and taken to be a public act, and shall take effect immediately.

Passed March 15, 1898.

No official form for application.

ACT OF APRIL 1, 1913.

Laws of 1913, p. 377.

SECTION 1. It shall be unlawful for any merchant, firm or corporation, for the purpose of attracting trade for other goods, to appropriate for his or their own ends a name, brand, trademark, reputation or goodwill of any maker in whose product said merchant, firm or corporation deals, or to discriminate against the same, by depreciating the value of such products in the public mind, or by misrepresentation as to value or quality, or by price inducement, or by unfair discrimination between buyers, or in any other manner whatsoever, except in cases where said goods do not carry any notice prohibiting such practice, and excepting in case of a receiver's sale, or a sale by a concern going out of business.

SECTION 2. Any person, firm or corporation violating this act shall be liable at the suit of the maker of such branded or

trademarked goods, or any other injured person, to an injunction against such practices, and shall be liable in such suit for all damages directly or indirectly caused to the maker by such practices, which said damages may be increased threefold, in the discretion of the court.

SECTION 3. This act shall take effect immediately. Approved April 1, 1913.

That this statute, being in derogation of the common law, must be strictly construed, and can not serve to enforce a mere price restriction affixed to an article of merchandise, see *Ingersoll v. Goldstein* (N. J. Ch.), 93 Atl. Rep. 193.

In an action to recover penalties under sec. 6 of this act it is not necessary to show guilty knowledge by the defendant. *Cigar Makers' International Union of America v. Goldberg*, 57 Atl. Rep. 143. The act is constitutional. *Ibid.*

Section 10 of this act imposing a penalty of not less than two hundred dollars, and not more than five hundred dollars, permits the plaintiff in an action for its recovery to elect and fix the amount for which the suit shall be brought within these limits. *State v. Schmidt*, 48 Atl. Rep. 588.

The Acts passed in 1889, 1892 and 1895, for the protection of the labels, trademarks and forms of advertising of associations or unions of workingmen, were held not to be unconstitutional, and not in violation of article IV, sec. 7, paragraph 11, of the Constitution of New Jersey, forbidding the passage of private, local or special laws, granting to any association, corporation, or individual, any special privilege, immunity, or franchise whatever. *Schmalz v. Wooley*, 57 N. J. Eq. 303, 41 Atl. Rep. 939.

An Act of February 21, 1854, supplemented March 25, 1863, relating to the protection of packages of manufacturers of mineral waters, and other beverages, and prescribing a penalty for the unauthorized use thereof, did not apply to junk dealers who had registered bottles on their premises. *Bowden v. Randolph Tp.*, 41 N. J. Law, 462.

In the Act of March 11, 1891, for the protection of manufacturers and bottlers of mineral waters and the like, several offenses are specified. It has been held, that in a complaint under this act, no statement of demand is required; and that a complaint is defective which charges, in the alternative, the commission of one or another of several of the specified offenses. *Brant v. Froelich*, 49 N. J. Law, 336, 8 Atl. Rep. 283.

NEW MEXICO.

AN ACT providing for the registration of trade-names, trade-marks and labels.

Be it enacted by the Legislative Assembly of the Territory of New Mexico:

SECTION 1. Any person or persons, firm, corporation or association who manufacture or deal in articles of a commercial nature and wish to retain the exclusive right to the use of a trade-name, trade-mark or label, shall make a description of the same in writing, accompanied by a *fac-simile* of such trade-name, trade-mark or label, which description and application must set forth the class or classes of merchandise to be covered by such trade-name, trade-mark or label, together with a statement that the applicant claims by priority of adoption and employment of the same exclusive right to the use thereof. Such instrument shall be signed by at least one of the persons or by the officials of the company making application for registration, the whole duly acknowledged, and filed in the office of the Secretary of the Territory. For the filing of each application and issuing certificate thereof, the secretary shall collect a fee of $5.00. The secretary shall keep a record of each trade-name, trade-mark or label, and it shall be unlawful for any other person, firm, corporation or association to adopt a trade-name, trade-mark or label identical with or similar to one previously registered. A copy of such description of any trade-name, trade-mark or label, certified under the Great Seal of the Territory of New Mexico, shall be *prima facie* evidence of the facts therein stated.

SECTION 2. The proprietor of each trade-name, trade-mark or label shall cause the same to be plainly marked, printed, stamped or branded upon each article or original package covered by the same.

SECTION 3. It shall be unlawful for any person or persons, firm, corporation or association to use or refill any barrel, sack, package or bottle bearing any registered trade-name, trade-mark or label with any article for purposes of deceit.

SECTION 4. It shall be unlawful for any person or persons, firm, corporation or association to make, forge or counterfeit

any trade-name, trade-mark or label previously registered in accordance with this act; have in his or their possession, except with written permission of the owner thereof, any die, stamp, stencil or model of such trade-name, trade-mark or label; vend or keep for sale any drugs, goods, wares or merchandise intended to represent the drugs, goods, wares or merchandise covered by such trade-name, trade-mark or label, or affix any general design identical with or similar to such trade-name, trade-mark or label when not the first to employ or use the same.

SECTION 5. Any person or persons, firm, corporation or association violating the provisions of sections 3 or 4 of this act shall be deemed guilty of misdemeanor and shall be subject to a fine in a sum not less than $50.00 nor more than $200.00 for each offense, at the discretion of the court, together with damages as they may appear.

SECTION 6. The provisions of this act, in so far as they may be applicable, are hereby extended to any person or persons, firm, corporation or association, who may have registered a trade-name, trade-mark or label in good faith prior to the passage of this act, and this act shall be in force and effect from and after its passage.

Chap. 24, Laws 1905. Approved March 2, 1905.

No official form for application.

NEW YORK.

Laws of 1909, chapter 9.

SECTION 48. MANUFACTURER'S BRAND OF CHEESE. Every manufacturer of full-milk cheese may put a brand or label upon such cheese indicating "full-milk cheese" and the date of the month and year when made; and no person shall use such a brand or label upon any cheese made from milk from which any of the cream has been taken. The Commissioner of Agriculture shall procure and issue to the cheese manufacturers of the state, on proper application therefor, and under such regulations as to the custody and use thereof as he may prescribe, a uniform stencil brand or labels bearing a suitable device or motto, and the words "New York state full-cream cheese."

Every such brand or label shall be used upon the outside of the cheese and shall bear a different number for each separate factory. The commissioner shall keep a book, in which shall be registered the name, location and number of each manufactory using the brands or labels, and the name or names of the persons at each manufactory authorized to use the same. No such brand or labels shall be used upon any other than full-milk cheese or packages containing the same.

SECTION 49. USE OF FALSE BRAND PROHIBITED. No person shall offer, sell, or expose for sale, in any package, butter or cheese which is falsely branded or labeled.

SECTION 50. COUNTY TRADEMARKS. At a regular or special meeting of a county dairymen's association in any county of the state there may be adopted a county trade mark, by a majority of the members present and voting, to be used as a trade mark by a person manufacturing pure, unadulterated butter or full-milk cheese in such county. The secretary of the association shall forthwith send to the Commissioner of Agriculture a copy of such trade mark, which copy he shall place on file in his office, noting thereupon the day and hour he received the same. But one county trade mark for butter and for cheese shall be placed on file for the same county. No association shall adopt any trade mark in any county already on file, or use that of any other county in the formation of a trade mark.

SECTION 51. OBJECT AND INTENT OF THIS ARTICLE. This article and each section thereof are declared to be enacted to prevent deception in the sale of dairy products, and to preserve the public health, which is endangered by the manufacture, sale and use of the articles herein regulated or prohibited.

SECTION 52. PENALTIES. Every person violating any of the provisions of this chapter shall forfeit to the people of the state of New York the sum of not less than fifty nor more than one hundred dollars for the first violation and not less than one hundred dollars nor more than two hundred dollars for the second and each subsequent violation. When such violation consists of the manufacture or production of any prohibited article, each day during which or any part of which

such manufacture or production is carried on or continued, shall be deemed a separate violation. When the violation consists of the sale, or the offering or exposing for sale or exchange of any prohibited article or substance, the sale of each one of several packages shall constitute a separate violation, and each day on which any such article or substance is offered or exposed for sale or exchange shall constitute a separate violation. When the use of any such article or substance is prohibited, each day during which or any part of which such article or substance is so used or furnished for use, shall constitute a separate violation, and the furnishing of the same for use to each person to whom the same may be furnished shall constitute a separate violation.

Chapter 25, Laws of 1909, contains the following sections:

SECTION 360. TRADE-MARKS ON BOTTLES, SIPHONS, TINS OR KEGS. Any person or corporation engaged in manufacturing, bottling or selling soda waters, mineral or aërated waters, porter, ale, beer, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer, or other beverages or medicines, medicinal preparations, perfumery, oils, compounds or mixtures, in bottles, siphons, tins or kegs, with his or its name or other marks or devices branded, stamped, engraved, etched, blown, impressed, or otherwise produced upon such bottles, siphons, tins or kegs, or the boxes used by him or it, may file in the office of the clerk of the county in which his or its principal place of business is situated, or if such person or corporation shall manufacture or bottle out of this state, then in any county in this state, and also in the office of the Secretary of State, a description of the name, marks or devices so used by him or it, and cause such description to be printed once in each week, for three weeks successively, in a newspaper published in the county in which said notice may have been filed as aforesaid, except that in the boroughs of Manhattan and Brooklyn in the city of New York, such publication shall be made twice in each week for three weeks successively in two daily newspapers published in such boroughs, respectively, and he shall thereupon be deemed the proprietor of such name, mark or device and of every vessel or receptacle upon which it may be branded, stamped, engraved, etched, blown, impressed or otherwise produced.

SECTION 361. TRADEMARKS ON OTHER ARTICLES. Any person or corporation engaged in manufacturing, freezing, preserving or selling ice cream, confectionery, charlotte russe, cakes and jellies, with his or its name, or other marks or devices, branded, stamped, engraved, stenciled, blown, impressed or otherwise produced upon the freezers, cans, blocks, molds, trays, bricks, pans, tanks, pails, kegs, tubs, refrigerators, boxes, spoons, cutlery, glass, china, chairs, tables or signs used by him or it, may file in the office of the clerk of the county in which his or its principal place of business is located, or if such person or corporation shall manufacture or sell out of this state, then in any county in this state, and also in the office of the Secretary of State, a description of the name or names, marks or devices, so used by him or it, and cause such description to be printed once in each week, for three weeks successively, in a newspaper published in the county in which said notice may have been filed, as aforesaid, except that in the boroughs of Manhattan and Brooklyn in the city of New York, such publication shall be made twice in each week, for three weeks successively, in two daily newspapers published in said boroughs respectively.

SECTION 362. UNLAWFUL USE OF TRADE MARKED ARTICLES. 1. It is hereby declared to be unlawful for any person or corporation to fill with soda waters, mineral or aërated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer or other beverages, or with medicine, medical preparations, perfumery, oils, compounds or mixtures, any bottle, box, siphon, tin or keg so marked or distinguished as aforesaid, with or by any name, mark or device, of which a description shall have been filed and published, as provided in section three hundred and sixty, or to deface, erase, obliterate, cover up or otherwise remove or conceal any such name, mark or device thereon, or to sell, buy, give, take or otherwise dispose of or traffic in the same without the written consent of, or unless the same shall have been purchased from the person or corporation whose mark or device shall be or shall have been in or upon the bottle, box, siphon, tin or keg so filled, trafficked in, used or handled as aforesaid. Any person or corporation offending against the provisions of this subdivision shall be deemed guilty of a misdemeanor, and shall be punished for the

first offense by imprisonment for not less than ten days nor more than one year, or by a fine of fifty cents for each and every such bottle, box, siphon, tin or keg so filled, sold, used, disposed of, bought or trafficked in, or by both such fine and imprisonment, and for each subsequent offense by imprisonment not less than twenty days nor more than one year, or by a fine of not less than one dollar, nor more than five dollars, for each and every bottle, box, siphon, tin or keg so filled, sold, used, disposed of, bought or trafficked in, or by both such fine and imprisonment, in the discretion of the magistrate before whom the offense shall be tried.

2. It is hereby declared to be unlawful for any person or corporation to make use of, for similar or other purposes, any such freezers, cans, blocks, molds, trays, bricks, pans, tanks, pails, kegs, tubs, refrigerators, boxes, spoons, cutlery, glass, china, chairs, tables or signs so marked or distinguished, as aforesaid, with or by any name, mark or device, of which a description shall have been filed and published, as provided in section three hundred and sixty-one, or to deface, erase, obliterate, cover up or otherwise remove or conceal, any such name, mark or device thereon, or to sell, buy, give, take or otherwise dispose of or traffic in the same without the written consent of, or unless the same shall have been purchased from the person or corporation whose mark or device shall be or shall have been in or upon the said freezers, cans, blocks, molds, trays, bricks, pans, tanks, pails, kegs, tubs, refrigerators, boxes, spoons, cutlery, glass, china, chairs, tables or signs trafficked in, used or handled as aforesaid. Any person or corporation offending against the provision of this subdivision, shall be deemed guilty of a misdemeanor, and shall be punished for the first offense by imprisonment not less than ten days nor more than one year, or by a fine of three dollars for each and every such article named and described in section three hundred and sixty-one, sold, used, disposed of, bought or trafficked in, or by both such fine and imprisonment, and for each subsequent offense by imprisonment not less than twenty days nor more than one year, or by a fine of not less than five dollars nor more than ten dollars for each and every such article named and described in said section, sold, used, disposed of, bought or trafficked in, or by both such

fine and imprisonment, in the discretion of the magistrate before whom the offense shall be tried.

SECTION 363. PRESUMPTIVE EVIDENCE OF UNLAWFUL USE. 1. The use by any person, other than the person or corporation whose device, name or mark shall be or shall have been upon the same without such written consent or purchase as aforesaid, of any such marked or distinguished bottle, box, siphon, tin or keg, a description of the name, mark or device, whereon shall have been filed and published, as herein provided, for the sale therein of soda waters, mineral or aërated waters, porter, ale, cider, ginger ale, milk, cream, beer, small beer, lager beer, weiss beer, white beer or other beverages, or any article of merchandise, medicines, medicinal preparations, perfumery, oils, compounds, mixtures or preparations, or for the furnishing of such or similar beverages to customers, or the buying, selling, using, disposing of or trafficking in any such bottles, boxes, siphons, tins or kegs by any person other than said persons or corporations having a name, mark or device thereon of such owner without such written consent, or the having by any junk dealer or dealers in second-hand articles, possession of any such bottles, boxes, siphons, tins or kegs, a description of the marks, names or devices, whereon shall have been so filed and published as aforesaid, without such written consent, shall and is hereby declared to be presumptive evidence of the said unlawful use, purchase and traffic in of such bottles, boxes, siphons, tins or kegs.

2. The use by any person other than the person or corporation whose device, name or mark shall be or shall have been upon the same without such written consent or purchase as aforesaid, of any such article named and described in section three hundred and sixty-one, a description of the name, mark or device whereon shall have been filed and published as herein provided, for similar or other purposes, or the buying, selling, using, disposing of, or trafficking in any such article named and described in said section, by any person other than said persons or corporations having a name, mark or device thereon of such owner, without such written consent, or the having by any junk dealer or dealers in second-hand articles, possession of any such article, named and described in said section,

a description of the marks, names or devices, whereon shall have been so filed and published as aforesaid, without such written consent, shall, and is hereby declared to be presumptive evidence of the said unlawful use or purchase of and traffic in of such freezers, cans, blocks, molds, trays, bricks, pans, tanks, pails, kegs, tubs, refrigerators, boxes, spoons, cutlery, glass, china, chairs, tables or signs.

SECTION 364. SEARCH WARRANT TO DISCOVER TRADE MARKED ARTICLES UNLAWFULLY USED. 1. Whenever any person or corporation mentioned in section three hundred and sixty or his or its agent shall make oath before any magistrate that he or it has reason to believe, and does believe, that any of his or its bottles, boxes, siphons, tins or kegs, a description of the names, marks or devices whereon has been so filed and published as aforesaid, are being unlawfully used or filled, or had, by any person or corporation manufacturing or selling soda, mineral or aërated waters, porter, ale, cider, ginger ale, milk, cream, small beer, lager beer, weiss beer, white beer or other beverages or medicine, medicinal preparations, perfumery, oils, compounds or mixtures, or that any junk dealer or dealers in second-hand articles, vendor of bottles, or any other person or corporation has any such bottles, boxes, siphons, tins or kegs in his or its possession or secreted in any place, the said magistrate must thereupon issue a search warrant to discover and obtain the same, and may also cause to be brought before him the person in whose possession such bottles, boxes, siphons, tins or kegs may be found, and shall then inquire into the circumstances of such possession, and if such magistrate finds that such person has been guilty of a violation of subdivision one of section three hundred and sixty-two, he must impose the punishment herein prescribed, and he shall also award possession of the property taken upon such warrant to the owner thereof.

2. Whenever any person or corporation mentioned in section three hundred and sixty-one or his or its agent shall make oath before any magistrate that he or it has reason to believe, and does believe, that any of his or its freezers, cans, blocks, molds, trays, bricks, pans, tanks, pails, kegs, tubs, refrigerators, boxes, spoons, cutlery, glass, china, chairs, tables or signs, a description of the names, marks or devices whereon has been so filed

and published as aforesaid, are being unlawfully used for similar or other purposes, or that any junk dealer or dealer in second-hand articles, or any other person or corporation, has any such article as named and described herein, in his or its possession, or secreted in any place, the said magistrate must thereupon issue a search warrant to discover and obtain the same, and may also cause to be brought before him the person in whose possession such articles as named and described herein may be found, and shall then inquire into the circumstances of such possession, and if such magistrate finds that such person has been guilty of a violation of subdivision two of section three hundred and sixty-two, he must impose the punishment herein prescribed, and he shall also award possession of the property taken upon such warrant to the owner thereof.

Section 365. What constitutes sale of article. The requiring, taking or accepting of any deposit, for any purpose, upon any bottle, siphon, tin, keg, freezer, can, block, mold, tray, brick, pan, tank, pail, keg, tub, refrigerator, box, spoon, cutlery, glass, china, chair, table or sign, shall not be deemed or constitute a sale of such property, either optional or otherwise, in any proceeding under this article.

Section 366. Trade marks heretofore filed. Any person or persons, corporation or corporations, that has or have heretofore filed in the offices mentioned in sections three hundred and sixty or three hundred and sixty-one, a description of the name or names, marks or devices upon his or its property, therein mentioned, and has caused the same to be published according to the law existing at the time of such filing and publication, shall not be required to again file and publish such description to be entitled to the benefits of this article.

Section 367. Further provisions concerning trade-marks on articles of merchandise. Any person or corporation engaged in manufacturing, packing, bottling or selling any article of merchandise, put up by him for sale in any bottle, vessel, box, package or other receptacle with his name, trade-mark, label or private mark appearing in any way thereon, or branded, stamped, affixed, blown or impressed thereon, may file in the office of the Secretary of State, and in the office of the county

clerk of the county where the same is manufactured, packed, bottled or put up for sale, or where his, its or their principal place of business is situated, or if such person or corporation shall manufacture, pack or bottle outside of this state, then in any county of this state, and also in the office of the Secretary of State, a description, specimen or fac-simile of the name, trade-mark, label or other private mark so appearing thereon or so branded, stamped, affixed, blown, impressed or otherwise marked thereupon, and he shall thereupon be deemed the proprietor of such name, trade-mark, label or other private mark. The Secretary of State shall deliver to such person or corporation so filing the same, a certificate under the seal of the record of such label, trade-mark or other private mark. Any person or corporation so filing said description, specimen or fac-simile may publish the same once a week for at least three weeks successively in a newspaper published in said county, except in New York and Kings counties, where such publication shall be for the same length of time daily in two newspapers therein. Such a certificate granted by the Secretary of State under this act and proof of publication as aforesaid shall be prima facie evidence of the ownership and use of the trademark and label by the persons therein named, in any actions under this statute. Such certificate shall be prima facie evidence of the ownership and use of any label or trade-mark therein described by the person therein named in any prosecution or action under any of the statutes of this state, where proof of such ownership and use is necessary, and in any action or proceeding brought for the purpose of recovering damages for the violation of said trade-mark or of preventing infringement thereof. This statute, however, shall not be construed as preventing the proof of any such label or trade-mark and the use thereof in any lawful manner in use prior to the passage of this act. The Secretary of State shall not record, register, or file any label, trade-mark or other private mark identical with or similar to any other label, trade-mark or other private mark theretofore filed or registered as above provided as would be calculated to deceive, unless it shall be proven to his satisfaction that the person or corporation lastly applying for the registry of such label, trade-mark or other private mark shall be entitled thereto,

and the rightful owner thereof by prior adoption; in which case the date of the adoption shall determine the ownership and shall be proven by affidavits of person conversant with such dates In case the Secretary of State becomes satisfied, after hearing the said affidavits, that the person or corporation last applying for registry is entitled by priority of adoption to register such label, trade-mark or other private mark, he shall revoke the first registry thereof, and re-register the same in the name of said persons last applying therefor. The supreme court may also, in an action brought for that purpose by any person aggrieved thereby against any person who has already filed or registered any such label, trade-mark or other private mark, direct the revocation of any such registration where it shall determine that the person who has already registered the same is not the rightful owner of any such label, trade-mark or other private mark. No person other than such proprietor of such label, trade-mark or other private mark which has been filed in the office of the Secretary of State and in the office of the county clerk, as aforesaid, shall sell, keep or offer for sale in, from, or out of, or fill, place or put into, any vessel, box, package, bottle or receptacle on which any such names, labels or marks in any manner appear, and while so branded, stamped, labeled, blown, impressed or marked, any article or substance other than the original contents placed therein by the proprietor of the label, trade-mark or other private marks thereon, or sell, keep or offer for sale any article or substance in, from or out of, or fill, or place or put any article or substance into any vessel, box, package, bottle or receptacle on which said label and trade-mark in any manner appears or which shall bear or have branded, stamped, labeled, blown, impressed or otherwise marked thereon, any imitation or counterfeit of any such label, trade-mark or other private mark so filed in the office of the Secretary of State and county clerk as aforesaid. No person other than such proprietor in such cases where filing and publication is made as aforesaid, shall remove, deface or obliterate any device, brand, stamp, mark, name, trade-mark or other private marks impressed, stamped or blown into the substance of which any vessel or receptacle is composed, without the written permission of such proprietor or unless there has been a

sale to such person of such vessel or receptacle exclusive of the contents thereof by such proprietor. No person other than such proprietor shall, without his permission, use, traffic in, purchase, sell, dispose of, convert, mutilate, destroy or wilfully or unreasonably refuse to return or deliver to such proprietor on demand, any such vessel or receptacle belonging to such proprietor, which is branded, stamped or marked by having any such registered design, device, name or mark blown in or impressed into the substance of which the vessel or receptacle is composed or sell or dispose of any such vessel or receptacle without obliterating or defacing such label, trade-mark or other private mark if such obliterating or defacing can be done without substantial injury to the vessel or receptacle on which it appears or to which it is affixed providing filing and publication has been made as aforesaid. Nothing herein contained shall be construed as preventing the traffic in any bottles or other receptacles without contents, with or without the obliteration or defacement of the trade-mark upon it, which such trade-mark can be obliterated or defaced without substantial injury to the bottle or receptacle, the intention of this section being to protect the owners of the trade-marks and labels against imitation and refilling of all packages and receptacles while bearing such trade-marks. Each act of refilling, each sale, each imitation, each counterfeit and each offering for sale shall be construed as constituting a separate and distinct violation of this act. Any person violating any provisions of this section shall forfeit to such proprietor one hundred dollars for each such violation. Written permission of such proprietor to do the specific act complained of shall be a complete defense to any action under this section. Nothing in this act shall prevent, lessen,* impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trademark might have had if this act had not been passed, and nothing herein contained shall prevent or avoid or defeat any prosecution under any of the existing penal or other statutes of this state. It is not intended hereby to repeal any of the existing penal or civil statutes or remedies relating to any trade-marks, labels, bottles or packages.

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* So in original.

Laws of 1909, chapter 36.

SECTION 15. LABELS, BRANDS AND MARKS USED BY LABOR ORGANIZATIONS. A union or association of employes may adopt a device in the form of a label, brand, mark, name or other character for the purpose of designating the products of the labor of the members thereof. Duplicate copies of such device shall be filed in the office of the Secretary of State, who shall, under his hand and seal, deliver to the union or association filing or registering the same a certified copy and a certificate of the filing thereof, for which he shall be entitled to a fee of one dollar. Such certificate shall not be assignable by the union or association to whom it is issued.

SECTION 16. ILLEGAL USE OF LABELS, BRANDS AND MARKS A MISDEMEANOR; INJUNCTION PROCEEDINGS. A person who (1) shall in any way use or display the label, brand, mark, name or character adopted by any such union or association as provided in the preceding section, without the consent or authority of such union or association; or (2) shall counterfeit or imitate any such label, brand, mark, name or other character, or knowingly sells or disposes or keeps or has in his possession, with intent to sell, or dispose of, or keeps, or has in his possession, with intent to sell, or dispose of any goods, wares, merchandise or other products of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, is guilty of a misdemeanor, and shall be punished by a fine of not less than one hundred dollars, nor more than five hundred dollars, or by imprisonment for not less than three months nor more than one year, or by both such fine and imprisonment. After filing copies of such device, such union or association may also maintain an action to enjoin the manufacture, use, display or sale of counterfeit or colorable imitations of such device, or of goods bearing the same, or the unauthorized display of such device, or of goods bearing the same, and the court may restrain such wrongful manufacture, use, display or sale, and every unauthorized use or display by others of the genuine device so registered and filed, if such use or display is not authorized by the owner thereof, and may award to the plaintiff such damages

resulting from such wrongful manufacture, use, display or sale as may be proved, together with the profits derived therefrom.

Laws of 1909, chapter 88.

SECTION 435. FALSE LABELS. A person who, with intent to defraud:

1. Puts upon an article of merchandise, or upon a cask, bottle, stopper, vessel, case, cover, wrapper, package, band, ticket, label or other thing, containing or covering such an article, or with which such an article is intended to be sold, or is sold, any false description or other indication of or respecting the kind, number, quantity, weight or measure of such article, or any part thereof, or the place or country where it was manufactured or produced or the quality or grade of any such article, if the quality or grade thereof is required by law to be marked, branded, or otherwise indicated on or with such article; or

2. Sells or offers for sale an article, which to his knowledge is falsely described or indicated upon any such package, or vessel containing the same, or label thereupon, or any of the particulars specified; or

3. Sells or exposes for sale any goods in bulk to which no name or trademark shall be attached, and orally or otherwise represents that such goods are the manufacture or production of some other than the actual manufacturer or producer, in a case where the punishment for such offense is not specially provided for otherwise by statute, is guilty of a misdemeanor.

SECTION 436. USING FALSE MARKS AS TO MANUFACTURE. A person who, with intent to defraud or to enable another to defraud any person, manufactures or knowingly sells or causes to be manufactured or sold, any article, marked, stamped or branded or incased or enclosed in any box, bottle or wrapper, having thereupon any engraving or printed label, stamp, imprint, mark or trade-mark, which article is not the manufacture, workmanship or production of the person named, indicated or denoted by such marking, stamping or branding, or by or upon such engraving, printed label, stamp, imprint, mark or trademark, is guilty of a misdemeanor.

Penal Law, Art. 206.

SECTION 2350. A "trademark" is a mark used to indicate the maker, owner or seller of an article of merchandise, and includes, among other things, any name of a person or corporation, or any letter, word, device, emblem, figure, seal, stamp, diagram, brand, wrapper, ticket, stopper, label or other mark, lawfully adopted by him, and usually affixed to an article of merchandise to denote that the same was imported, manufactured, produced, sold, compounded, bottled, packed or otherwise prepared by him; and also a signature or mark used or commonly placed by a painter, sculptor or other artist upon a painting, drawing, engraving, statue or other work of art, to indicate that the same was designed or executed by him.

SECTION 2351. A trade-mark is deemed to be affixed to an article of merchandise when it is placed in any manner in, or upon:

1. The article itself; or,

2. A box, bale, barrel, bottle, case, cask, platter, or other vessel or package, or a cover, wrapper, stopper, brand, label or other thing in, by or with which the goods are packed, inclosed or otherwise prepared for sale or disposition.

SECTION 2352. ARTICLE OF MERCHANDISE DEFINED. The expression "article of merchandise," as used in sections twenty-three hundred and fifty and twenty-three hundred and fifty-one, signify any goods, wares, work of art, commodity, compound, mixture, or other preparation or thing, which may be lawfully kept or offered for sale.

SECTION 2353. An "imitation of a trademark" is that which so far resembles a genuine trade-mark as to be likely to induce the belief that it is genuine, whether by the use of words or letters, similar in appearance or in sound, or by any sign, device or other means whatsoever.

SECTION 2354. (Amended by Session Act 1914, as follows):

CHAPTER 332.

Laws of New York, 1914. 137th Session.

AN ACT to amend the penal law, in relation to trade-marks. Became a law April 14, 1914, with the approval of the Governor. Passed, three-fifths being present.

The People of the State of New York, represented in Senate and Assembly, do enact as follows:

SECTION 1. Section twenty-three hundred and fifty-four of chapter eighty-eight of the laws of nineteen hundred and nine, entitled "An act providing for the punishment of crime, constituting chapter forty of the Consolidated Laws," as amended by chapter two hundred and forty of the laws of nineteen hundred and nine, is hereby amended to read as follows:

SECTION 2354. OFFENSES AGAINST TRADEMARKS. A person who:

1. Falsely makes or counterfeits a trade-mark; or,

2. Affixes to any article of merchandise, a false or counterfeit trade-mark, knowing the same to be false or counterfeit, or the genuine trade-mark, or an imitation of the trade-mark of another, without the latter's consent; or,

3. Knowingly sells, or keeps or offers for sale, an article of merchandise, to which is affixed a false or counterfeit trade-mark, or the genuine trade-mark, or an imitation of the trade-mark of another, without the latter's consent; or,

4. Has in his possession a counterfeit trade-mark, knowing it to be counterfeit, or a die, plate, brand, or other thing for the purpose of falsely making or counterfeiting a trade-mark; or,

5. Makes or sells, or offers to sell or dispose of, or has in his possession with intent to sell or dispose of, an article of merchandise with such a trade-mark as to appear to indicate the quantity, quality, character, place of manufacture or production, or persons manufacturing, packing, bottling, boxing or producing the article, but not indicating it truly; or,

6. Knowingly sells, offers or exposes for sale, any goods which are represented in any manner, by word or deed, to be the manufacture, packing, bottling, boxing or product of any person, firm or corporation, other than himself, unless such goods are contained in the original packages, box or bottle and under the labels, marks or names placed thereon by the manufacturer who is entitled to use such marks, names, brands or trade-marks; or,

7. Shall sell, or expose for sale any goods in bulk, to which no label or trade-mark shall be attached, and shall by representa-

tion, name or mark written or printed thereon, represent that such goods are the production or manufacture of a person who is not the manufacturer; or,

8. Shall knowingly sell, offer or expose for sale any article of merchandise, and shall orally or by representation, name or mark written or printed thereon or attached thereto used in connection therewith, or by advertisement, or otherwise, in any manner whatsoever, make any false representation as to the person by whom such article of merchandise or the material thereof was made, or was in whole or in part produced, manufactured, finished, processed, treated, marked, packed, bottled or boxed, or falsely represents that such article of merchandise or the material or any part thereof has or may properly have any trade-mark attached to it in connection with it, or is or may properly be indicated or identified by any trade-mark,

Is guilty of a misdemeanor and punishable for the first offense by a fine not less than fifty dollars nor more than five hundred dollars or imprisonment for not more than one year, or both such fine and imprisonment, and for each subsequent offense by imprisonment for not less than thirty days or more than one year, or by both such imprisonment and a fine of not less than five hundred dollars or more than one thousand dollars.

Section 2. This act shall take effect September first, nineteen hundred and fourteen.

Section 2355. Refilling or selling trade-mark bottles and vessels. Any person engaged in making, bottling, packing, selling or disposing of milk, ale, beer, cider, mineral water or other beverage or in making, selling, or disposing of articles of pastry, may register his title as owner of a trade-mark by filing with the Secretary of State and the clerk of the county where the principal place of business of such person is situated, a description of the marks and devices used by him in his business, and in case same has not been heretofore published according to the laws existing at the time of publication, causing the same to be published in a newspaper of the county, three weeks daily, if in the city of New York or Brooklyn, and weekly if in any other part of the state; but no trade-mark shall be filed which is not and can not become a lawful trade-mark, or which is merely the name of a person, firm or corpora-

tion unaccompanied by a mark sufficient to distinguish it from the same name when used by another person. After such registration, the use without the consent of the owner of the trade-mark so described or the filling of any bottle, siphon, barrel, platter, vessel, or thing for the purpose of sale, or for the sale, therein, of any article of the same general nature and quality which said bottle, siphon, barrel, platter, vessel or other thing before contained, without the obliteration or defacement of the trade-mark upon it, when such trade-mark can be obliterated or defaced without substantial injury to the bottle, siphon, barrel, platter, vessel or other thing so as to prevent its wrongful use, shall be deemed a misdemeanor.

SECTION 2356. KEEPING TRADE-MARK BOTTLES AND VESSELS WITH INTENT TO REFILL OR SELL THEM. Any person engaged in the business of buying and selling bottles, siphons, barrels, platters, or other vessels or things, who shall with intent to defraud the registered owner of the trade-mark, knowingly sell or offer for sale any bottle, siphon, barrel, platter, vessel, or other thing, to any person, who he has reason to believe wrongfully intends to use the trade-mark upon it, or to fill such bottle, siphon, barrel, platter, vessel or other thing in violation of section twenty-three hundred and fifty-five, shall be deemed guilty of a misdemeanor.

SECTION 2357. SEARCH FOR TRADE-MARK BOTTLES AND VESSELS KEPT IN VIOLATION OF LAW AUTHORIZED. Whenever a registered owner of a trade-mark, or his agent, makes oath before a magistrate that he has reason to believe and does believe, stating the grounds of his belief, that a bottle, siphon, barrel, platter, vessel or other thing to which is affixed a trade-mark belonging to him is being used or filled, or has been sold or offered for sale, by any person whomsoever, in violation of the preceding section, then the magistrate may issue a search warrant to discover the thing and cause the person having it in possession to be brought before him and may thereupon inquire into the circumstances, and if on examination, he finds that such person has been guilty of the offense charged, he may hold the offender to bail to await the action of the grand jury, and the offender shall also be liable to an action on the

case for damages, for such wrongful use of such trade-mark at the suit of the owner thereof, and the party aggrieved, shall also have his remedy according to the course of equity to enjoin the wrongful use of his trade-mark, and to recover compensation therefor, in any court having jurisdiction over the person guilty of such wrongful use.

As to search warrants under sec. 369, Penal Code 1893, see *People v. Hogan*, 29 N. Y. St. 110. For further rulings under that section see *Mullins v. People*, 23 How. Pr. 289, 24 N. Y. 399. *People v. Cannon*, 139 N. Y. 32, 34 N. E. Rep. 759.

Chapter 219, Laws 1893, relates to the protection of labels of unions or associations of workingmen, and provides a penalty for selling cigars bearing a counterfeit label. In an action for the recovery of this penalty, it was held that knowledge, or intent to injure or defraud were not ingredients in the offense prohibited, and that allegations of the knowledge, or intent to injure or defraud should be treated as surplusage. *Bulena v. Newman*, 31 N. Y. Supp. 449. See also *Perkins v. Heert*, 158 N. Y. 306, 53 N. E. Rep. 18.

A conviction under sec. 364, Penal Code, was sustained where the defendant printed a label containing a trade-mark at the solicitation of the agent of the owner of the trade-mark. *People v. Gluckman*, 70 N. Y. Supp. 173.

In sustaining a conviction under the same section, it was held to be immaterial that the prosecutor knew that he was purchasing counterfeit goods. *People v. Hilfman*, 70 N. Y. Supp. 621.

In sustaining another conviction under this section, the court of appeals similarly held that it was no defense that the act relied on for conviction was done at the instance of the prosecutor. *People v. Krivitzky*, 168 N. Y. 182, 61 N. E. Rep. 175.

Where the plaintiffs had filed a certificate pursuant to sec. 363, Penal Code, setting forth their intention to do business under the name "American Watchman Clock Co.," and subsequently prepared to incorporate under that name, and the defendant having knowledge of the facts, and to forestall the plaintiff's proposed incorporation, thereupon incorporated under the same name, injunction was granted upon the ground of unfair competition. *Pettes v. American Watchman's Clock Co.*, 85 N. Y. Supp. 900.

That one who is convicted of counterfeiting or imitating a stamp, wrapper, or label is also liable to civil damages, see *Brown v. Mercer*, 37 N. Y. Super. Ct. 265.

Laws of 1887, chap. 377, sec. 2, as amended by laws of 1888, chap. 181, made it unlawful to use boxes, bottles, and other packages having the owner's name, or other marks or devices, "branded, stamped, engraved, etched, blown, impressed, or otherwise produced upon such bottles," etc.

It was held that the use of bottles bearing lithographic labels containing the name of another was not a violation of this act. *People v. Elfenbein*, 20 N. Y. Supp. 364.

A section of the same act making it a misdemeanor to refill registered stamped bottles of the manufacturers of soda water, and the like, was held to apply only to dealing in empty bottles after the original contents had been removed. *People v. Cannon*, 139 N. Y. 32, 34 N. E. Rep. 759.

Under the Laws of 1862, chap. 306, sec. 4, and the Laws of 1863, chap. 209, sec. 2, relating to the use of false stamps, labels, or trademarks, and providing a penalty therefor, it was held essential to a recovery of the penalty that the fraudulent intent of the defendant be shown. *Low v. Hall*, 47 N. Y. 104.

Under the Union Label Act, Laws 1893, chap. 219, certain evidence is reviewed and held not sufficient to sustain a judgment for plaintiff in *Higgins v. Dakin*, 33 N. Y. Supp. 890, 86 Hun, 461.

Laws of 1887, chap. 377, amended by Laws of 1888, chap. 181, relating to the registration of marks used on bottles, it is required that the certificate filed with the county clerk, describing the names, marks and devices used on the bottles be certified. Consequently, such a description is admissible in evidence, though defectively acknowledged. *People v. Bartholf*, 66 Hun, 626, 20 N. Y. Supp. 782.

Penal Code, sec. 364 prohibits the sale, from a refilled package bearing a trademark, of goods made by original producer of the package. *People v. Luhrs*, 89 N. E. Rep. 171, 195 N. Y. 377, affirming judgment, 111 N. Y. S. 749, 127 App. Div. 634.

Under sec. 367, General Business Laws, the newspaper publication of the mark is not required to support the recovery of a penalty for refilling trademarked bottles. *John Jameson & Son v. Reilly*, 153 N. Y. S. 225, 90 Misc. Rep. 318; *Gordon Dry Gin Co. v. Reilly*, 153 N. Y. S. 226.

FORM OF APPLICATION FOR REGISTRATION.

To the Secretary of State of the State of New York:

In compliance with the requirements of Article 24 of Chapter 25, of the Laws of 1909, constituting Chapter 20 of the Consolidated Laws, known as the "General Business Law," approved the 17th day of February, 1909, as amended by Chapter 475 of the Laws of 1909, relating to the registra-

tion, use and protection of trade marks, We, the undersigned, certify as follows:

I. The name of the person or corporation applying for this registration is ———.

II. The principal place of business of the applicant is in the city of ———, and State of ———.

III. The name, trade mark, label or private mark is as follows: ———

IV. A specimen or fac-simile is affixed hereto.

V. The same has been in use by applicant since ———.

——— ———,

By ——— ———.

State of ——— ———,
County of ——— ———, ss:

———, being duly sworn, deposes and says that he ——— of the applicant named in the foregoing application. That he knows the contents thereof and that the statements contained therein are true. That the applicant named in the foregoing application has the right to use the name, trade mark or other mark therein described, and that no other person or corporation has the right to use the same either in the identical form or in any such near resemblance thereto as might be calculated to deceive, and that the fac-similes or specimens filed herewith are true and correct.

——— ———.

Subscribed and sworn to before me this ——— day of ———, 19—.

——— ———.

Notary Public.

NORTH CAROLINA.

Chapter 74, Revisal of 1905.

TRADEMARKS.

	Sections.
I. Generally,	3012-3022
II. Timber,	3023-3027
III. Live stock,	3028

I. GENERALLY.

SECTION 3012. TRADEMARKS, LABELS, ETC., FILED FOR REGISTRY. It shall be lawful for any person to adopt for his protection and file for registry, as in this chapter provided, any label, trademark, term, or design that has been used or is intended to be used for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or products of

labor that have been or may be wholly or partly made, manufactured, produced, prepared, packed, or put on sale by any such person, or to or upon which any work or labor has been applied or expended by any such person, or by any member of any corporation that has adopted and filed for registry any such label, trademark, term, or design as aforesaid, or announcing or indicating that the same have been made in whole or in part by any such person or corporation, or by any member thereof. (1903, c. 271.)

SECTION 3013. PROPERTY RIGHTS PROTECTED BY FILING FOR REGISTRY. Whenever any person shall adopt and file for registry any label, trademark, term, or design pursuant to the provisions of this chapter, the property, privileges, rights, remedies and interest in and to any such label, trademark, term, or design, and in and to the use of same, provided or given by this chapter to, or otherwise conferred upon or enjoyed by, the person filing the same for the registry, shall be fully and completely secured, preserved, and protected as the property of those entitled to the same before any such label, trademark, term, or design has been actually applied to any goods, wares, merchandise, or product of labor, and put upon the market for sale or otherwise, and before any use or appropriation of any such label, trademark, term, or design has been made in connection with any such goods, wares, merchandise, or product of labor, as well as after the same has been used or applied to designate, make known, or distinguish any such goods, wares, merchandise, or product of labor and they have been put upon the market. (1903, c. 271, s. 2.)

SECTION 3014. FILED WITH SECRETARY OF STATE; AFFIDAVIT; FEES. Any person who has heretofore adopted and used, or shall hereafter adopt and use any label, trademark, term, or design, as in this chapter provided, may file the same for registry in the office of the Secretary of State, by leaving two copies, *fac-similes* or counterparts thereof, with the said secretary, and filing therewith a statement in the form of an affidavit, subscribed and sworn to by any such person, or by any officer, agent, or attorney if a corporation, specifying the person by whom any such label, trademark, term, or design is filed, and the class or character of the goods, wares, merchandise, o·

products of labor to which the same has been or is intended to be appropriated or applied, and that the person so filing the same has the right to the use of the said label, trademark, term, or design, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, without the permission or authority of the person filing the same, and that the copies, *fac-similes*, or counterparts filed therewith are true and correct copies, *fac-similes*, or counterparts of the genuine label, trademark, term, or design of the person filing the same, and there be paid for such registry a fee of one dollar to the Secretary of State for the use of the state, and the same recording fees required by law for recording certificate of organization of corporations. (1903, c. 271, s. 3.)

SECTION 3015. REGISTRATION; CERTIFIED COPIES; EVIDENCE; FEES. The Secretary of State, upon the filing of any such label, trademark, term, or design, that is not in conflict with the next section, shall register the same, and shall deliver to the person filing the same as many certified copies thereof, with his certificate of such registry, as any such person may request, and for every such copy and certificate there shall be paid to the Secretary of State, for the use of the state, a fee of one dollar; and any such certified copy and certificate shall be admissible in evidence and competent and sufficient proof of the adoption, filing, and registry of any such label, trademark, term, or design, by any such person in any action or judicial proceeding in any of the courts of this state, and of due compliance with the provisions of this chapter. (1903, c. 271, s. 4.)

SECTION 3016. HOW TRANSFERRED. The right to use any registered label, trademark, term, or design shall be granted only by an instrument in writing, duly filed in the office of the Secretary of State. The fees for recording or filing such transfer and issuing copies thereof shall be the same as for filing such label, trademark, term, or design.

SECTION 3017. SIMILAR TRADEMARKS REFUSED REGISTRATION. It shall not be lawful for the Secretary of State to register for any person any label, trademark, term, or design that is in the identical form of any other label, trademark, term, or design

theretofore filed by any other person, or that bears any such near resemblance thereto as may be calculated to deceive, or that would be liable to be mistaken therefor. (1903, c. 271, s. 5.)

SECTION 3018. PENALTY FOR SECURING FRAUDULENT REGISTRATION. Any person who shall file or procure the filing and registry of any label, trademark, term, or design in the office of the Secretary of State under the provisions of this chapter, by making any false or fraudulent representations or declarations, with fraudulent intent, shall be liable to pay any damages sustained in consequence of any such registry, to be recovered by or in behalf of the party injured thereby. (1903, c. 271, s. 5.)

SECTION 3019. USE OF COUNTERFEIT TRADEMARKS UNLAWFUL. Whenever any person has adopted and filed for registry any label, trademark, term, or design, as provided by law, and the same shall have been registered pursuant to law, it shall be unlawful for any other person to manufacture, use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, or design, or have in possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or product of labor to which or on which any counterfeit or imitation of any such label, trademark, term, or design is attached, affixed, printed, stamped, impressed, or displayed, or to sell or dispose of, or offer to sell or dispose of, or have in possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or product of labor contained in any box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, stamped, impressed or displayed. (1903, c. 271, s. 6.)

SECTION 3020. UNAUTHORIZED USE UNLAWFUL; USE UNDER LICENSE. Whenever any person has adopted and registered any label, trademark, term, or design, as provided by law, it shall be unlawful for any other person to make any use, sale, offer for sale, or display of the genuine label, trademark, term, or design of any such person filing the same, or to have any such genuine label, trademark, term, or design, in possession, with intent that the same shall be used, sold, offered for sale, or displayed, or that the same shall be applied, attached, or displayed

in any manner whatever to or on any goods, wares, or merchandise, or to sell, offer to sell, or dispose of, or have in possession, with intent that the same shall be sold or disposed of, any goods, wares, or merchandise in any box, case, can or package to or on which any such genuine label, trademark, term, or design of any such person is attached, affixed, or displayed, or to make any use whatever of any such genuine label, trademark, term, or design, without first obtaining in every such case the license of the person adopting, filing and registering the same; and any such license may be revoked and terminated at any time upon notice, and thereafter any use thereof shall be unlawful. (1903, c. 271, s. 7.)

SECTION 3021. REMEDIES; DAMAGES; PROFITS; DESTRUCTION OF COUNTERFEITS. Any person who has registered any label, trademark, term, or design under the provisions of this chapter shall have a right of action against any person for the unauthorized use of such label, trademark, term, or design, and the courts shall by appropriate remedies prevent the unauthorized or unlawful use, manufacture, or display of any label, trademark, term, or design, or the imitation or counterfeit thereof, or the sale, disposal or display of any articles of property on which any counterfeit or imitation of any registered label, trademark, term or design, or on which any genuine label, trademark, term, or design may be used or displayed without proper authority; and shall further secure and protect all persons in all rights of property and interest which they may have in any label, trademark, term, or design registered under this chapter; and the court shall award to the plaintiff any and all damages resulting from any such wrongful use of any such label, trademark, term, or design; and any counterfeit or imitation of any labels, trademarks, terms, or designs and any die, engraving, mold, or mechanical device for the manufacture of the same in the possession or under the control of the defendant, shall be delivered up to an officer of the court, to be destroyed, and that any such genuine labels, trademarks, terms, or designs in the possession or under the control of any such defendant shall be delivered to the plaintiff. (1903, c. 271, s. 8.)

SECTION 3022. ADDITIONAL PENALTY. In addition to any other rights, remedies, or penalties provided by this chapter,

and as concurrent therewith, any person who shall violate any of the provisions of this chapter shall be liable to a penalty of two hundred dollars, to be recovered by any person who has filed any such label, trademark, term, or design. (1903, c. 271, s. 9.)

II. TIMBER.

SECTION 3023. WHO MAY ADOPT. Any person dealing in timber in any form shall be known as a timber dealer, and as such may adopt a trademark, in the manner and with the effect in this sub-chapter provided. (1903, c. 261, s. 1.)

SECTION 3024. HOW ADOPTED, REGISTERED AND PUBLISHED. Every such dealer desiring to adopt a trademark may do so by the execution of a writing in form and effect as follows:

TRADEMARK.

Notice is hereby given that I [*or* we, etc., *as the case may be*] have adopted the following trademark, to be used in my [*or* our, etc.] business as timber dealer [*or* dealers] to-wit: ——— [*Here insert the words, letters, figures, etc., constituting the trademark, or if it be any device other than words, letters, or figures, insert a fac-simile thereof*].

Dated this ——— day of ———, 19—.

A. ———, B. ———.

Such writing shall be acknowledged or proved for record in the same manner as deeds are acknowledged or proved, and shall be registered in the office of the register of deeds of the county in which the principal office or place of business of such timber dealer may be, in a book to be kept for that purpose marked "Registry of Timber Marks," also, in office of Secretary of State, and a copy thereof shall be published at least once in each week for four successive weeks in some newspaper printed in such county, or if there be no such newspaper printed therein, then in some newspaper of general circulation in such county. (1889, c. 142; 1903, c. 261, s. 2.)

SECTION 3025. PROPERTY IN; HOW USED. Every trademark so adopted shall, from the date thereof, be the exclusive property of the person adopting the same. The proprietor of such trademark shall, in using the same, cause it to be plainly stamped,

branded, or otherwise impressed upon each piece of timber upon which the same is placed. (1889, c. 142; 1903, c. 261, ss. 3, 4.)

SECTION 3026. BRANDING WITH, EFFECT OF. When timber is purchased by the proprietor of any such trademark, and the said trademark is placed thereon as hereinbefore provided, such timber shall thenceforth be deemed the property of such purchaser, without any other or further delivery thereof, and such timber shall thereafter be at the risk of the purchaser, unless otherwise provided by contract in writing between the parties. (1889, c. 142; 1903, c. 261, s. 6.)

SECTION 3027. BRANDING WITH, EVIDENCE OF OWNERSHIP. In any action, suit, on contest in which the title to any timber, upon which any trademark has been placed as aforesaid, shall come in question, it shall be presumed that such timber was the property of the proprietor of such trademark, in the absence of satisfactory proof to the contrary. (1903, c. 261, s. 7.)

NOTE.—For unlawful use of timber trademark, see secs 3854-3856.

For buying branded logs, see sec. 3853.

III. LIVE STOCK.

SECTION 3028. OWNERS OF STOCK TO REGISTER BRAND OR MARK. Every person who hath any horses, cattle, hogs, or sheep may have an earmark or brand different from the earmark or brand of all other persons, which he shall record with the clerk of the board of commissioners of the county where his horses, cattle, hogs, or sheep are; and he may brand all horses eighteen months old and upwards with the said brand, and earmark all his hogs and sheep six months old and upwards with the said earmark, and earmark or brand all his cattle twelve months old and upwards; and if any dispute shall arise about any earmark or brand, the same shall be decided by the record thereof. (Code, s. 2317; R. C., c. 17, s. 1.)

APPLICATION FOR REGISTRATION OF TRADEMARK OR DESIGN.

State of ——— ———.

County of ———, ss:

To the Secretary of State of the State of North Carolina:

The undersigned, pursuant to Chapter 74 of the Revisal of 1905, entitled "Trademarks," having heretofore adopted or used, or desiring

to adopt or use, a trademark or design for the purpose set out in the aforesaid Chapter 74 of the Revisal, and desiring to file the same for record in the office of the Secretary of State of the State of North Carolina, does hereby certify:

1st. The name of the person, firm or corporation so filing is ———.

2d. The principal office or place of business of said person, firm or corporation is ———.

3d. The class of merchandise for which said trademark or design is to be used is ———.

4th. The trademark or design consists of ———.

5th. The length of time, if any, during which it has been in use is ———.

State of ——— ———,
County of ——— ———, ss:

Personally appeared before me, this ——— day of ———, A. D. 19—, ———, who, being by me duly sworn according to law, doth depose and say that the statements contained in the foregoing instrument are true; that ———, the person, firm or corporation so filing such trademark or design, has the right to use the same, and that no other person or persons, firm or corporation has the right to such use, and that the fac-similes filed therewith are true and correct.

Sworn to and subscribed before me the day and year aforesaid.

——— ———,
——— ———.

NOTE.—Two copies of the trademark or design must be filed herewith. Registration fee, $3.10.

NORTH DAKOTA.

Rev. Codes 1905.

SECTION 4921. One who produces or deals in a particular thing or conducts a particular business, may appropriate to his exclusive use as a trademark any form, symbol or name which has not been so appropriated by another to designate the origin or ownership thereof; but he can not exclusively appropriate any designation or part of a designation which relates only to the name, quality, or the description of the thing or business, or the place where the thing is produced or the business is carried on.

SECTION 4922. The goodwill of a business is the expectation of continued public patronage, but it does not include a right to use the name of any person from whom it is acquired.

SECTION 4923. The goodwill of a business is property, transferable like any other.

SECTION 5426. One who sells or agrees to sell any article to which there is affixed or attached a trademark, thereby warrants that mark to be genuine and lawfully used.

SECTION 5427. One who sells or agrees to sell any article to which there is affixed or attached a statement or mark to express the quantity or quality thereof or the place where it was in whole or in part produced, manufactured or prepared thereby warrants the truth thereof.

SECTION 8996. Every person who wilfully forges, counterfeits or procures to be forged or counterfeited any trademark usually affixed by any person to any goods of such person, with intent to pass off any goods to which such forged or counterfeit trademark is affixed or intended to be affixed, as the goods of such person, is guilty of a misdemeanor.

SECTION 8997. Every person who, with intent to defraud, has in his possession any die, plate or brand, or any imitation of the trademark of any person, for the purpose of making any counterfeit or imitation of any description whatever of such trademark, or of selling the same when made, or affixing the same to any goods, and selling or offering the same for sale or disposal as the original goods of any other person, and every person who so uses or sells the same, or who fraudulently uses the genuine trademark of another with intent to sell or offer for sale or disposal, any goods not the goods of the person to whom such trademark properly belongs, as genuine and original, is guilty of a misdemeanor.

SECTION 8998. Every person who either:

1. Uses or causes to be used any brand, mark, name, print, designation or description, the same as or similar to any recorded to any other persons, or on the place recorded to another; or,

2. Uses or causes to be used any second-hand sacks, box, barrel, can, package or other article on which has been placed any brand, mark, name, print, designation or description, the property of another, for the purposes of deception or profit, is

guilty of a misdemeanor, and upon conviction thereof is punishable by fine of not less than one hundred and not exceeding one thousand dollars.

SECTION 8999. Every person who sells or keeps for sale any goods upon which any counterfeit trademark has been affixed, and intended to represent such goods as the genuine goods of another, knowing the same to be counterfeited, is guilty of a misdemeanor.

SECTION 9000. Every person who, with intent to defraud, affixes or causes to be affixed to any goods, or to any bottle, case, box or other package containing any goods, any description of label, stamp, brand, imprint, printed wrapper, label or mark, which designates such goods by any word or token which is wholly or in part the same to the eye or to ear as the word of any of the words or tokens used by any other person as his trademark, and every person who knowingly sells, or keeps, or offers for sale any such bottle, case, box, or other package with any such label, stamp, brand, imprint, printed wrapper, ticket or mark affixed to, or upon it, in case the person affixing or causing to be affixed such mark, or so selling or exposing or offering for sale such bottle, case, box, or other package, was not the first to employ or use such words as his trademark, is guilty of a misdemeanor, and in addition to the punishment prescribed therefor is liable to the party aggrieved in the penal sum of one hundred dollars for each and every offense, to be recovered by him in a civil action.

SECTION 9001. The word "trademark," as used in the sections preceding, include every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman to denote any goods to be goods imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description.

SECTION 9002. The word "goods," as used in the sections preceding, includes every kind of goods, wares, merchandise, compound or preparation, which may be lawfully kept or offered for sale.

SECTION 9003. The offense of affixing a false trademark to goods is equally complete within the meaning of sections 7256, 7259 and 7260, whether such mark is affixed to the goods themselves or to any box, bale, barrel, bottle, case, cask, wrapper or other package or vessel, or any cover or stopper thereof, in which such goods are put up.

SECTION 2138 relates to protection of packages of manufacturers and bottlers of soda, mineral water, and other beverages.

CERTIFICATE AND STATEMENT ACCOMPANYING A TRADEMARK.

Filed in accordance with Section 1543, Chapter 124, Session Laws of 1901, of the State of North Dakota, being an act to protect manufacturers from the use of counterfeiting labels, stamps and trademarks.

To all whom it may concern:

Be it known that ———, a corporation duly organized under the laws of the State of ———, and having its place of business at ——— in said state, has adopted a trademark, the essential features of which are described as follows:

———, the style and size of type and color of ink and paper to be varied at pleasure.

The trademark has been in continuous use by said corporation since ———, and the following is a fac-simile thereof:

I, ——— of the ——— do hereby declare, in accordance with the provisions of the law hereinbefore referred to, that the said company has a right to the use of the trademark as described in the foregoing certificate and that no other person, firm, association or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and

I further declare that the fac-similes, copies or counterparts filed with the foregoing certificate are true and correct.

In witness whereof, I have hereunto signed my name this ——— day of ———, 19—.

——— ———.

State of ——— ———,
County of ——— ———, ss:

Personally appeared before me, a Notary Public in and for said county and state, the above named ———, and made oath that the foregoing declaration by him subscribed to is true of his own knowledge.

——— ———,
Notary Public.

NOTE.—The fee for filing the above is $2. In case a certificate of filing is desired, papers should be made out in duplicate, remitting $1 additional.

OHIO.

102 O. L. 513.

AN ACT to provide for the registration of marks of ownership on personal property, and to make such registered mark *prima facie* evidence of ownership of property bearing such mark.

Be it enacted by the General Assembly of the State of Ohio:

SECTION 6240-1. Section 1. That any and all persons or corporations who may be the owners of cans, tubs, firkins, boxes, bottles, casks, barrels, kegs, cartons, tanks, fountains, vessels or containers, with his, her, its or their names, brands, designs, trademarks, devices, or other marks of ownership stamped, impressed, labeled, blown in or otherwise marked thereon, may file with the Secretary of State, and also with the clerk of the court of common pleas of the county in which such person or persons or corporations may have his, her, its or their principal place of business, a written statement or description verified by affidavit of such owner or his, her or its agents, of the names, brands, designs, trademarks, devices or other marks of ownership so used by him, her, it or them, and of the said article or articles upon which the same are used; or if such principal place of business be without this state, then such written statement or description so verified may be filed with the clerk of the court of common pleas of any county in this state.

SECTION 6240-2. Section 2. The statement provided for in section one of this act shall be published once a week for four successive weeks in a newspaper printed in the English language, and of general circulation in the county in which such notice may have been filed with the clerk of the court of common pleas as aforesaid; a copy of which publication proved in the same manner as proof of publication is now required to be made by law, when no special mode of proving the same is provided, shall also be filed with the Secretary of State, and with the clerk of the court of common pleas of the county where such statement is filed.

All such written statements or descriptions and all such certificates of publication so filed with the clerk of the court of common pleas shall be recorded by him in a book to be kept by him for such purpose; and such book shall be subject, at all reasonable hours, to the inspection of all persons who may choose to inspect the same.

SECTION 6420-3. Section 3. The Secretary of State and the clerk of the court of common pleas of the county where such statement is filed, shall deliver to any person who may apply therefor, upon payment of the fees herein provided, copies of all such written statements or descriptions of names, brands, designs, trademarks, devices, or other marks of ownership, and of all certificates of publication so filed with them, duly certified to by them in the usual manner; and such certified copies, so made by either the Secretary of State or the clerk of the court of common pleas of the county where such statement is filed, shall be admissible in evidence in any suit, action or proceeding in law under this act, and shall be *prima facie* evidence that the provisions of this act have been complied with, and also *prima facie* evidence of the title of the owner or owners named therein, to the property upon which the name, brand, design, trademark, device or other mark or marks of ownership of such owner or owners may appear as described therein.

SECTION 6240-4. Section 4. The Secretary of State and the clerk of the court of common pleas shall each receive a fee of one dollar ($1.00) for each statement and certificate of publication filed, and also a fee of one dollar ($1.00) for each certified copy of such statement and certificate of publication.

The sectional numbers on the margin hereof are designated as provided by law.

TIMOTHY S. HOGAN,
Attorney General.

S. J. VINING,
Speaker of the House of Representatives.
HUGH L. NICHOLS,
President of the Senate.

Passed May 31st, 1911. Approved June 7th, 1911.
JUDSON HARMON, *Governor.*

106 O. L. 108.

AN ACT to amend and supplement section 13169 of the General Code passed April 28, 1913 (103 O. L. 652), by enacting a new section 13169, and adding supplemental sections 13169-1, 13169-2 and 13169-3 providing for the registration of bottles, siphons, siphon tops, tins, fountain tanks, kegs or other containers; and making it unlawful for any person, other than the owner thereof, to fill, refill, deal or traffic in such bottles and other containers and to repeal said original section 13169 of the General Code.

Be it enacted by the General Assembly of the State of Ohio:

SECTION 1. That section 13169 of the General Code be amended by enacting a new section 13169 and supplemented by adding supplemental sections 13169-1, 13169-2 and 13169-3 to read as follows:

SECTION 13169. Any person, firm or corporation engaged in the manufacturing, bottling, or selling of soda waters, mineral or aërated waters, ginger ale, porter, ale, beer, cider, small beer, milk, cream, lager beer, weiss beer, white beer, or other beverages, or medicines, medical preparations, perfumery, oils, compounds, or mixtures, and using in the manufacture, sale and delivery of the same any bottles, siphons, siphon tops, tins, fountain tanks, kegs or other containers, may mark and designate such bottles, siphon, siphon tops, tins, kegs and other containers with his or its name or other mark or device branded, stamped, engraved, etched, blown, or otherwise produced upon the same, and file in the office of the Secretary of State and also in the office of the clerk of the courts of the county in which his or its principal place of business is situated a description of such name, mark or device and cause such description to be printed once in each week for three weeks successively in a newspaper published in such county. *Provided,* that if the principal place of business of any such person, firm or corporation is in another state, the filing of such description shall be made in the office of the Secretary of State and also in the office of the clerk of the courts in any county of this state, and printed for three weeks successively in a newspaper published in such county. When any such person, firm or corporation shall have complied with the provisions of this section, he or it shall thereupon be deemed the proprietor of such name, mark or device and of every such bottle, siphon, siphon top, tin, fountain tank, keg or other container upon which may be branded, stamped, etched, engraved, blown or otherwise produced upon the same, upon the filing with the Secretary of State and county clerk, as herein above referred to, such name, mark or device, there shall be paid to the Secretary of State and the county clerk respectively one dollar for each such name, mark or device so filed.

SECTION 13169-1. When any person, firm or corporation, having complied with the provisions of section 13169 of this act, assigns by sale or otherwise his or its business, including such name, mark or device, to another person, firm or corporation, the assignee shall have all the rights and immunities and obligations conferred by this act upon the original manufacturer, bottler or seller, relative to said bottles, siphons, siphon tops, tins, fountain tanks, kegs or other containers so assigned, provided such assignee shall, upon such assignment, file in the office of the Secretary of State and also in the office of the clerk of courts of the county in which his or its principal place of business is situated a certificate of said assignment, and cause such certificate to be printed once in each week for three weeks successively in a newspaper published in such county. If the principal place of business of such assignee is in another state the filing of such certificate of assignment shall be made in the office of the Secretary of State and also in the office of the clerk of courts in any county of this state, and printed once in each week for three weeks successively in a newspaper published in such county.

SECTION 13169-2. It is hereby declared unlawful for any person, firm or corporation to fill or refill with soda water, mineral or aërated waters, ginger ale, porter, ale, beer, cider, small beer, milk, cream, lager beer, weiss beer, white beer or other beverages, or with medicines, medical preparations, perfumery, oils, compounds, or mixtures, with intent to sell such contents, any bottle, siphon, siphon top, tin, fountain tank, keg, or other container so marked or designated as aforesaid by any name, mark or device of which a description shall have been filed and published, as provided in sections 13169 and 13169-1 of this act; or to deface, erase, obliterate, cover up, or otherwise remove or conceal any such name, mark or device thereon, or to sell, buy, give, take, or otherwise dispose of or traffic in such bottles, siphon, siphon top, tin, fountain tank, keg, or other container without the consent of, or unless the same shall have been purchased from the person, firm or corporation whose name, mark or device shall be in or upon the bottle, siphon, siphon top, tin, fountain tank, keg or other container so filled, refilled, trafficked in, used, or handled, as aforesaid. The provisions of this sec-

tion shall not apply to any person, firm or corporation, as to filling or refilling with his or its product any bottle, siphon, tin, fountain tank, keg, or other container owned by or having the name, mark or designation of such person, firm or corporation pursuant to the provisions of this act, when such person, firm or corporation shall have complied with the rules and regulations of the dairy and food division of the Agricultural Commission of Ohio, relative to the cleansing of such bottles, siphons, siphon tops, tins, fountain tanks, kegs, or other containers.

SECTION 13169-3. Whoever violates any of the provisions of this section shall be punished for the first offense by a fine of fifty cents for each and every such bottle, siphon, siphon top, tin, fountain tank, keg, or other container by him so filled, refilled, sold, bought, used, disposed of, bought or trafficked in; and for each subsequent offense by a fine of not more than five dollars for every such bottle, siphon, siphon top, tin, fountain tank, keg, or other container by him so filled, refilled, used, bought, sold, disposed of, bought or trafficked in, or by imprisonment not to exceed ninety days, or by both such fine and imprisonment in the discretion of the magistrate or court before whom such offense shall be tried.

Section 2. That said original section 13169 of the General Code be, and the same is hereby repealed.

The sectional numbers herein are in conformity to the General Code.

EDWARD C. TURNER,
Attorney General.

CHARLES D. CONOVER,
Speaker of the House of Representatives.

JOHN H. ARNOLD,
President of the Senate.

Passed March 24, 1915. Approved April 2, 1915.

FRANK B. WILLIS, *Governor.*

Filed in the office of the Secretary of State at Columbus, Ohio, on the 3rd day of April, A. D. 1915.

CERTIFICATE FOR REGISTRATION OF BOTTLES, SIPHONS, SIPHON TOPS, TINS, FOUNTAIN TANKS, KEGS OR OTHER CONTAINERS.

Application of ——— of ———, Ohio, ———.

Witnesseth: That ———, above named, in compliance with "An Act" of the General Assembly of the State of Ohio, passed March 24, 1915, and approved April 2, 1915, (106 O. L. 108), "to provide for the registration of bottles, siphons siphon tops, tins, fountain tanks, kegs or other containers, and making it unlawful for any person other than the owner thereof to fill, refill, deal or traffic in such bottles and other containers and to repeal original section 13169 of the General Code, and to make such registered mark prima facie evidence of ownership of property bearing such mark," hereby makes application for the registration in the office of the Secretary of State of the State of Ohio and in the office of the Clerk of the Court of Common Pleas of ——— County, Ohio, said ——— having ——— principal place of business ——— by filing this written statement or description verified by affidavit of said mark of ownership used by said ———, to-wit:

——— ———,

By ——— ———.

State of ——— ———,

County of ——— ———, ss:

———, being duly sworn says that he is the ——— of the above named ———, in whose behalf the foregoing application is made; that said ——— has the right to use such name, mark or device, and that no other person, firm, association, union or corporation has the right to use such name, mark or device either in the identical form or any such near resemblance thereto as may be calculated to deceive, and that the description of said mark, name or device is true and correct.

Subscribed in my presence and sworn to before me, this ——— day of ———, A. D. 19—.

——— ———.

NOTE.—The fee for filing this certificate is one dollar ($1), for each name, mark or device.

REGISTRATION OF MARKS OF OWNERSHIP ON PERSONAL PROPERTY.

Application of ——— of ———, Ohio, ———.

Witnesseth: That ———, above named, in compliance with "An Act" of the General Assembly of the State of Ohio, passed May 31, 1911, and approved June 7, 1911 (102 O. L. 513), "to provide for the registration of marks of ownership on personal property, and to make such registered mark prima facie evidence of ownership of property bearing such mark," hereby makes application for the registration in the

office of the Secretary of State of the State of Ohio and in the office of the Clerk of the Court of Common Pleas of ——— County, Ohio, said ——— having ——— principal place of business ———, by filing this written statement or description verified by affidavit of said mark of ownership used by said ———, to-wit:

———,

By ——— ———.

State of ——— ———,
County of ——— ———, ss:

———, being duly sworn says that he is the ——— of the above-named ———, in whose behalf the foregoing application is made; that said ——— has the right to use such mark of ownership, and that no other person, firm, association, union or corporation has the right to use such mark of ownership either in the identical form or any such near resemblance thereto as may be calculated to deceive, and that the fac-similes or counterparts filed therewith are true and correct.

——— ———.

Subscribed in my presence and sworn to before me, this ——— day of ———, A. D. 19—.

NOTE.—The fee for filing this certificate is one dollar ($1).

OKLAHOMA.

Chapter 82, Statutes, Oklahoma, 1903.

SECTION 6728. That all manufacturers or dealers in carbonated goods, soda waters, mineral or aërated waters, porter, ale, beer, cider or other beverages, requiring the use of kegs, casks, barrels, boxes, siphons, bottles or any other vessels for containers, on which the names, brands, marks or trademarks or other designation of ownership or proprietorship is stamped, engraved, etched, blown in, impressed or otherwise produced upon such kegs, casks, barrels, boxes, siphons, bottles or any other vessels for containers, may file in the office of the Secretary of the Territory of Oklahoma a fac-simile or description of the name or names, marks or devices, so used by such manufacturer or dealer in any such wares herein enumerated and cause such description to be published in a public newspaper published at the capital of said territory for two successive weeks and the fact of so filing and causing to be recorded by said Secretary of the Territory of Oklahoma and publishing shall operate as a trademark, entitling the said manufacturer to the sole and

exclusive use in Oklahoma Territory of said mark, name or device.

SECTION 6734. Every such person, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement as provided in section 1 of this act, shall file the same for record in the office of the Secretary of the Territory of Oklahoma, by leaving two copies, counterparts or fac-similes thereof with said secretary, and by filing therewith a sworn application specifying the name and names of the person, association, or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trademark, term, device, or form of advertisement. Said Secretary of the Territory shall not record for any person, union or association any label, trademark, term, design, device or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement.

NOTE.—No official form of application is provided.

OREGON.

Chapter 97, Laws 1911.

AN ACT to provide for the registration by any person, partnership, firm or private corporation desiring to secure within the State of Oregon the exclusive use of any trademark; to provide for the registration of such trademark with the Secretary of State and fees to be charged therefor; defining term "trademark," "affixing," "article of merchandise," and "imitation," making an infringement or unauthorized use of a trademark a misdemeanor and providing penalties therefor, and repealing sections 6052, 6053, 6054, 6055, 6056, 6057, 6058 and 6059, of Lord's Oregon Laws.

Be it enacted by the People of the State of Oregon:

Be it enacted by the Legislative Assembly of the State of Oregon:

SECTION 1. "TRADEMARK" DEFINED. A "trademark" is a mark used to indicate the maker, owner, or seller of an article of merchandise and includes, among other things, any name of a person, partnership, firm, or private corporation, or any letter, word, device, emblem, figure, seal, stamp, brand, wrapper, ticket, stopper, label or other mark, lawfully adopted by him, and usually affixed to any article of merchandise to denote that the same was imported, manufactured, produced, sold, compounded, bottled, packed or otherwise prepared by him; and also a signature or mark, used or commonly placed by a painter, sculptor or other artist upon a painting, drawing, engraving, statue, or other work of art to indicate that the same was designed or executed by him

SECTION 2. "AFFIXING" DEFINED. A trademark is deemed to be affixed to an article of merchandise when it is placed in any manner in or upon: (1) the article itself; or (2) a box, bale, barrel, bottle, case, cask, platter, or other vessel or package, or a cover, wrapper, stopper, brand, label, or other thing in, by, or with which the goods are packed, enclosed or otherwise prepared for sale or disposition.

SECTION 3. "ARTICLE OF MERCHANDISE" DEFINED. The expression "article of merchandise," as used in this act, signifies any goods, wares, works of art, commodity, compound, mixture or other preparation or thing, which may be lawfully kept or offered for sale.

SECTION 4. "IMITATION OF TRADEMARK" DEFINED. An "imitation of trademark" is that which so far resembles a genuine trademark as to be likely to induce the belief that it is genuine, whether by use of words or letter, similar in appearance or in sound, or by any sign, device or other means whatsoever.

SECTION 5. APPLICATION FOR TRADEMARK. Any person, partnership, firm, or private corporation desiring to secure within the state of Oregon the exclusive use of any trademark for any article of merchandise, shall make application to the Secretary of State upon a blank furnished for that purpose for the registration of such trademark, which application shall be accompanied by particular description or a fac-simile of such trademark as he may desire to use, and the description of the article or articles of merchandise to which such trademark is to be applied.

SECTION 6. SIMILAR TRADEMARKS NOT ALLOWED. If there be not already a claim or application filed with the Secretary of State for the same, or a similar trademark, or a trademark so closely resembling the one applied for as to cause confusion, he shall immediately file such application and record the same in a book, to be especially provided and kept by him for such purpose, which book shall be at all times subject to public inspection and examination. If there be already filed the same or any similar trademark, or a trademark so closely resembling same as to be likely to cause confusion or be misleading, the secretary shall so inform the applicant and shall not file or record the same; *provided*, that no trademark shall be granted for a word or generic term, which by general or common use is descriptive of or characterizes a particular article to which it pertains rather than its origin or proprietorship.

SECTION 7. FEE FOR FILING TRADEMARK. Upon filing a trademark by the Secretary of State the owner or person offering the same for filing shall pay a fee of five dollars for filing and recording same. And no trademark shall be filed until such fee be paid.

SECTION 8. NOTICE OF FILING TRADEMARK. Upon the filing of a trademark by the Secretary of State, the owner thereof shall cause to be published in some newspaper published in the county in which the principal office or place of business of such owner is located, once a week for three successive weeks, a notice

setting forth the description of such trademark, and article or articles of merchandise to which it is to be applied, together with the name of the person, partnership, firm or private corporation owning same; after such registration and publication of notice as hereinbefore provided the person, partnership, firm or private corporation shall thereupon be deemed the proprietor of such trademark and exclusive owner thereof.

SECTION 9. CORPORATION NAME CAN NOT BE USED AS TRADEMARK. No person, partnership, firm, or private corporation can file or use as the trademark the name of any foreign or domestic corporation of record under the laws of the state of Oregon at the time of making such application for trademark, and the Secretary of State, if in his opinion any trademark offered for filing and record shall so closely resemble the name of a foreign or domestic corporation of record under the laws of the state of Oregon as to be likely to cause confusion, shall so inform the applicant and shall not file same.

SECTION 10. INFRINGEMENT OF TRADEMARK. Any person, partnership, firm, or private corporation that shall use or cause to be used any trademark owned by another, or use words or letters similar in appearance or in sound, or by any sign, device or other means whatsoever imitate such trademark without the owner's consent, or shall have in his possession a counterfeit trademark, knowing it to be a counterfeit, or die, plate, brand or anything for the purpose of falsely making or imitating a trademark without the owner's consent, or shall knowingly sell or expose for sale any article of merchandise to which such false or imitation trademark is attached without the consent of the owner of such trademark shall be guilty of a misdemeanor, and upon conviction thereof shall be punished by a fine of not less than fifty dollars or more than one hundred dollars, or imprisonment in the county jail for not less than twenty days, nor more than fifty days, or both such fine and imprisonment.

SECTION 11. FORFEITURE OF PROPERTY BEARING INFRINGEMENT OF TRADEMARK. Any person, partnership, firm or private corporation that shall use or cause to be used any name, brand, mark or description, whether by the use of words or letters similar in appearance or sound, or by any sign, device or other means whatsoever imitate a trademark filed and recorded, upon any article of merchandise for the purpose of deception or profit,

shall forfeit to the use of the owner of the said trademark so taken or substituted the property or article upon which the same is placed or used, or the value thereof to be recovered by said owner in any court having jurisdiction of the subject-matter.

SECTION 12. PROVISIONS AS TO CERTIFICATE OF FILING TRADEMARK. The Secretary of State shall, upon filing trademark as hereinbefore provided, deliver to the person, partnership, firm or private corporation so filing the same a certificate, under the seal of the state, of the record of such trademark, and article or articles of merchandise to which it is applied. Such certificate granted by the Secretary of State under this act, and proof of publication as hereinbefore provided, shall be *prima facie* evidence of the ownership of any such trademark therein described named in any prosecution or action under any of the statutes of this state, where proof of such ownership and use is necessary, and any action or proceeding brought for the purpose of recovering damages for the violation of said trademark, or of preventing infringement thereof. This statute, however, shall not be construed as preventing the proof of any such trademark, and the use thereof in any other lawful manner in use prior to the passage of this act. The Secretary of State shall not record, register, or file any trademark so similar to any other trademark heretofore filed or registered as would be calculated to deceive, unless it should be proven to his satisfaction that the person, partnership, firm, or private corporation last applying for the registration of such trademark shall be entitled thereto and the rightful owner thereof by prior adoption, in which case the date of the adoption shall determine the ownership and shall be proven by affidavits of persons conversant with such dates. In case the Secretary of State becomes satisfied after hearing the said affidavits that the person, partnership, firm, or private corporation last applying for registry is entitled by priority of adoption to register such trademark, he shall revoke the first registry and re-register the same in the name of the person last applying therefor. Any court of competent jurisdiction may also in an action brought for that purpose by any person aggrieved thereby against any person, partnership, firm, or private corporation, who has already filed

or registered any such trademark, direct the revocation of any such registration, where it shall determine that the person who has already registered the same is not the rightful owner of such trademark.

SECTION 13. TRADEMARKS HERETOFORE FILED. Any person, partnership, firm, or private corporation that has heretofore filed under the provisions of law existing at the time of such filing shall not be required to again file and publish such descriptions, to be entitled to the benefits of this act.

SECTION 14. RIGHT TO ENJOIN INFRINGEMENT CONTINUES. Nothing in this act shall be construed so as to affect the power of courts of equity to perpetually restrain by injunction the improper use of any trademark, which may have been secured by the provisions of this act or other provisions of law.

SECTION 15. REPEALING CONFLICTING LAWS. Secs. 6052, 6053, 6054, 6055, 6056, 6057, 6058 and 6059 of Lord's Oregon Laws are hereby repealed.

Filed in the office of the Secretary of State, February 18, 1911.

APPLICATION TO REGISTER A TRADEMARK IN THE STATE OF OREGON.

———, 19—.

To the Secretary of State:

———, whose place of business is ——— Street, City of ———, County of ———, State of ———, desiring to secure within the State of Oregon the sole and exclusive use of a trademark in accordance with the provisions of "An Act to provide for the registration by any person, partnership, firm or private corporation, desiring to secure within the State of Oregon, the exclusive use of any trademark, etc.," filed in the office of the Secretary of State, February 18, 1911, hereby presents this application for the registration of such trademark, described as follows: ———, a *fac-simile* of which is marked "Exhibit A," hereto attached. This trademark, as shown in the Exhibit, is to be placed upon the following articles of merchandise: ———.

And by reason of priority of adoption of the trademark herein described and shown in the Exhibit hereto attached, the said ——— [*name of person, partnership, firm or private corporation*] hereby claims the right to the sole and exclusive use of the same within the State of Oregon for the uses and purposes herein stated. A fee of five ($5.00) dollars pro-

vided by law for issuing Certificate of Registration for such trademark is tendered herewith.

———— ————,
———— ————.

NOTE.—Enclosed with the application should be two (2) extra *facsimiles* of trademark printed, impressed, or made upon thin, durable paper for attaching to the book of Records of Trademarks. A fee of $5.00 must be sent with the application.

APPLICATION TO REGISTER A TRADEMARK IN THE STATE OF OREGON.

THIS FORM TO BE USED WHEN APPLICANT IS A CORPORATION.

————, 19—.

To the Secretary of State of the State of Oregon, Salem, Oregon:

————, whose place of business is ———— Street, City of ————, County of ————, State of ————, desiring to secure within the State of Oregon the sole and exclusive use of a trademark in accordance with the provisions of "An Act to provide for the registration by any person, partnership, firm or private corporation, desiring to secure within the State of Oregon, the exclusive use of any trademark, etc.," filed in the office of the the Secretary of State, February 18, 1911, hereby presents this application for the registration of such trademark, described as follows: ————, a *fac-simile* of which is marked "Exhibit A," hereto attached. This trademark, as shown in the Exhibit, is to be placed upon the following articles of merchandise: ————.

And by reason of priority of adoption of the trademark herein described and shown in the Exhibit hereto attached, the said ———— [*name of private corporation*] hereby claims the right to the sole and exclusive use of the same within the State of Oregon for the uses and purposes herein stated. A fee of five ($5.00) dollars provided by law for issuing Certificate of Registration for such trademark is tendered herewith.

In witness whereof, said corporation has caused this application to be executed in its name by its ———— President and ———— Secretary and its Corporate Seal to be hereto affixed the ———— day of ————, 19—.

[Corporate Seal.]

————, [Seal].
————, *President.*
————, *Secretary.*

NOTE.—Enclosed with the application should be two (2) extra *facsimiles* of trademark printed, impressed, or made upon thin, durable paper for attaching to the book of Records of Trademarks. A fee of $5.00 must be sent with the application.

PENNSYLVANIA.

Act of April 24, 1905, No. 210.

AN ACT amending the third section of the act, entitled "An act to provide for the registration of labels, trademarks, tradenames, stamps, designs, devices, shopmarks, terms, brands, designations, descriptions, or forms of advertisement, and protect and secure the rights, property and interests therein of the persons, copartnerships or corporations adopting and filing the same, and providing penalties for the violations of the act," approved the twentieth day of June, Anno Domini one thousand nine hundred and one; so as to further protect and secure the rights, property and interest of persons, corporations or copartnerships adopting and registering said labels, trademarks, tradenames, stamps, designs, devices, shopmarks, terms, brands, designations, descriptions or forms of advertisement.

SECTION 1. *Be it enacted, etc.*, That the third section of the act, entitled "An act to provide for the registration of labels, trademarks, tradenames, stamps, designs, devices, shopmarks, terms, brands, designations, descriptions or forms of advertisement, and protect and secure the rights, property and interest therein of the persons, copartnerships or corporations adopting and filing the same, and providing penalties for the violation of the act," approved the twentieth day of June, Anno Domini one thousand nine hundred and one, which reads as follows:

"Section 3. That whenever person or persons, copartnership or corporations, has heretofore adopted and filed for record or registry, or shall hereafter adopt and file for registry, any label, trademark, tradename, device, shopmark, designation, or form of advertisement, as herein provided, it shall be unlawful, and a violation of this act, for any other person, copartnership or corporation to make any use, sale, offer for sale, or display of the genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, or any such likeness or imitation thereof as shall be calculated or liable to deceive, of any such person or persons, copartnership or corporations, filing the same; or to sell, offer to sell, or dispose of, any goods, wares or merchandise, in bulk, or in any box, case, can, bottle or package to or which any such genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, filed for record as aforesaid, or any such likeness or imitation thereof, is attached, affixed or displayed; or to make

any wrongful use whatever of any such genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, or any such likeness or imitation thereof; or to in any way use the name or seal of any such person or persons, copartnership or corporation, or any such likeness or imitation thereof, in and about the sale of goods or otherwise, without first obtaining in every such case the license, consent or authority of the person or persons, copartnership or corporation, adopting, filing and registering the same; and it shall be unlawful for any other person or persons, firm, copartnership, or corporation to make any use of such label, trademark, tradenames, device, shopmark, designation, or form of advertisement, so filed, or any such likeness or imitation thereof, or utter or display the same orally or in any printed or written form in the conduct of his business or in any business transaction, attached to merchandise or products of labor, or detached from and independent of the same, on invoice, letterheads, bills or advertisements, without express consent, license and authority of the person or persons, copartnership or corporation, so filing the same; and any such license, consent or authority may be revoked and terminated at any time, upon notice, and thereafter any use thereof shall be a violation of this act, and subject those violating the same to all the liabilities and penalties herein provided against any violation thereof. He shall refuse to file or register any label, trademark, tradename, device, shopmark, designation, or form of advertisement, identical with, or so similar to as to be calculated or liable to deceive, any label, trademark, tradename, device, shopmark, designation, or form of advertisement, filed and registered, unless it shall be proved to his satisfaction that the person or persons, copartnership or corporation, lastly applying for the registry of such label, trademark, tradenames, device, shopmark, designation, or form of advertisement, shall be entitled thereto, and the owner thereof by right of prior adoption; in which case the date of adoption shall determine the ownership, and shall be proved by affidavits of persons conversant with such dates. In case the Secretary of State becomes satisfied, after hearing the said affidavits, that the person or persons, copartnership or corporation, last applying for registry is entitled to priority of adoption to register such trademark, tradename, device, shopmark, designation, or

form of advertisement, he shall revoke the first registry thereof, and re-register the same in the name of said applying person or persons, copartnership or corporations," be and the same is hereby amended so as to read as follows:

SECTION 3. That whenever person or persons, copartnership or corporations, has heretofore adopted and filed for record or registry, or shall hereafter adopt and file for registry, any label, trademark, tradename, device, shopmark, designation, or form of advertisement, as herein provided, it shall be unlawful and a violation of this act for any other person, copartnership, or corporation to make any use, sale, offer for sale, or display of the genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, or any such likeness or imitation thereof, as shall be calculated or liable to deceive, of any such person or persons, copartnership or corporations, filing the same; or to sell, offer to sell, or dispose of any goods, wares, or merchandise, in bulk, or in box, case, can, bottle or package to or which any genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, filed for record as aforesaid, or any such likeness or imitation thereof, is attached, affixed or displayed; or to make any wrongful use whatever of any such genuine label, trademark, tradename, device, shopmark, designation, or form of advertisement, or any such likeness or imitation thereof; or to, in any way, use the name or seal of any such person or persons, copartnership or corporation, or any other likeness or imitation thereof, in and about the sale of goods, or otherwise, without first obtaining, in every such case, the license, consent or authority of the person or persons, copartnership or corporation adopting, filing and registering the same; and it shall be unlawful for any other person or persons, firm, copartnership, or corporation to *remove any such label, trademark, tradename, device, shopmark, designation, or form of advertisement, so registered as aforesaid and attached to merchandise or products of labor, for the purpose of using such merchandise or products of labor as a pattern for the reproduction of the same: Provided however, That nothing herein contained shall be taken to prohibit the using of such merchandise or products of labor as a pattern for the reproduction of the same, in individual cases of emergency repair. And it shall be unlawful for any other person or persons, firm, co-*

partnership, or corporation to make any use of such label, trademark, tradename, device, shopmark, designation, or form of advertisement, so filed, or any such likeness or imitation thereof, or utter or display the same orally or in any printed or written form in the conduct of his business or in any business transaction, attached to merchandise or products of labor, or detached from and independent of the same, on invoice, letterheads, bills, or advertisements, without express consent, license and authority of the person or persons, copartnership or corporation, so filing the same; and any such license, consent or authority may be revoked and terminated at any time, upon notice, and thereafter any use thereof shall be a violation of this act, and subject those violating the same to all the liabilities and penalties herein provided against any violation thereof. He shall refuse to file or register any label, trademark, tradename, device, shopmark, designation, or form of advertisement, identical with, or so similar to as to be calculated or liable to deceive, any label, trademark, tradename, device, shopmark, designation, or form of advertisement, filed or registered, unless it shall be proved to his satisfaction that the person or persons, copartnership or corporation, lastly applying for the registry of such label, trademark, tradename, device, shopmark, designation, or form of advertisement, shall be entitled thereto, and the owner thereof by right of prior adoption; in which case the date of adoption shall determine the ownership, and shall be proved by affidavits of persons conversant with such dates. In the case the Secretary of State becomes satisfied, after hearing the said affidavits, that the person or persons, copartnership or corporation, last applying for registry is entitled to priority of adoption to register such trademark, tradename, device, shopmark, designation, or form of advertisement, he shall revoke the first registry thereof, and re-register the same in the name of said applying person or persons, copartnership or corporations.

To the Secretary of the Commonwealth of Pennsylvania:

Sir:—

In compliance with the requirements of an Act of the General Assembly of the Commonwealth of Pennsylvania, entitled "An Act to provide for the registration of labels, trademarks, tradenames, stamps, designs, devices, shopmarks, terms, brands, designations, descriptions, or forms of advertisement, and protect and secure the rights, property and inter-

est therein of the persons, copartnerships or corporations adopting and filing the same, and providing penalties for the violation of the act," approved the 20th day of June, A. D. 1901, the undersigned, ——— resident or doing business in the United States, having heretofore adopted or used, or desiring to adopt or use a ———, for the purposes provided in said act, and desiring to file the same for record in the office of the Secretary of State of the State of Pennsylvania, do hereby certify:

1st. The name of the person or persons, copartnership or corporation so filing, is ——— [*if a corporation give State under which organized*].

2nd. His or its residence, location or place of business, ———.

3rd. The class of merchandise, and the particular description of goods comprised therein ———.

The trademark consists of ———.

4th. The class to which it has been or is intended to be appropriated ———

5th. The length of time, if any, during which it has been in use ———.

——— ———,

[*Signature of applicant.*]

State of ——— — —,
County of ——— — —, ss:

Personally appeared before me, this ——— day of ———, A. D. 19—, ———, who, being duly sworn, according to law, deposes and says that the statements contained in the foregoing instrument are true; that the ——— so filing such ———, has a right to use the same, and that no other person or persons, copartnership or corporation, has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-similes, copies or counterparts filed herewith are true and correct.

Sworn and subscribed before me, the day and year aforesaid, ss:

[Seal.]

——— ———.

[*Signature of affiant.*]

NOTE.—Two copies of the trademark must be filed with the application. The application itself should not be in duplicate. Fee for filing and certificate, two dollars.

RHODE ISLAND.

General Laws, 1909, Chapter 196.
Public Laws of 1900-1, Chapter 735.

AN ACT for the protection of labels and seals of labor organizations, associations and societies in the State of Rhode Island and Providence Plantations.

SECTION 1. Whenever any person, or any association or union of workingmen, has heretofore adopted or used, or shall here-

after adopt or use, any label, trademark, term, design, device, or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or other product of labor as having been made, manufactured, produced, prepared, packed, or put on sale by such person, or association or union of workingmen, or by a member, or members, of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device, or form of advertisement.

SECTION 2. Whoever knowingly counterfeits or imitates any such label, trademark, term, design, device, or form of advertisement which has been filed and recorded in the office of the Secretary of State as hereinafter provided; or knowingly sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement; or knowingly keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped, or impressed; or knowingly sells or disposes of any goods, wares, merchandise, or other product of labor contained in any box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed; or knowingly keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor in any box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed, shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than three months.

SECTION 3. Every such person, association, or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement as provided in section 1 of this act, shall file the same for record in the office of the Secretary of State by leaving two copies, counter-

parts, or *fac-similes* thereof, with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association, or union on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed; the class of merchandise, and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed, has the right to the use of the same, that no other person, firm, association, union, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac-simile* or counterparts filed therewith are true and correct, before there shall be any liability to any suit or proceeding for any violation of this act. There shall be paid for such filing and recording a fee of one dollar. Said Secretary of State shall cause a description of such label, trademark, term, design, device, or form of advertisement to be published once a week for three successive weeks, at the expense of the applicant, in some newspaper published in the city of Providence. After such publication said secretary shall deliver to such person, association, or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, association, or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, term, design, device, or form of advertisement. Said Secretary of State shall not record for any person, union, or association any label, trademark, term, design, device, or form of advertisement that would probably be mistaken for any label, trademark, term, design, device, or form of advertisement theretofore filed by or on behalf of any other person, union, or association.

SECTION 4. Any person who shall, for himself or on behalf of any other person, association, or union, procure the filing of any label, trademark, term, design, or form of advertisement in the office of the Secretary of State under the provisions of

this act by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars, or by imprisonment not exceeding three months. In any suit or prosecution under the provisions of this act, the defendant may show that he or it was the owner of such label, trademark, term, design, device, or form of advertisement prior to its being filed under the provisions of this act, and that it had been filed wrongfully or without right by some other person, association or union.

SECTION 5. Every such person, association, or union adopting or using a label, trademark, term, design, device, or form of advertisement, as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction may grant injunctions to restrain such manufacture, use, display, or sale, and may award the complainant in any such suit damages resulting from such manufacture, use, sale, or display, as may be by the said court deemed just and reasonable, and may require the defendants to pay such person, association or union all profits derived from such wrongful manufacture, use, display, or sale; and such court may also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

SECTION 6. Any person or persons who shall in any way use the name or seal of any such person, association, or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use the same, shall be guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months or by a fine of not more than one hundred dollars.

SECTION 7. The provisions of this act shall not abridge any rights to any trademarks existing at the time of the passage of this act, whether the same shall be recorded or not, nor any remedies or rights of action otherwise or theretofore existing in favor of owners of trademarks.

SECTION 8. The district courts of the several judicial districts shall have jurisdiction of all complaints for violation of this act.

SECTION 9. This act shall take effect and be in force from and after the first day of June, A. D. 1900, and all acts and parts of acts inconsistent herewith are hereby repealed.

Chapter 627, Pub. Laws 1898-1899, relates to the protection of bottles, barrels, kegs, casks, cans, etc., of manufacturers, bottlers, and vendors of soda water, mineral water, ale, beer, or other liquids that may be used as foods or beverages, or medicines, perfumery, oils, compounds, etc.

Rhode Island Laws 1909, chap. 198. "Of the protection of owners of cans, bottles, and other vessels used in the sale of mineral waters, milk, beer, cider, wine, or other beverages and compounds" is constitutional. *State v. Hand Brewing Co.*, 32 R. I. 56, 78 Atl. Rep. 499.

STATE OF RHODE ISLAND, ETC.

Application, accompanying a ——— [*insert label, trademark, term, design, device, or form of advertisement as the case may be*] filed in accordance with the provisions of Chapter 196 of the General Laws of Rhode Island, 1909, entitled "Of the Protection of Labels and Seals of Labor Organizations."

Name of person, association or union ———.

Class of merchandise and description of the goods to which the ——— [*insert label, trademark, term, device, or form of advertisement, as the case may be*] has been or is intended to be appropriated, ———.

The essential feature of said ——— [*insert label, trademark, term, device, or form of advertisement, as the case may be*] consists of ——— [*give what is considered to be the essential feature or features thereof*].

The style and size of type, and color of ink and paper ——— [*use the word "may" or the words "will not" as the case may be*] be varied at pleasure.

I, ———, do hereby declare, in accordance with the provisions of said Chapter 196 of the General Laws of Rhode Island, 1909, that ——— ha— [*have or has*] a right to the use of the same ——— referred to in the foregoing application, that no other person, firm, association, union or corporation has the right to such use, either in the identical form or

in any such near resemblance thereto as may be calculated to deceive, and that the *fac-simile* or counterparts filed therewith are true and correct.

In witness whereof, I have hereunto signed my name this ——— day of ———, in the year nineteen hundred —.

——— [*Sign here*].

———, 19—.

State of ——— ———,

County of ——— ———, ss:

Then personally appeared the above named ——— and made oath that the foregoing declaration by him subscribed is true and correct.

Before me.

——— ———,

Notary Public.

SOUTH CAROLINA.

AN ACT for the protection of labels and seals of labor organizations, associations and societies in the State of South Carolina.

SECTION 1. *Be it enacted* by the General Assembly of the State of South Carolina, Whenever any person, or any association or union of workingmen, has heretofore adopted or used, or shall hereafter adopt or use, any label, trademark, term, design, device or form of advertisement for the purpose of designation, making known, or distinguishing any goods, wares, merchandise, or other product of labor as having been made, manufactured, produced, prepared, packed, or put on sale by such person, or association, or union of workingmen, or by a member, or members, of such association or union, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device, or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device, or form of advertisement.

SECTION 2. Whoever knowingly counterfeits or imitates any such label, trademark, term, design, device, or form of advertisement which has been filed and recorded in the office of Secretary of State, as hereinafter provided, or knowingly sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device, or form of advertisement, or knowingly keeps or has in

his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped, or impressed; or knowingly sells or disposes of any goods, wares, merchandise, or other product of labor contained in any box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed, or knowingly keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor in any box, case or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed, shall be punished by a fine of not more than one hundred dollars or by imprisonment for not more than three months.

SECTION 3. Every such person, association, or union, that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device, or form of advertisement, as provided in section 1 of this act, shall file the same for record in the office of the Secretary of State by leaving two copies, counterparts or *fac-similes* thereof with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association, or union on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed, the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating the parties so filing, or on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed, has the right to the use of the same; that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac-simile* or counterparts filed therewith are true and correct, before there shall be any liability to any suit or proceeding for any violation of this act. There shall be paid for such filing and recording a fee of one dollar. Said Secretary of State shall cause a description of such label, trademark, term, design, device, or form of advertisement to be published once a week for three successive weeks, at the expense of the appli-

cant, in some newspaper published in the city of Columbia. After such publication said secretary shall deliver to such person, association, or union, so filing or causing to be filed any such label, trademark, term, design, device, or form of advertisement, so many duly attested certificates of the recording of the same as such person, association, or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificate of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, design, term, device, or form of advertisement. Said Secretary of State shall not record for any person, union or association any label, trademark, term, design, device, or form of advertisement that would probably be mistaken for any label, trademark, term, design, device, or form of advertisement theretofore filed by or on behalf of any other person, union, or association.

SECTION 4. Any person who shall, for himself or on behalf of any other person, association or union, procure the filing of any label, trademark, term, design, device, or form or advertisement in the office of the said Secretary of State, under the provisions of this act, by making any false or fraudulent representations or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months. In any suit or prosecution under the provisions of this act the defendant may show that he or it was the owner of such label, trademark, term, design, device, or form of advertisement prior to its being filed under the provisions of this act, and that it has been filed wrongfully or without right by some other person, association or union.

SECTION 5. Every such person, association, or union, adopting or using a label, trademark, term, design, device, or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction may grant injunctions to restrain such manufacture, use, display,

or sale, and may award the complainant in any such suit damages resulting from such manufacture, use, sale or display, as may be by said court deemed just and reasonable, and may require the defendants to pay to such person, association, or union, all profits derived from such wrongful manufacture, use, display or sale; and such court may also order that all such counterfeits or imitations in the possession or under the control of any defendants in such case to be delivered to an officer of the court, or to the complainant, to be destroyed. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union, on behalf of and for the use of such association or union.

SECTION 6. Any person or persons who shall in any way use the name or seal of any such person, association, or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to use same, shall be guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

SECTION 7. The provisions of this act shall not abridge any rights to any trademark existing at the time of the passage of this act, whether the same shall be recorded or not, nor any remedies or rights of action otherwise or theretofore existing in favor of owners of trademarks.

SECTION 8. The judicial courts of the several judicial districts shall have jurisdiction of all complaints for violations of this act.

Approved the 24th day of February, A. D. 1910.

APPLICATION TO RECORD UNION LABEL OR TRADEMARK.

State of ——— ———,
County of ——— ———, ss:

To the Secretary of the State of South Carolina:

I, ——— [*insert name of person making the affidavit*], being first duly sworn, on oath say, I am the ——— [*insert person, president, secretary, or manager*] of the ——— [*insert name of association or union of workingmen*] and that ——— [*insert name of association or union of workingmen*] has adopted and used as a ——— [*insert whether label, trademark, term, design, or form of advertisement*], as provided by an

Act of the General Assembly of the State of South Carolina, entitled "An Act for the protection of labels and seals of labor organizations, associations and societies in the State of South Carolina," approved February 24, 1910, the following ——— [*insert whether label, trademark, term, design, or form of advertisement*] two ——— [*insert trademark or label*] of which are herewith filed in the office of the Secretary of State; that the name of the ——— [*insert whether person, association, or union of workingmen*] making this application for such ——— [*insert whether label, trademark, term, design, or form of advertisement*] is ——— [*insert name of association or union of workingmen*]; that the class of merchandise and description of the goods to which such ——— [*insert whether label, trademark, term, design, or form of advertisement*] has been and is intended to be appropriated, and the ——— [*insert whether copies, counterparts, or fac-similes*] are as follows, to wit: ——— [*insert class of merchandise and a description of the goods to which the trademark, etc., is to be appropriated*] ——— [*insert trademark or label*] and that the ——— [*insert whether person, association, or union of workingmen*] filing this application has the sole right to use said ——— [*insert whether label, trademark, term, design, or form of advertisement*], and that no other person, firm, association, union, or corporation has the right to use the said ——— [*insert whether label, trademark, term, design, or form of advertisement*] either in the identical form of the copies or *fac-similes* herewith filed with the said Secretary of State, or in any such near resemblance thereto as may be calculated to deceive, and that the copies or *fac-similes* of said ——— [*insert whether label, trademark, term, design, or form of advertisement*] filed herewith, are true and correct.

——— ———,

[*Insert name of person making the affidavit.*]

——— ———,

[*Insert person, president, secretary, or manager.*]

Subscribed and sworn to before me this ——— day of ———, 19—.

——— ———,

Notary Public in and for the State of ———.

Send copy or *fac-simile* of label or trademark for each certificate required.

Applications must be filed in duplicate.

SOUTH DAKOTA.

POLITICAL CODE, 1903.

SECTION 3190. It shall be lawful for associations and unions of workingmen to adopt, for their protection, labels, trademarks, and advertisements, used by such unions or associations, announcing that goods manufactured by members of such associations or unions are so manufactured by such members.

SECTION 3191. Any and all persons using such union or association trademarks, labels or advertisement, whether exactly like such labels, trademarks or advertisements or not, if with the intention to, or likely to, deceive the public, shall be guilty of a misdemeanor and on conviction thereof shall be punished by imprisonment of not less than ten days nor more than thirty days, or a fine of not less than twenty-five dollars nor more than one hundred dollars, or both.

SECTION 3192. Every person who shall use any such counterfeited trademark, label or advertisements of such a union or association, after having been notified that the same is so counterfeited, shall be guilty of a misdemeanor and on conviction thereof shall be punished by imprisonment of not less than ten days nor more than thirty days, or by fine of not less than twenty-five dollars nor more than one hundred dollars, or both.

SECTION 3193. Every association of workingmen or labor union adopting a label, trademark or advertisement of the kind specified in section 3190, shall record the same in the office of the Secretary of State by leaving two copies of said labels or advertisements with said Secretary of State, who shall, under his hand and seal, deliver to the association or union recording such label or advertisements a certificate of record for which he shall receive a fee of one dollar.

SECTION 3194. Every association or labor union adopting a label, trademark or advertisement of the kind specified in section 3190 may proceed by suit in any of the courts of the state to enjoin the manufacture, use, display or sale of counterfeits or imitations of such labels, trademarks, or advertisements, and that all courts having jurisdiction of the persons, and upon satisfactory proof of such wrongful use, shall grant an injunction for such wrongful use of such counterfeits, and shall award the complainant such damages resulting from such wrongful use as may be proved, and shall require the defendants to pay to the complainant the profits derived from such wrongful use, or both profits and damages; and the court shall also order all counterfeit labels and advertisements in the possession or under the control of the defendant in such cause to be delivered to an officer of the court or to the complainants, to be destroyed.

SECTION 3195. In like manner such unions or associations of workingmen shall be authorized to proceed against all persons who shall wrongfully use or display the genuine labels or advertisements of the respective associations or unions, not being authorized by such associations or unions to use or display the same, in any court having jurisdiction thereof.

CIVIL CODE, 1903.

SECTION 183. There may be ownership of all inanimate things which are capable of appropriation, or of manual delivery; of all domestic animals; of all obligations; of such products of labor or skill, as the composition of an author, the goodwill of a business, trademarks and signs, and of rights created or granted by statute.

SECTION 892. One who produces or deals in a particular thing, or conducts a particular business, may appropriate to his exclusive use, as a trademark, any form, symbol or name which has not been so appropriated by another, to designate the origin or ownership thereof; but he can not exclusively appropriate any designation, or part of a designation, which relates only to the name, quality or description of the thing or business, or the place where the thing is produced or the business is carried on.

SECTION 1331. One who sells or agrees to sell any article to which there is affixed or attached a trademark, thereby warrants that mark to be genuine and lawfully used.

PENAL CODE, 1903.

SECTION 421. Every person who wilfully forges, counterfeits or procures to be forged or counterfeited any trademark usually affixed by any person to any goods of such person, with intent to pass off any goods to which such forged or counterfeit trademark is affixed, or intended to be affixed, as the goods of such person, is guilty of a misdemeanor.

SECTION 422. Every person who, with intent to defraud, has in his possession any die, plate or brand, or any imitation of the trademark of any person, for the purpose of making any counterfeit or imitation of any description whatever of such

trademark, or of selling the same when made, or affixing the same to any goods, and selling or offering the same for sale or disposal as the original goods of any other person, and every person who so uses or sells the same, or who fraudulently uses the genuine trademark of another with intent to sell or offer for sale or disposal, any goods not the goods of the person to whom such trademark properly belongs, as genuine and original, is guilty of a misdemeanor.

SECTION 423. Every person who sells or keeps for sale any goods upon which any counterfeited trademark has been affixed, intended to represent such goods as the genuine goods of another, knowing the same to be counterfeited, is guilty of a misdemeanor.

SECTION 424. Every person who, with intent to defraud, affixes or causes to be affixed to any goods, or to any bottle, case, box or other package containing any goods, any description of label, stamp, brand, imprint, printed wrapper, label or mark, which designates such goods by any word or token which is wholly or in part the same to the eye, or to the ear, as the word or any of the words or tokens used by any other person as his trademark, and any person who knowingly sells, or keeps or offers for sale, any such bottle, case, box or other package, with any such label, stamp, brand, imprint, printed wrapper, ticket or mark affixed to or upon it, in case the person affixing or causing to be affixed such mark, or so selling, or exposing, or offering for sale such bottle, case, box or other package, was not the first to employ or use such words as his trademark, is guilty of a misdemeanor, and, in addition to the punishment prescribed therefor, is liable to the party aggrieved in the penal sum of one hundred dollars for each and every offense, to be recovered by him in a civil action.

SECTION 425. The word "trademark," as used in the sections preceding, includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label or wrapper, usually affixed by any mechanic, manufacturer, druggist, merchant or tradesman, to denote any goods to be goods imported, manufactured, produced, compounded or sold by him, other than any name, word or expression generally denoting any goods to be of some particular class or description.

SECTION 426. The word "goods," as used in the sections preceding, includes every kind of goods, wares, merchandise, compound or preparation, which may be lawfully kept or offered for sale.

SECTION 427. The offense of affixing a false trademark to goods is equally complete within the meaning of sections 421, 423 and 424, whether such mark is affixed to the goods themselves, or to any box, bale, barrel, bottle, case, cask, wrapper, or other package or vessel, or any cover or stopper thereof, in which such goods are put up.

SECTION 428. Whenever any person engaged in manufacturing, bottling, selling in bottles, soda, mineral waters, porter, ale, cider or small beer, has filed and published, in the manner authorized by law, a description of a name, mark or label usually stamped by him in the bottles containing such beverage, every other person who, without the written consent of such manufacturer or dealer, refills with any beverage, whether genuine or otherwise, with the intent to sell the same, any bottles stamped with such name, mark or label, and every person who sells, disposes of, purchases or traffics in such bottles, is liable to a penalty of fifty cents for each and every bottle so filled, sold, bought, disposed of, or trafficked in, for the first offense, and five dollars for each and every bottle so filled, bought, disposed of, or trafficked in, for every subsequent offense.

SECTION 429. Every person who keeps any bottles such as are designated in the last section, without the written consent of the manufacturer so to do, with intent to refill or use or sell them in violation of the last section, is liable to the penalty therein prescribed.

SECTION 430. Whenever any manufacturer or dealer designated by section 428, or his agent, shall make oath or affirmation before any magistrate that he has reason to believe and does believe, that any of his bottles stamped and registered as mentioned in said section are being unlawfully used by any person or persons selling or manufacturing mineral water or other beverages, or that any junk dealer or vendor of bottles, has any such bottles secreted in any place, such magistrate shall thereupon issue a search warrant to discover and obtain the

same under the provisions of the law upon search warrants, which are hereby declared to fully relate to the purposes of this chapter; and the magistrate may summarily bring or cause to be brought before him the person in whose possession the bottles are found, to examine into the circumstances of his possession, and if such magistrate on summary examination finds that such person has been guilty of a violation of section 428, such magistrate shall proceed to impose the fine therein prescribed, and, if the same be not paid, to commit such person to prison for a term not exceeding fifteen days.

APPLICATION FOR REGISTRATION OF TRADEMARK.

To the Secretary of State, Pierre, S. D.

State of ——— ———,
County of ——— ———, ss:

———, being duly sworn, deposes and says that he is the President of the ——— Company located in the City of ———, State of ———. That the said ——— Company is the exclusive owner of the trademark described in the specification accompanying this affidavit and he petitions that the said trademark may be filed in the office of the Secretary of State of South Dakota, in accordance with the law in such cases made and provided.

——— ———.

Subscribed and sworn to before me this ——— day of ——— 19—.

——— ———,
Notary Public.

SPECIFICATION.

To all whom it may concern:

Be it known that the ——— Company of the City of ———, State of South Dakota, being engaged in the business of manufacturing, advertising and selling ——— adopted for their use a trademark of which the following is a description: ———.

The style and size of type and color of ink and paper may be varied at pleasure.

The trademark has been used in its business since about ———. The class of merchandise and the particular goods upon which the trademark was used are: ———.

By ——— ———.
President.

(File two copies of the trademark with the application and remit $1.00 filing fee to the Secretary of State.)

TENNESSEE.

Chapter 21, Act of 1905.

AN ACT to regulate trademarks and to provide remedies and penalties for the violation of this act.

SECTION 1. *Be it enacted by the General Assembly of the State of Tennessee*, That within the meaning of this act a trademark shall be construed to be any seal, label, term, design, device, or form of advertisement used for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or other product of labor, as having been made, manufactured, produced, prepared, packed, or put on sale by any person, firm, corporation, association, or union of workingmen, or by any member or members of such association or union.

SECTION 2. *Be it further enacted*, That whenever any person, firm, or corporation or any association or union of workingmen has heretofore adopted or used or shall hereafter adopt or use any trademark, it shall be unlawful to counterfeit or imitate the same; or to use, sell, or to offer for sale, or in any way utter or circulate any counterfeit or imitation of any such trademark provided such trademark has been filed and recorded in the office of the Secretary of State, as provided in section 4 of this act.

SECTION 3. *Be it further enacted*, That whoever knowingly counterfeits any such trademarks, or knowing said trademark to be counterfeit, sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of such trademark, or knowing such trademark to be counterfeit, keeps, or has in his possession, with the intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped, or impressed; or knowing said trademark so printed, painted, stamped, or impressed thereon, sells or disposes of such goods, wares, merchandise, or other product of labor contained in any box, case, can, or package, to which or on which any such counterfeit or imitation is attached, fixed, printed, painted, stamped or impressed, or knowing such trademark to be counterfeit, keeps or has in his possession with the intent that the same shall be sold or disposed of, any goods,

wares, merchandise, or other product of labor, in any box, case, can, or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped, or impressed, shall be punished by a fine of not more than one hundred ($100) dollars.

SECTION 4. *Be it further enacted*, That every person, firm, corporation, or association, or union of workingmen that has heretofore adopted or used, or shall hereafter adopt or use, any trademark mentioned and provided in section 1 of this act, may file the same for record in the office of the Secretary of State by leaving two copies, counterparts, or fac-similes thereof with said secretary, and by filing therewith a sworn application, specifying the name or names of the person, firm, corporation, association, or union on whose behalf such trademark shall be filed, the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such trademark shall have been filed, has the right to use the same; that no other person, firm, corporation, association, or union has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-simile or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of five dollars. Said secretary shall deliver to such person, firm, corporation, association, or union so filing, or causing to be filed, any such trademark, so many duly attested certificates of the recording of the same as such person, firm, corporation, association, or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificates of record shall in all suits and prosecutions under this act be *prima facie* evidence of the adoption of such trademark. Said Secretary of State shall not record for any person, firm, or corporation, association, or union any trademark heretofore filed by or on behalf of any other person, firm, corporation, association, or union.

SECTION 5. *Be it further enacted*, That any person who shall for himself, or on behalf of any other person, firm, corporation, association, or union, procure the filing of any trademark in the office of the Secretary of State, under the provisions of this

act, by knowingly making any false or fraudulent representation or declaration, verbally or in writing, or by any means known to be fraudulent, shall be liable to pay any damages sustained in consequence of such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months.

SECTION 6. *Be it further enacted*, That every such person, firm, corporation, association, or union adopting or using a trademark may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display, or sale, and may award the complainant in any such suit, the court having jurisdiction, such damages resulting from such fraudulent manufacture, use, display, or sale as may be by the court or jury deemed just and reasonable; and shall require the defendants to pay to such person, firm, corporation, association, or union all profits derived from such wrongful manufacture, use, display, or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such case be delivered to an officer of the court, or to the complainant, to be destroyed.

SECTION 7. *Be it further enacted*, That every person who shall use or display the genuine trademark for the purpose of fraud of any such person, firm, corporation, association, or union, in any manner not being authorized so to do by such person, firm, corporation, association, or union, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not less than three months, or by a fine of not more than one hundred dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union, in behalf of and for the use of such association or union.

SECTION 8. *Be it further enacted*, That none of the provisions of this act shall affect or apply to persons, firms, or corporations who shall in good faith buy or come into possession of

goods with a counterfeit trademark thereon, when such person, firm, or corporation did not know at the time he or they obtained possession of such goods that the same were stamped with a counterfeit trademark; provided such person, firm, or corporation does not knowingly misrepresent the facts regarding the trademark at the time he offers such goods for sale.

SECTION 9. *Be it further enacted*, That this act shall take effect from and after its passage, the public welfare requiring it.

Passed January 31, 1905.

APPLICATION FOR REGISTRATION.

To the Honorable ———, *Secretary of State*, ———, ———:

The petition of ——— of the State of ——— and city of ———, for the registration of a trademark under the laws of the State of Tennessee.

The undersigned respectfully represent that they are a — organized under the laws of the State of ——— for the purpose of carrying on the business of ———, that in the course of their business they have adopted a certain label or trademark, design and device or form of advertisement of their said business, which design or device is in the following words, figures, etc., to-wit: ——— [*here paste a copy of said trademark*].

They represent that the same is intended to advertise their ——— [*here state the particular class of goods to be advertised*].

That they alone are entitled to the exclusive use and benefit of said mark or device, and so far as they are aware it is no infringement upon the trademark of any other firm or corporation and no others are entitled to the use of the same. They herewith tender *fac-similes* of said mark with this petition which are in all things identical with that hereto attached.

They respectfully ask that this petition be filed and that their said trademark be registered in accordance with the Act of the General Assembly of the State of Tennessee, being Chapter 21 of the Acts of 1905; and that they be given a certificate showing their compliance with said act, whereby they may have the benefit and protection of the laws of the State of Tennessee.

——— ———.

Subscribed in my presence and sworn to before me, this ——— day of ———, 19—.

——— ———.

(This petition should be sworn to before any officer authorized to administer oaths, and a fee of $5.00 be sent to cover cost, together with two copies of the Mark in addition to the one attached to the petition. If additional certificates are wanted, $1.00 extra should be sent for each one desired.)

TEXAS.

General Laws 1895, Chapter 81.

AN ACT to protect persons, associations, private corporations and unions of workingmen, incorporated or unincorporated, in their labels, trademarks, designs, devices, imprints, and forms of advertising and names; and to prescribe penalties for violation of same, and to repeal all laws or parts of laws in conflict with this act.

SECTION 1. That whenever any person, association, private corporations or union of workingmen, incorporated or unincorporated, have adopted or shall hereafter adopt for their protection any label, trademark, design, device, imprint or form of advertisement, indicating that goods to which such label, trademark, design, device, imprint or form of advertisement shall be attached, were manufactured by such person, association, private corporations or union, or by a member or members of such association or union, it shall be unlawful for any person, inclusive of officers, agents, receiver or receivers of corporations, to counterfeit or imitate such label, trademark, design, device, imprint or form of advertisement or to use such counterfeit or imitation of such label, trademark, design, device, imprint or form of advertisement, knowing the same to be counterfeit or imitation, or to aid, assist, countenance or knowingly permit such counterfeit or imitation or the use of such counterfeit or imitation for his own use or benefit, or for the use or benefit of any corporation of which he may then be an officer, agent or receiver. Every person, whether in his individual capacity or as an officer, agent or receiver of a corporation, violating this section, shall, upon conviction, be punished by a fine of not less than twenty-five nor more than one hundred dollars. Each day's violation of this section shall be considered a separate offense.

SECTION 2. Every person, whether in his individual capacity or as the officer, agent or receiver of a corporation, who shall wilfully and knowingly use or display the genuine label, trademark, design, device, imprint, or form of advertisement, or name of any such person, association or union, incorporated or unincorporated, not being authorized to use or display the same, or shall aid, assist, countenance or knowingly permit the use of

same, not being authorized to use the same, shall, upon conviction, be punished by fine of not less than twenty-five nor more than one hundred dollars.

SECTION 3. Every person, association or union of workingmen, incorporated or unincorporated, having adopted a label, trademark, design, device, imprint or form of advertisement, as aforesaid, may proceed by suit to enjoin the wrongful manufacture, use, display or sale of any such label, trademark, design, device, imprint or form of advertisement and the manufacture, use, display or sale of any such counterfeit or imitation, and all courts having jurisdiction thereof shall grant injunctions to restrain such manufacture, use, display or sale, and shall award the plaintiff in such suit such damages resulting from such wrongful manufacture, use, display or sale as by him may have been sustained. Where such association or union is not incorporated suits under this act may be commenced and prosecuted by any officer or member of such association or union in his own name, for himself and for the use and benefit of such association or union.

SECTION 4. Every person, association or union of workingmen, incorporated or unincorporated, that has heretofore or shall hereafter adopt a label, trademark, design, device, imprint or form of advertisement, shall file the same in the office of the Secretary of State by leaving two copies, counterparts or *fac-similes* thereof, with the Secretary of State, and said secretary shall deliver back to such person, association or union so filing the same one of said copies, counterparts or *fac-similes*, along with and attached to a duly attested certificate of the filing of same, for which he shall receive a fee of one dollar from such person, association or union. Such certificate of filing shall in all suits and prosecutions under this act be sufficient proof of the adoption of such label, trademark, design, device, imprint or form of advertisement, and of the right of such person, association or union to adopt the same. No label, trademark, design, device, imprint or form of advertisements shall be filed as aforesaid that would probably be mistaken for a label, trademark, design, device, imprint or form of advertisement already of record: provided, that no person or association shall be permitted to register as a label, trademark, design,

device, imprint or form of advertisement, any emblem, design or resemblance thereto that has been adopted or used by any charitable, benevolent or religious society or association without their consent: and provided, further, that all persons, institutions or associations now using a label, trademark, design, device, imprint or form of advertisement shall have thirty days' time after this act takes effect in which to file such label, trademark, design, device, imprint or form of advertisement under the provisions of this act, before the same can be registered by others.

SECTION 5. All laws and parts of laws in conflict with the provisions of this act be and the same are hereby repealed.

SECTION 6. It being important that the benefits of this act be realized at once, because the parties to be benefited by this act have no adequate protection under existing laws, creates an emergency and an imperative public necessity that the constitutional rule requiring bills to be read on three several days be suspended, and that this act take effect and be in force from and after its passage, and it is so enacted.

Approved, April 29, 1895.

Sayles' Civ. St., Articles 318a, 318b, p. 148 relate to the protection of bottles, boxes, siphons, etc., of manufacturers and dealers in mineral water and other beverages, and manufacturers of medicines or other compounds.

NOTE—There is no official form of application for registration in Texas.

UTAH.

Compiled Laws, 1907, Title 83, Trademarks.

SECTION 2720. DEFINED. The phrase "trademark," as used in this title, includes every description of word, letter, device, emblem, stamp, imprint, brand, printed ticket, label, or wrapper usually affixed by any mechanic, manufacturer, druggist, merchant, tradesman, association, or union, whether incorporated or unincorporated, to denote any goods to be goods imported, manufactured, produced, compounded, or sold by him, or by such association or union, other than any name, word, or expression generally denoting any goods to be of some particular class or description.

SECTION 2721. RECORDED WITH SECRETARY OF STATE. Any person, association, or union may record any trademark or name by filing with the Secretary of State his or its claim to the same, and a copy or description of such trademark or name, with his affidavit attached thereto, certified to by any officer authorized to take acknowledgments of conveyances, setting forth that he, or the firm, corporation, association, or union of which he is a member, is the exclusive owner, or agent of the owner, of such trademark or name.

SECTION 2722. RECORD OPEN TO PUBLIC. The Secretary of State must keep for public examination a record of all trademarks or names filed in his office, with the date when filed and name of claimant; and must at the time of filing collect from each claimant the authorized fee.

SECTION 2723. OWNERSHIP—TRANSFER—DAMAGES FOR INFRINGEMENT. Any person who has first adopted and used a trademark or name, whether within or beyond the limits of this state, is its original owner. Such ownership may be transferred in the same manner as personal property, and is entitled to the same protection by suits at law; and any court of competent jurisdiction may restrain, by injunction, and award damages for, any use of trademarks or names in violation of this title.

APPLICATION FOR TRADEMARK.

State of ——— ———,
County of ——— ———, ss:

———, being duly sworn, deposes and says that he is ———, located and doing business in ——— County of ———, State of ———. That the said ——— is the exclusive owner of the trademark or name described in the specification accompanying this affidavit, and he petitions that the said trademark may be recorded in the office of the Secretary of State of the State of Utah, in accordance with Title 83, Compiled Laws of Utah, 1907.

——— ———.

Subscribed and sworn to before me this ——— day of ———, 19—.

——— ———,
Notary Public.

SPECIFICATION.

To all whom it may concern:

Be it known, That ———, of ———, County of ———, State of ———, being engaged in the business of ——— adopted for ——— use a trademark, of which the following is a description, or *fac-simile:*

Said trademark to be used generally as follows:

NOTE.—The statutory fee of $3.00 and three *fac-similes* must accompany application.

VERMONT.

AN ACT to amend sections 4962, 4963, 4965, 4966 and 4967 of the public statutes, relating to trademarks.

It is hereby enacted by the General Assembly of the State of Vermont:

SECTION 1. Section 4963 of the Public Statutes is hereby amended so as to read as follows:

Section 4962. A person, partnership or corporation, or an association or union of workingmen, may adopt as and for a trademark or tradename any particular name, term, design, device, label, stamp or form of advertisement not previously owned or adopted by another person, partnership or corporation, or association or union of workingmen, to designate or distinguish goods, wares or merchandise by him or them manufactured or prepared, or on which the labor of persons belonging to such association or union of workingmen has been put, and may file the same for record in the office of the Secretary of State by leaving two copies, counterparts or *fac-similes* thereof with said secretary, and shall also file therewith an accurate description of such name, term, design, device, label, stamp or form of advertisement, verified under oath by the person or some officer of the partnership, corporation or association or union of workingmen by whom it is filed.

The fee for such filing shall be two dollars.

The Secretary of State may make such rules and regulations and prescribe such forms as may be necessary to carry out the provisions of this chapter.

SECTION 2. Section 4963 of the Public Statutes is hereby amended so as to read as follows:

Section 4963. The Secretary of State shall deliver to the person, partnership, corporation or association or union of workingmen so filing such trademark or tradename, a duly attested certificate of the record thereof, for which he shall receive a fee of two dollars.

Such certificate shall, in all suits and prosecutions under this chapter, be sufficient proof of the adoption of such trademark or tradename.

No name, term, design, device, label, stamp or form of advertisement shall be recorded that in any way resembles or would be reasonably mistaken for a name, term, design, device, label, stamp or form of advertisement already on record.

SECTION 3. Section 4965 of the Public Statutes is hereby amended so as to read as follows:

Section 4965. A person who knowingly and wilfully sells or keeps for sale goods upon which or in connection with which is affixed a forgery, imitation or counterfeit of a trademark or tradename adopted and recorded as provided in this chapter, and intended to represent such goods as the genuine goods of another person, or as goods upon which the labor of a member or members of such association or union of workingmen has been put shall be punished as provided in the preceding section.

SECTION 4. Section 4966 of the Public Statutes is hereby amended so as to read as follows:

Section 4966. A person who, with intent to defraud another person, partnership, corporation, or association or union of workingmen, knowingly affixes or causes to be affixed to or upon a package or bottle containing goods, wares or merchandise, a name, term, design, device, label, stamp or form of advertisement, which designates such goods, wares or merchandise either wholly or in part, by a word or words, or by general design, which is wholly or in part the same, either in appearance or in sound, as the word or words or the general design of a trademark or tradename adopted and recorded as provided in this chapter, or who knowingly sells or exposes for sale such package or bottle with such imitating or counterfeit name, term, design, device, label, stamp or form of advertisement, may also be imprisoned not more than one year or fined not more than five hundred dollars, or both.

SECTION 5. Section 4967 of the Public Statutes is hereby amended so as to read as follows:

Section 4967. The court of chancery may, on complaint of the owner of a trademark or tradename adopted and recorded as provided in this chapter, enjoin other persons, partnerships, corporations, or associations or unions of workingmen, from the manufacture, use or sale, without the authority of the owner, of all likenesses, similitudes, copies, imitations or counterfeits thereof, and also from selling or exposing for sale goods, compounds, or preparations, to or with which such unauthorized likenesses, similitudes, copies, imitations or counterfeits are affixed or connected, and may award to such complainant such a sum of money as shall be just and reasonable compensation for the damage to the reputation of the complainant's genuine goods, compounds, preparations, trademark or tradename, by reason of such wrongful manufacture, use, sale or exposure for sale, and may also require the defendant to pay to the complainant in such cause a sum equal to the amount which the complainant would have received for the same quantity of genuine goods, compounds or preparations, and may also order that all such likenesses, similitudes, copies, imitations or counterfeits in the possession or under the control of the defendant be delivered to an officer of the court or to the complainant, to be destroyed.

Approved December 17, 1908.

APPLICATION FOR REGISTRATION.

Certificate accompanying a ——— [*insert name, term, design, device, label, stamp or form of advertisement, as the case may be*] adopted as a ——— [*insert trademark, or tradename, as the case may be*] and filed in accordance with Chapter 212 of the Public Statutes and the amendments thereto, entitled "Trademarks; Protection of Dealers in Milk and Beverages."

Name or names of the persons, Partnership or Corporation ——— [*follow regulations, p. 812, at A.*].

Residence, location or place of business ———.

Class of merchandise and the particular description of goods comprised in such class to which the ——— [*insert name, term, design, device, label, stamp, or form of advertisement, as the case may be*] has been or is intended to be appropriated ——— [*follow regulations, p. 812, at B.*].

[*Here insert the trademark or tradename adopted and send three extra copies, facsimilies or counterparts of the trademark or name*].

Length of time, if any, during which the ——— [*insert name, term, design, device, label, stamp, or form of advertisement, as the case may be*] has been in use. Since ——— [*give month, day of month and year when adopted, or give date since when in use*].

I, [*if a person, insert name; if an officer of a partnership or corporation, insert name, title of office, and name of the partnership or corporation. Outside of Vermont, oath should be administered by a Commissioner for Vermont or Notary Public, with seal*] do hereby declare, that ——— [*insert the name of the person, partnership, or corporation adopting the trademark or tradename*] has a right to the use of the ——— [*insert trademark, or tradename, as the case may be*] referred to in the foregoing certificate, and that no other person, partnership or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and,

I further declare that the foregoing descriptions and the *fac-similes*, copies or counterparts filed with the foregoing certificate are true, correct and accurate.

In witness whereof, I have hereunto signed my name this ——— day of ———, 19—.

——— [*Sign here*].

State of ——— ———,
——— ———, ss:

———, 19—.

Then personally appeared the above named ———, and made oath that the foregoing declaration by him subscribed is true.

Before me.

——— ———.

[*Here write official title.*]

REGULATIONS.

A. If a corporation, state under the laws of what state incorporated. If one or more persons are doing business under a partnership name, state the name of such person or persons and add the words "doing business under the name and style of," then give the partnership name under which the business is conducted.

B. State, *first*, as near as possible in one or two words, the general class of merchandise to which the name, term, design, device, label, stamp or form of advertisement has been or is intended to be appropriated; *second*, as near as possible in one or two words, the particular description or designation of such general class of merchandise. Do not describe the composition, or name the parts which comprise the formula of which the merchandise is composed; *third*, by using the following words: "the essential feature of the (trademark or tradename) is," given what is

considered to be the essential feature or features thereof. If an illustration or pictorial representation is used for a trademark, it is very desirable that a word or words shall also form a part of the "essential features" of such trademark; *fourth*, by using the following words, that: "The style and size of type and the color of ink and paper may be varied at pleasure."

NOTE.—The registration fee is $4.00.

VIRGINIA.

Act of April 30, 1903.

AN ACT to protect persons, firms, corporations, associations, or unions of workingmen in the use of their labels, trademarks, terms, designs, devices, and forms of advertisements, and to provide for the registry thereof. Approved April 30, 1903.

SECTION 1. *Be it enacted by the General Assembly of Virginia*, That whenever any person, firm, corporation, or any association or union of workingmen has heretofore adopted or used, or shall hereafter adopt or use, any label, trademark, term, design, device, or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or other product of labor, as having been made, manufactured, produced, prepared, packed, or put on sale by such person, firm or corporation, or association, or union of workingmen, by a member or members of such association or union, and has filed the same for registry as hereinafter provided, it shall be unlawful to counterfeit or imitate such label, trademark, term, design, device or form of advertisement, or to use, sell, offer for sale or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

SECTION 2. Whoever counterfeits or imitates any such registered label, trademark, term, design, device, or form of advertisement, or knowingly and with intent to deceive, sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such registered label, trademark, term, design, device, or form of advertisement, or knowingly and with intent to deceive, keeps, or has in his possession, with the intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor to which, or on which,

any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly and with intent to deceive, knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can, or package to which, or on which, any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, or knowingly and with intent to deceive, keeps or has in his possession with intent that the same shall be sold or disposed of, any goods, wares, merchandise, or other product of labor in any box, case, can, or package to which, or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than one hundred dollars, or by imprisonment for not more than three months. All such applications for registry shall be made on forms prescribed by the Secretary of the Commonwealth, and any person applying to the Secretary of the Commonwealth for a certificate of registry of any label, trademark, term, design, device or form of advertisement, shall furnish to the said secretary a copy *fac-simile*, or counterpart thereof.

Section 3. Every such person, firm, corporation, association or union that has heretofore adopted or used, or shall hereafter adopt or use a label, trademark, term, design, device, or form of advertisement, as provided in section one of this act, may file the same for registry in the office of the Secretary of the Commonwealth by leaving six copies, counterparts, or *fac-similes* thereof, with the said secretary, and by filing herewith a sworn application, specifying (1) the name or names of the person, firm, corporation, association or union, on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed; (2), the class of merchandise and the description of the goods to which it has been, or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trademark, term, design, device, or form of advertisement shall be filed, has a right to use the same; (3), that no other person, firm, association, union, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and (4), that the *fac-simile* or counterparts filed therewith are true and correct. There shall be paid for such filing

and registry to the Secretary of the Commonwealth a fee of two dollars and fifty cents. Said secretary shall deliver to such person, firm, corporation, association, or union so filing, or causing to be filed, any such label, trademark, term, design, device, or form of advertisement, so many duly attested certificates of the registry of the same as such person, firm, corporation, association, or union may apply for, for each of which certificates said secretary shall receive a fee of two dollars and fifty cents. Any such certificate of registry shall in all suits and prosecutions under this act be sufficient proof of the adoption and registry of such label, trademark, term, design, device, or form of advertisement. Said Secretary of the Commonwealth shall not record for any person, firm, corporation, union, or association any label, trademark, design, term, device, or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement heretofore filed by or on behalf of any other person, firm, corporation, union or association.

Section 4. Any person who shall for himself, or on behalf of any other person, firm, corporation, association, or union, procure the filing and registry of any label, trademark, term, design, or form of advertisement in the office of the Secretary of the Commonwealth, under the provisions of this act, by making any false or fraudulent representations or declaration verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months.

Section 5. Every such person, firm, corporation, association, or union, which has adopted and registered a label, trademark, term, design, device, or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display, or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display, or sale, as may be by the said

court deemed just and reasonable, and shall require the defendants to pay to such person, firm, corporation, association, or union, all profits derived from such wrongful manufacture, use, display, or sale; and such court shall also order that any such counterfeits or imitations in the possession, or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

SECTION 6. Every person who shall use or display the genuine registered label, trademark, term, design, device, or form of advertisement, of any such person, firm, corporation, association or union in any manner, not being authorized so to do by such person, firm, corporation, union, or association, shall be deemed guilty of a misdemeanor, and shall be punished by imprisonment for not more than three months, or by a fine of not more than one hundred dollars. In all cases where such association, or union, is not incorporated, suits under this act may be commenced and prosecuted by an officer, or member of association or union, on behalf of, and for the use of, such association or union.

SECTION 7. Any person, or persons, who shall in any way use the name or seal of any such person, firm, corporation, association, or union, or officer thereof, in and about the sale of goods, or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by fine of not more than one hundred dollars.

SECTION 8. This act shall take effect and be in force from and after its passage.

FORM OF APPLICATION FOR REGISTRATION.

To the Secretary of the Commonwealth of Virginia:

———, [*name and address*] in whose name and behalf this application for the registry in the State of Virginia, of the label, trademark, term, design, device or form of advertising hereinafter indicated is made, in order to secure to the applicant the exclusive use of the same for the purpose of designating, making known and distinguishing the articles hereinafter described, do declare, that:

The name of the applicant in whose name and behalf this registry is made, is as above set forth:

The applicant has heretofore adopted and used, and has the right to use, said label, trademark, design, device or form of advertising, for the purpose of designating, making known or distinguishing the articles hereinafter designated, and that no other person, firm, association, union or corporation, has the right to such use, either in the identical form, or in any such near resemblance thereto as may be calculated to deceive.

The class of articles, and the description thereof, to which such label, trademark, term, design, device or form of advertising is appropriated, are the following, to-wit: ——— [*insert fac-simile or counterpart of trademark or label*].

The *fac-simile* or counterpart herewith filed is true and correct.

——— ———.

Witness the following signature this, the ——— day of ———, 19—.

——— ———,

——— ———.

State of ——— ———,

——— ———, ss:

I, ——— a Notary Public for the ——— of ———, in the State aforesaid, do hereby certify that ——— [*if officer of corporation or partner so state*] this day personally appeared before me in my ——— and state aforesaid and made oath that the statements contained in the foregoing writing bearing date on the ——— day of ———, 19—, are true and that he is duly authorized to make this oath.

Given under my hand and official seal, this, the ——— day of ———, 19—.

——— ———.

NOTE.—Five additional *fac-similes* of counterparts of the trademark or label should accompany the application.

WASHINGTON.

§§ 9492-9500, Remington & Ballinger's Code of the Laws of Washington.

(Section 9492) 1. COUNTERFEITING TRADEMARKS PROHIBITED. Whenever any person, or any association or union of workingmen has heretofore adopted or used, or shall hereafter adopt or use, and has filed as hereinafter provided any label, trademark, term, design, device or form of advertisement for the purpose of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale by such person or association or union of workingmen or by a member or members of such association or union, it shall be unlawful to counterfeit or imitate such label, trade-

mark, term, design, device or form of advertisement, or to use, sell, offer for sale, or in any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device, or form of advertisement.

(SECTION 9493) 2. PENALTY. Whoever counterfeits or imitates any such label, trademark, term, design, device or form of advertisement, or sells, offers for sale, or in any way utters or circulates any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed; or keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor, in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, painted, stamped or impressed, shall be punished by a fine of not more than one hundred dollars, or by imprisonment for not more than three months.

(SECTION 9494) 3. FILING AND RECORDING. Every such person, association or union, that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement, as provided in section one of this act, may file the same for record in the office of the Secretary of State by leaving two copies, counterparts or *facsimiles* thereof, with said secretary, and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, the class of merchandise, and a description of the goods to which it has been, or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, has the right to the use of the same, that no other person,

firm, association, union or corporation has the right to such use either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the *fac-simile* or counterparts filed therewith are true and correct. There shall be paid, for such filing and recording, a fee of five dollars. Said secretary shall deliver to such person, association or union so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement, so many duly attested certificates of the recording of the same as such person, association or union may apply for, for each of which certificates said secretary shall receive a fee of two dollars. Any such certificate of record shall, in all suits and prosecutions under this act, be sufficient proof of the adoption of such label, trademark, term, design, device or form of advertisement. Said Secretary of State shall not record for any person, union or association, any label, trademark, term, design, device or form of advertisement that would probably be mistaken for any label, trademark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, union or association.

(Section 9495) 4. Fraudulent filing, etc.—Penalty. Any person who shall, for himself or on behalf of any other person, association or union, procure the filing of any label, trademark, term, design or form of advertisement in the office of the Secretary of State, under the provisions of this act, by making any false or fraudulent representations or declaration, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing, to be recovered by or on behalf of the party injured thereby, in any court having jurisdiction, and shall be punished by a fine not exceeding one hundred dollars or by imprisonment not exceeding three months.

(Section 9496) 5. Enjoin use, etc. Every such person, association or union adopting or using a label, trademark, term, design, device or form of advertisement as aforesaid, may proceed by suit to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and may award the complainant in any such suit damages resulting from such

manufacture, use, sale or display, as may be by the said court deemed just and reasonable, and shall require the defendants to pay to such person, association or union all profits derived from such wrongful manufacture, use, display or sale; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant to be destroyed.

(Section 9497) 6. Penalty for unauthorized use. Every person who shall use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, association or union in any manner, not being authorized so to do by such person, union or association, shall be deemed guilty of a misdemeanor,, and shall be punished by imprisonment for not more than three months, or by a fine of not more than one hundred ($100) dollars. In all cases where such association or union is not incorporated, suits under this act may be commenced and prosecuted by an officer or member of such association or union on behalf of and for the use of such association or union.

(Section 9498) 7. Penalty for use of name or seal. Any person or persons who shall, in any way, use the name or seal of any such person, association or union or officer thereof, in and about the sale of goods or other wise, not being authorized to so use the same, shall be guilty of a misdemeanor, and shall be punishable by imprisonment for not more than three months, or by a fine of not more than one hundred dollars.

(Section 9499) 8. Penalty for defacing or removing trademark, etc. Any person using the trademark so adopted and filed by any such person, or any imitation of such trademark, or any counterfeit thereof; or who shall, in any manner mutilate, deface, destroy or remove such trademark from any goods, wares, merchandise, article or articles, or from any package or packages containing the same, or from any empty or second hand package which has contained the same or been used therefor, with the intention of using such empty or second hand package, or of the same being used to contain goods, wares,

merchandise, article or articles of the same general character as those for which they were first used; and any person who shall use any empty or second hand package for the purpose aforesaid, without the consent in writing of the person whose trademark was first applied thereto or placed thereon shall, upon conviction thereof, be fined in any sum not less than one hundred dollars, or by imprisonment for not more than three months, and the goods, wares, merchandise, article or articles, contained in any second hand package or packages shall be forfeited to the original user of such package or packages whose trademark was first applied thereto or placed thereon. The violation of any of the above provisions as to each particular article or package shall be held to be a separate offense.

(SECTION 9500) 9. "PERSON" DEFINED. The word "person" in this act shall be construed to include a person, co-partnership, corporation, association or union of workingmen.

Where the mark in litigation has not been registered under section 3621, Ballinger's Annotated Codes, the sufficiency of a complaint for the infringement of the mark must be adjudged upon the principles of common law. *Woodcock v. Guy*, 33 Wash. 234, 74 Pac. Rep. 358.

This act is sufficiently entitled to support its penal provisions. More than one label may be covered by one application. A conviction under the act sustained. *State v. Montgomery*, 106 Pac. Rep. 771, 57 Wash. 192.

APPLICATION FOR REGISTRATION OF TRADEMARK.

KNOW ALL MEN BY THESE PRESENTS: That ———, of the City of ———, County of ———, State of ———, has heretofore adopted and does hereby adopt the following trademark, term, device, design or form of advertisement, and does hereby make application for the registration of said trademark in the office of the Secretary of State of the State of Washington, said trademark, term or form of advertisement being described as follows, to-wit: ———, as shown by the accompanying *facsimiles* or counterparts thereof, filed herewith, which are true and correct copies of said original. The class of merchandise or goods to which this label, trademark, term or form of advertisement is appropriated and on which it is to be used is ———.

Your applicant has the right to the use of such label, trademark, term, device, design or form of advertisement, and no other person, firm, association, union or corporation has the right to such use, either in the

identical form or in any such near resemblance thereto as may be calculated to deceive.

_____ _____.

Subscribed and sworn to before me this _____ day of _____, A. D. 19—.

[Impress Seal here.] _____ _____,

Notary Public in and for the State of _____, *residing at* _____.

INSTRUCTION TO APPLICANT.

(Fee for filing, $5.00 for each application.)

Insert in the first blank the name of the person, firm or corporation on whose behalf the label is to be filed, filling in name of city, etc., as indicated. Describe the trademark fully, giving form, manner and arrangement, etc., *and transmit two fac-similes of said trademark with the application.* Describe the class of goods, merchandise or commodity upon which same is to be used, indicating the manner in which it shall be shown, whether stamped, painted, lithographed, pasted or otherwise, and whether same may be varied in size, color, etc., without changing the general form and wording thereof, etc. No application will be filed for a trademark covering a specific article or class of merchandise, etc., on which the same or a very similar one is of record.* The same term may be used and applied to one class of merchandise that has been adopted for an entirely different class, but no two covering the same class can be filed, under the trademark law of 1897, which can be found upon page 65, of the printed session laws of that year.

WEST VIRGINIA.

Acts of 1901.

SECTION 17. Whenever any person, firm or corporation, or any association or union of workingmen, has heretofore adopted or used, or shall hereafter adopt or use, any label, trademark, term, design, device or form of advertisement for the use of designating, making known, or distinguishing any goods, wares, merchandise or other product of labor, as having been made, manufactured, produced, prepared, packed or put on sale, by such person, firm, corporation or association or union of workingmen, or by a member or members of such association or union, and shall register the same as provided in section three of this act, it shall be unlawful to knowingly counterfeit or imitate such label, trademark, term, design, device or form of advertisement, or to knowingly use, sell, offer for sale, or in

any way utter or circulate any counterfeit or imitation of any such label, trademark, term, design, device or form of advertisement.

SECTION 18. Whoever so knowingly counterfeits or imitates any such registered label, trademark, term, design, device or form of advertisement; or knowingly sells, or offers for sale, or in any way utters or circulates any counterfeit or imitation of any such registered label, trademark, term, design, device or form of advertisement; or knowingly keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor to which or on which any such counterfeit or imitation is printed, painted, stamped or impressed; or knowingly sells or disposes of any goods, wares, merchandise or other product of labor contained in any box, case, can or package to which or on which any such counterfeit or imitation is attached, affixed, printed, painted stamped or impressed or knowingly keeps or has in his possession, with intent that the same shall be sold or disposed of, any goods, wares, merchandise or other product of labor in any box, case, can or package, to which or on which any such counterfeit or imitation is attached, affixed, printed, stamped or impressed, shall be punished by a fine of not more than five hundred dollars or by imprisonment for not more than three months, or by both such fine and imprisonment.

SECTION 19. Every such person, firm, corporation, association or union that has heretofore adopted or used, or shall hereafter adopt or use, a label, trademark, term, design, device or form of advertisement as provided in section one of this act, shall register the same by filing the same for record in the office of the Secretary of State by leaving two copies, counterparts or fac-similes thereof, with said secretary and by filing therewith a sworn application specifying the name or names of the person, association or union on whose behalf such label, trademark, term, design, device or form of advertisement, shall be filed; the class of merchandise and a description of the goods to which it has been or is intended to be appropriated, stating that the party so filing, or on whose behalf such label, trademark, term, design, device or form of advertisement shall be filed, has the right to use the same; that no other person, firm,

association union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the fac-similes or counterparts filed therewith are true and correct. There shall be paid for such filing and recording a fee of one dollar. Said secretary shall deliver to such person, association, or union, so filing or causing to be filed any such label, trademark, term, design, device or form of advertisement so many duly attested certificates of the recording of the same as such person, firm, corporation, association or union may apply for, for each of which certificates said secretary shall receive a fee of one dollar. Any such certificates of record shall in all suits and prosecutions under this act be sufficient proof of the adoption of such labels, trademarks, terms, designs, devices or forms of advertisement. Said secretary of state shall not record for any person, union or association, any label, trademark, term, design, device or form of advertisement, that would probably be mistaken for any label, trademark, term, design, device or form of advertisement theretofore filed by or on behalf of any other person, firm, corporation, union or association. But the said secretary shall file and record under this act any label, trademark, term, design, device or form of advertisement, which may have been previously filed by any person, firm, corporation or any association or union of workingmen, provided the person, firm, corporation, association or union seeking to file and record under this act is the same person, firm, corporation, association or union that previously filed or recorded the same label, trademark, term, design, device or form of advertisement.

SECTION 20. Any person who shall for himself, or on behalf of any other person, firm, corporation, association or union, procure the filing of any label, trademark, term, design or form of advertisement, in the office of the Secretary of State under the provisions of this act, by making any known false or fraudulent representations, or declarations, verbally or in writing, or by any fraudulent means, shall be liable to pay any damages sustained in consequence of any such filing to be recovered by or on behalf of the party injured thereby in any court having jurisdiction, and shall be punished by a fine not exceeding five hundred dollars or by imprisonment not exceeding three months, or by both such fine and imprisonment.

SECTION 21. Every such person, firm, corporation, association or union adopting or using any such registered label, trademark, term, design, device or form of advertisement, as aforesaid, may proceed by suit for damages to enjoin the manufacture, use, display or sale of any counterfeits or imitations thereof, and all courts of competent jurisdiction shall grant injunctions to restrain such manufacture, use, display or sale, and award the complainant in any such suit damages resulting from such manufacture, use, sale or display, as may be by the said court deemed just and reasonable, and shall require the defendants to pay such person, association or union, all profits derived from such wrongful manufacture, use, sale or display; and such court shall also order that all such counterfeits or imitations in the possession or under the control of any defendant in such cause be delivered to an officer of the court, or to the complainant, to be destroyed.

SECTION 22. Every person, firm, corporation or union, who shall knowingly use or display the genuine label, trademark, term, design, device or form of advertisement of any such person, firm, corporation, association or union when registered as aforesaid, in any manner, not being authorized so to do by such person, firm, corporation, association or union, shall be deemed guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than three hundred dollars. In all cases where such association or union is not incorporated suits under this act may be commenced and prosecuted by any officer or member of such association or union on behalf of and for the use of such association or union.

SECTION 23. Any person, firm, corporation, association, or union, who shall in any way knowingly use the name or seal of any such person, firm, corporation, association or union, or officer thereof, in and about the sale of goods or otherwise, not being authorized to so use the same, shall be guilty of a misdemeanor and shall be punished by imprisonment for not more than three months or by a fine of not more than five hundred dollars.

SECTION 24. Nothing contained in this act shall be construed as affecting or impairing any right or remedy at law or in equity

now existing for the protection of any label, trademark, term, design, device or form of advertisement, whether or not the same is registered under the provisions hereof.

The Act of 1882 relates to timber trade.

Another Act of 1889 relates to the protection of persons and corporations engaged in manufacturing and selling mineral waters, malt liquors and other beverages.

NOTE.—No official form of application for registration.

Fee for certificate, $5.00.

WISCONSIN.

LABELS AND TRADEMARKS REGISTRATION.

Ch. 127, 1909; in effect May 13, 1909.

SECTION 1747a. TRADEMARKS AND LABELS; APPLICATION. 1. Any person, firm, copartnership, corporation, association, or union of workingmen, which has heretofore adopted or used or shall hereafter adopt or use any label, trademark, tradename, term, design, pattern, model, device, shopmark, drawing, specification, designation, or form of advertisement, for the purpose of designating, making known, or distinguishing any goods, wares, merchandise, or other product of labor or manufacture as having been made, manufactured, produced, prepared, packed or put on sale by such person, firm, copartnership, corporation, association, or union of workingmen, or by a member or members thereof, he or they, if residents of this or any other state of the United States, and such foreign corporations as may have been duly licensed to transact business in the State of Wisconsin, may file an original, a copy, or photographs, or cuts with specifications of the same for record in the office of the Secretary of State, by leaving two such originals, copies, photographs, or cuts with specifications, the same being counterparts. * * * *fac-similes*, or drawings thereof, with said secretary, and by filing therewith a sworn statement, specifying the name of the person, firm, copartnership, corporation, association, or union of workingmen, on whose behalf such label, trademark, term, tradename, pattern, model, design, device, shopmark, drawing, specification, designation, or form of advertisement is to be filed, the class of merchandise and a separate description of the goods to which the same has been or is intended

to be appropriated, the residence, location, or place of business of such party, that the party on whose behalf such label, trademark, tradename, term, design, pattern model, device, shopmark, drawing, specification, designation or form of advertisement is to be filed, has the right to the use of the same, and that no other person, or persons, firm, copartnership, corporation, association or union of workingmen * * * has such right, either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the originals, copies, photographs, or cuts, counterparts, * * * *fac-similes*, or drawings filed therewith are correct.

TRADENAME; SEVERAL PARTS. 2. Where the several parts of a single unit article of trade or commerce are severally marked to distinguish them by the person, firm, copartnership, corporation, association, or union of workingmen having the right to manufacture such single unit under a tradename or brand used by him or them, such person, firm, copartnership, corporation, association, or union may, in filing under this section the designation of such tradename or brand, attach thereto photographs or cuts with the specifications of the several parts of the unit to which it is attached or applied, and thereafter no further filing or registration of any such parts so used shall be necessary to protect the owner or lawful use of the tradename or brand of the unit against the use by others of any of the several parts thereof, and any such filing shall be construed to be a single filing, and but one filing fee shall be paid therefor.

RECORDING. 3. The papers required to be filed hereunder shall be recorded in a book for that purpose, and there shall be paid to the Secretary of State for such recording and filing one dollar.

Ch. 127, 1909; in effect May 13, 1909.

SECTION 1747am. DUPLICATION OR REPRODUCTION PROHIBITED. 1. It shall be unlawful for any person, firm, copartnership, corporation, association, or union of workingmen, without the consent of the owner of any such label, trademark, tradename, term, design, pattern, model, device, shopmark, drawing, specification, designation, or form of advertisement

registered in accordance with the provisions of the preceding section, to remove any such label, trademark, tradename, design, shopmark, or other designation, or form of advertisement so registered and attached to merchandise or products of labor, for the purpose of using such merchandise or products of labor as a pattern for the duplicating or reproduction of the same, either in the identical form or in such near resemblance thereto as may be calculated to deceive.

REPAIRS. 2. Nothing herein contained shall be taken to prohibit the using of such merchandise or products of labor as a pattern for the reproduction of the same in individual cases of emergency repairs.

USE. 3. And it shall be unlawful for any other person to make use of such label, trademark, tradename, term, design, pattern, model, device, shopmark, drawing, specification, designation, or form of advertisement so filed, or any such likeness or imitation thereof, or utter or display the same orally, or in any printed or written form in the conduct of his business or any business transaction without the express consent, license, and authority of the person, firm, copartnership, corporation, association, or union so owning the same, and such unauthorized and unlawful use may be prohibited and prevented by injunction or other proper proceeding in a court of competent jurisdiction without resource to the penal statute providing a punishment for such unlawful use. In case such association or union of workingmen is not incorporated, such actions may be commenced and prosecuted by an officer or member of such associations or union on behalf of and for the use of such association or union.

Ch. 127, 1909; in effect May 13, 1909.

SECTION 1747am. PENALTY. 1. Every person who shall knowingly and wilfully violate sections 1747a or 1747am, except only those provisions relative to emergency repairs, shall be guilty of a misdemeanor, and upon conviction thereof shall be punished by imprisonment for not more than six months or by a fine of not more than two hundred dollars.

NOT RETROACTIVE. 2. Nothing contained in sections 1747a, 1747am and 1747an shall require a new filing or registration in cases to which this act applies where there has heretofore been a compliance with section 1747a, or any acts amendatory thereof, by any person or persons, firm, copartnership, corporation, association, or union of workingmen.

State of ——— ———,
County of ——— ———, ss:

———, being first duly sworn, deposes and says that he is the ——— of the ———, located and doing business in the City of ——— and State of ———, and that he makes this sworn statement in ——— behalf, and that the ——— is the sole owner of the trademark sought to be registered, and has adopted the same for its own use.

The trademark sought to be registered is as follows:

The class of merchandise to which the same is intended to be appropriated is ———, and a particular description of the goods is ———.

That the said ——— has the right to the use of the same, and that no other person or persons, firm, copartnership, corporation, association, or union of workingmen has such right either in the identical form or in any such near resemblance thereto as may be calculated to deceive, and that the originals, copies, photographs or cut, counterparts, *facsimiles* or drawings filed herewith are correct.

——— ———,
By ——— ———.

Subscribed and sworn to before me this ——— day of ———, A. D. 19—.

[Seal.] ——— ———,
Notary Public.

NOTE.—Fee for certificate $1.00.

WYOMING.

REGISTRATION OF TRADEMARKS.

Section 3439, Wyoming Compiled Statutes, 1910.

Any person, association or union may adopt a label, trademark, stamp or form of advertisement not previously owned or adopted by any other person, association or union, and may file the same for record in the office of the Secretary of State, by leaving two copies, counterparts or fac-similes thereof, with said secretary; and shall file therewith a certificate specifying the name or names of the person, association or union so filing such

label, trademark, stamp or form of advertisement, his or its residence, location or place of business, the class of merchandise and the particular description of goods comprised in such class to which it has been or is intended to be appropriated, and the length of time, if any, during which it has been in use. Such certificate shall be accompanied by a written declaration, verified under oath by the person or some officer of the association or union by whom it is filed, to the effect that the party so filing such label, trademark stamp or form of advertisement, has a right to the use of the same, and that no other person, firm, association, union or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as may be calculated to deceive and that the fac-similes, copies or counterparts filed therewith are true and correct. There shall be paid for such filing the fee of five dollars. Said secretary shall deliver to such person, association or union so filing the same, a duly attested certificate of the record of the same, for which he shall receive the fee of five dollars. Such certificate of record shall, in all suits and prosecutions under this chapter, be sufficient proof of the adoption of such label, stamp, trademark or form of advertisement. No label, trademark, stamp or form of advertisement shall be recorded that would reasonably be mistaken for a label, trademark, stamp or form of advertisement already on record. (L. 1899, ch. 5, sec. 1; R. S. 1899, sec. 2526.)

NOTE.—Forms for application for registration are not furnished.

The fees, as above stated, are: For registration, $5 00; for certificate of registration, $5.00.

Three fac-similes or copies of the label, trademark, stamp or form of advertisement should accompany the application for registration; one to be attached to the declaration, one for use on the certificate of registration, and one for the record.

APPENDIX G.

CANADA.

CIRCULAR of the Department of Agriculture containing "The Trade Mark and Design Act" and "The Timber Marking Act" with Rules and Forms under the same, approved by the Governor General in Council.

1915.

CHAPTER 71.

AN ACT respecting Trade Marks and Industrial Designs.

SHORT TITLE.

1. This act may be cited as the Trade Mark and Design Act. (R. S., c. 63, s. 1.)

GENERAL INTERPRETATION.

"Minister."

2. In this act, unless the context otherwise requires, "Minister" means the Minister of Agriculture.

DIVISION OF ACT.

3. This act is divided into three parts. Part I applies only to trade marks. Part II applies only to industrial designs, but does not apply to any design the proprietor of which is not a person resident within Canada, nor to any design which is not applied to a subject-matter manufactured in Canada. Part III is general and applies to both trade marks and industrial designs. (R. S., c. 63, ss. 2, 24 and 36.)

PART I.—TRADE MARKS.

INTERPRETATION.

Definitions.

4. In this part, unless the context otherwise requires—

(*a*) "general trade mark" means a trade mark used in connection with the sale of various articles in which a proprietor deals in his trade, business, occupation or calling generally;

(*b*) "specific trade mark" means a trade mark used in connection with the sale of a class merchandise of a particular description. (R. S., c. 63, s. 4.)

What shall be deemed to be trade marks.

5. All marks, names, labels, brands, packages or other business devices which are adopted for use by any person in his trade, business, occupation or calling, for the purpose of distinguishing any manufacture, product or article of any description manufactured, produced, compounded, packed or offered for sale by him, applied in any manner whatever either to such manufacture, product or article, or to any package, parcel, case, box or other vessel or receptacle of any description whatsoever containing the same, shall, for the purposes of this act, be considered and known as trade marks. (R. S., c. 63, s. 3.)

As to timber or lumber.

6. Timber or lumber of any kind upon which labor has been expended by any person in his trade, business, occupation or calling, shall, for the purposes of this act, be deemed a manufacture, product or article. (R. S., c. 63, s. 3.)

SEAL.

Seal and its use.

7. The minister may cause a seal to be made for the purposes of this part, and may cause to be sealed therewith trade marks and other instruments, and copies of such trade marks and other instruments, proceeding from his office in relation to trade marks. (R. S., c. 63, s. 7.)

REGISTRATION.

Register to be kept.

8. A register shall be kept at the Department of Agriculture for the registration of trade marks. (R. S., c. 63, s. 5.)

Registration by Minister.

9. Subject to the provisions of this act, the minister shall on application duly made in that behalf, register therein the trade mark of any proprietor applying for such registration in manner as provided by this act in that behalf and by the rules and regulations made thereunder. (R. S., c. 63, ss. 5 and 8.)

Nature of trade mark to be specified.

10. Every proprietor of a trade mark who applies for its registration shall state in his application whether the said trade mark is intended to be used as a general trade mark or a specific trade mark. (R. S., c. 63, s. 9.)

Minister may refuse to register trade mark in certain cases.

11. The minister may refuse to register any trade mark—

(*a*) if he is not satisfied that the applicant is undoubtedly entitled to the exclusive use of such trade mark;

(*b*) if the trade mark proposed for registration is identical with or resembles a trade mark already registered;

(*c*) if it appears that the trade mark is calculated to deceive or mislead the public;

(*d*) if the trade mark contains any immorality or scandalous figure;

(*e*) if the so-called trade mark does not contain the essentials necessary to constitute a trade mark, properly speaking. (54-55 V., c. 35, s. 1.)

Reference to the Exchequer Court.

12. The minister may, in any case in the last preceding section mentioned, if he thinks fit, refer the matter to the Exchequer Court of Canada, and, in that event, such court shall have jurisdiction to hear and determine the matter, and to make an order determining whether and subject to what conditions, if any, registration is to be permitted. (54-55 V., c. 35, s. 1.)

How registration may be effected.

13. Subject to the foregoing provisions, the proprietor of a trade mark may, on forwarding to the minister a drawing and description in duplicate of such trade mark, and a declaration that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof, together with the fee required by this act in that behalf, and on otherwise complying with the provisions of this act in relation to trade marks and with the rules and regulations made thereunder, have such trade mark registered for his own exclusive use.

Exclusive right to trade mark.

2. Thereafter such proprietor shall have the exclusive right to use the trade mark to designate articles manufactured or sold by him. (R. S., c. 63, ss. 3, 5, 8 and 13.)

Certificate of registration.

14. Upon any trade mark being registered under this act, the minister shall return to the proprietor registering the same one copy of the drawing and description forwarded to him with a certificate signed by the minister to the effect that the said trade mark has been duly registered in accordance with the provisions of this act; and the day, month and year of the entry of the trade mark in the register shall also be set forth in such certificate. (R. S., c. 63, s. 13.)

ASSIGNMENT.

Trade marks may be assigned.

15. Every trade mark registered in the office of the minister shall be assignable in law.

Entry.

2. On the assignment being produced, and the fee by this act prescribed therefor being paid, the minister shall cause the name of the assignee, with the date of the assignment and such other details as he sees fit, to be entered in the margin of the register of trade marks on the folio where such trade mark is registered. (R. S., c. 63, s. 16.)

TIME LIMIT.

Duration of general trade mark.

16. A general trade mark once registered and destined to be the sign in trade of the proprietor thereof, shall endure without limitation. (R. S., c. 63, s. 14.)

And of specific trade mark.

17. A specific trade mark, when registered, shall endure for the term of twenty-five years, but may be renewed before the

expiration of the said term by the proprietor thereof, or by his legal representative, for another term of twenty-five years, and so on from time to time; but every such renewal shall be registered before the expiration of the current term of twenty-five years. (R. S., c. 63, s. 14.)

CANCELLATION.

Cancellation of trade mark.

18. Any person who has registered a trade mark may petition for the cancellation of the same, and the minister may, on receiving such petition, cause the said trade mark to be so cancelled.

Effect of cancellation.

2. Such trade mark shall, after such cancellation, be considered as if it had never been registered under the name of the said person. (R. S., c. 63, s. 15.)

RIGHT OF ACTION

Suit by proprietor.

19. An action or suit may be maintained by any proprietor of a trade mark against any perosn who uses the registered trade mark of such proprietor, or any fraudulent imitation thereof, or who sells any article bearing such trade mark or any such imitation thereof, or contained in any package of such proprietor or purporting to be his, contrary to the provisions of this act. (R. S., c. 63, s. 18.)

No suit unless trade mark is registered.

20. No person shall institute any proceeding to prevent the infringement of any trade mark, unless such trade mark is registered in pursuance of this act. (R. S., c. 63, s. 19.)

OFFENSES AND PENALTIES.

Unlawful use of trade mark.

21. Every person other than the proprietor of any trade mark who, with intent to deceive and to induce any person to believe that any article of any description whatsoever was manu-

factured, produced, compounded, packed or sold by the proprietor of such trade mark,—

(*a*) marks any such article with any trade mark registered under the provisions of this act, or with any part of such trade mark, whether by applying such trade mark or any part thereof to the article itself or to any package or thing containing such article, or by using any package or thing so marked which has been used by the proprietor of such trade mark; or,

(*b*) knowingly sells or offers for sale any such article marked with such trade mark or with any part thereof;

Penalty.

is guilty of an indictable offense and liable for each offense to a fine not exceeding one hundred dollars and not less than twenty dollars.

To whom payable.

2. Such fine shall be paid to the proprietor of such trade mark, together with the costs incurred in enforcing and recovering the same.

Suit by proprietor or his agent.

3. Every complaint under this section shall be made by the proprietor of such trade mark, or by some one acting on his behalf and thereunto duly authorized. (R. S., c. 63, s. 17.)

WARRANTY UPON SALE.

Warranty that trade mark is genuine.

22. Upon the sale or in the contract for the sale of any goods to which a trade mark, or mark, or trade description has been applied, the vendor shall, unless the contrary is expressed in some writing, signed by or on behalf of the vendor, and delivered at the time of the sale or contract to and accepted by the vendee, be deemed to warrant that the mark is a genuine trade mark and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of Part VII of the Criminal Code. (51 V., c. 41, s. 18.)

PART II.—INDUSTRIAL DESIGNS.

REGISTRATION.

Register of, to be kept.

23. The minister shall cause to be kept a book to be called the Register of Industrial Designs, for the registration therein of industrial designs. (R. S., c. 63, s. 22.)

Drawing and description to be deposited.

24. The proprietor applying for the registration of any design shall deposit with the minister a drawing and description in duplicate of the same, together with a declaration that the same was not in use to his knowledge by any other person than himself at the time of his adoption thereof. (R. S., c. 63, s. 22.)

Examination prior to registration.

25. On receipt of the fee prescribed by this act in that behalf, the minister shall cause any design for which the proprietor has made application for registry to be examined to ascertain whether it resembles any other design already registered. (R. S., c. 63, s. 22.)

Registration of design—Proviso.

26. The minister shall register the design if he finds that it is not identical with or does not so closely resemble any other design already registered as to be confounded therewith; and he shall return to the proprietor thereof one copy of the drawing and description with the certificate required by this part: *Provided* that he may refuse, subject to appeal to the Governor in Council, to register such designs as do not appear to him to be within the provisions of this part or any design which is contrary to public morality or order. (R. S., c. 63, ss. 22 and 27.)

Certificate of Minister.

27. On the copy of the drawing and description returned to the person registering, a certificate shall be given, signed by the Minister or the Deputy Minister of Agriculture to the effect that such design has been duly registered in accordance with the provisions of this act.

Particulars thereof.

2. Such certificate shall show the date of registration including the day, month and year of the entry thereof in the proper register, the name and address of the registered proprietor, the number of such design and the number or letter employed to denote or correspond to the registration.

Certificate to be evidence of contents.

3. The said certificate, in the absence of proof to the contrary, shall be sufficient evidence of the design, of the originality of the design, of the name of the proprietor, of the person named as proprietor being proprietor, of the commencement and term of registry, and of compliance with the provisions of this act. (R. S., c. 63, ss. 22 and 28.)

Who may register.

28. If the author of any design shall, for a good and valuable consideration, have executed the same for some other person, such other person shall alone be entitled to register it. (R. S., c. 63, s. 25.)

EXCLUSIVE RIGHT.

Registration gives.

29. An exclusive right for an industrial design may be acquired by registration of the same under this part. (R. S., c. 63, s. 29.)

Duration of right—Renewal—Proviso.

30. Such exclusive right shall be valid for the term of five years, but may be renewed, at or before the expiration of the said term of five years, for a further period of five years or less on payment of the fee in this act prescribed for extension of time: *Provided* that the whole duration of the exclusive right shall not exceed ten years in all. (R. S., c. 63, s. 29.)

Using design without leave—Unlawful.

31. During the existence of such exclusive right, whether of the entire or partial use of such design, no person shall, without the license in writing of the registered proprietor, or, if as-

signed, of his assignee, apply for the purposes of sale such design or a fraudulent imitation thereof to the ornamenting of any article of manufacture or other article to which an industrial design may be applied or attached, or publish, sell or expose for sale or use, any such article as aforesaid to which such design or fraudulent imitation thereof has been applied. (R. S., c. 63, s. 31.)

PROPRIETORSHIP.

Who shall be deemed proprietor.

32. The author of any design shall be considered the proprietor thereof unless he has executed the design for another person for a good or valuable consideration, in which case such other person shall be considered the proprietor.

Acquired right.

2. The right of such other person to the property shall only be co-extensive with the right which he has acquired. (R. S., c. 63, s. 25.)

ASSIGNMENTS.

Design to be assignable.

33. Every design shall be assignable in law, either as to the whole interest or any undivided part thereof, by an instrument in writing which shall be recorded in the office of the minister on payment of the fees prescribed by this act in that behalf.

Right to use design.

2. Every proprietor of a design may grant and convey an exclusive right to make, use and vend and to grant to others the right to make, use and vend such design within and throughout Canada or any part thereof for the unexpired term of its duration or any part thereof.

License.

3. Such exclusive grant and conveyance shall be called a license, and shall be recorded in like manner and time as assignments. (R. S., c. 63, s. 30.)

PROTECTION OF DESIGN.

Conditions of registration.

34. In order that any design may be protected, it shall be registered before publication, and, after registration, the name of the proprietor shall appear upon the article to which his design applies by being marked, if the manufacture is a woven fabric, on one end thereof, together with the letters *Rd.*, and, if the manufacture is of any other substance, with the letters *Rd.*, and the year of registration at the edge or upon any convenient part thereof.

How mark shall be applied.

2. The mark may be put upon the manufacture by making it on the material itself, or by attaching thereto a label with the proper marks thereon. (R. S., c. 63, s. 24.)

RIGHT OF ACTION.

Suit by proprietor.

35. If any person applies or imitates any design for the purpose of sale, being aware that the proprietor of such design has not given his consent to such application, an action may be maintained by the proprietor of such design, against such person for the damages such proprietor has sustained by reason of such application or imitation. (R. S., c. 63, s. 35.)

OFFENSES AND PENALTIES.

Violation of this Part.

36. Every person who, in violation of the provisions of this part, during the existence of the exclusive right acquired for any industrial design by the registration of the same under this part, whether of the entire or partial use of such design, without the license in writing of the registered proprietor, or, if assigned, of his assignee,—

By applying design.

(*a*) for the purposes of sale, applies or attaches such design or a fraudulent imitation thereof to the ornamenting of any article of manufacture or other article to which an industrial design may be applied or attached; or,

By selling article with design improperly applied.

(*b*) publishes, sells or exposes for sale or for use, any article of manufacture or other article to which an industrial design may be applied or attached and to which such design or fraudulent imitation thereof has been applied or attached,

Penalty.

shall forfeit a sum not exceeding one hundred and twenty dollars and not less than twenty dollars to the proprietor of the design so applied.

Recovery.

2. Such sum shall be recoverable with costs on summary conviction under Part XV of the Criminal Code by the registered proprietor or assignee. (R. S., c. 63, s. 31.)

Falsely representing an article as having a registered design.

37. Every person who,—

(*a*) places the word *Registered* or the letters *Rd.* upon any article for which no design has been registered under this part or upon any article for the design of which the exclusive right has expired; or,

(*b*) advertises for sale as a registered article any article for which no design has been registered or for the design of which the exclusive right has expired; or,

(c) unlawfully sells, publishes or exposes for sale any article for which no design has been registered, or for the design of which the exclusive right has expired, and on which the word *Registered* or the letters *Rd.* have been placed, knowing the said article to have been fraudulently marked or the exclusive right to such design to have expired;

Penalty.

shall for each offense be liable to a penalty not exceeding thirty dollars and not less than four dollars.

Recovery.

2. Such penalty shall be recoverable on summary conviction under Part XV of the Criminal Code with costs by any person who sues for the same.

Application.

3. A moiety of such penalty shall belong to the prosecutor, and the other moiety to His Majesty for the public uses of Canada. (R. S., c. 63, s. 32.)

LIMITATION OF ACTIONS.

Time.

38. All suits under this part and all proceedings thereunder for offenses, shall be brought within twelve months from the cause of action or commission of the offense and not afterwards. (R. S., c. 63, s. 36.)

PART III.—GENERAL.

RULES, REGULATIONS AND FORMS.

Minister may make rules and adopt forms.

39. The minister may, from time to time, subject to the approval of the Governor in Council, make rules and regulations and adopt forms for the purposes of this act respecting trademarks and industrial designs; and such rules, regulations and forms circulated in print for the use of the public shall be deemed to be correct for the purposes of this act.

Documents deemed valid.

2. All documents executed according to the said rules, regulations and forms, and accepted by the minister, shall be deemed to be valid so far as relates to official proceedings under this act. (R. S., c. 63, ss. 6 and 23.)

CLERICAL ERRORS.

Correction.

40. Clerical errors which occur in the drawing up or copying of any instrument under this act respecting trademarks or industrial designs shall not be construed as invalidating the same, but, when discovered, may be corrected under the authority of the minister. (R. S., c. 63, ss. 21 and 38.)

INSPECTION.

Inspection of registers.

41. Any person may be allowed to inspect the register of trademarks or the register of industrial designs.

Copies.

2. The minister may cause copies of representations of trade marks or copies of representations of industrial designs to be delivered on the applicant for the same paying the fee or fees prescribed by this act in that behalf. (R. S., c. 63, ss. 20 and 37.)

PROCEDURE AS TO RECTIFICATION AND ALTERATION.

Exchequer Court may rectify entries.

42. The Exchequer Court of Canada may, on the information of the attorney general, or at the suit of any person aggrieved by any omission, without sufficient cause, to make any entry in the register of trade marks or in the register of industrial designs, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying any entry in any such register as the court thinks fit; or the court may refuse the application.

Costs.

2. In either case, the court may make such order with respect to the costs of the proceedings as the court thinks fit.

Questions to be decided.

3. The court may in any proceedings under this section, decide any question that may be necessary or expedient to decide for the rectification of any such register. (54-55 V., c. 35, s. 1.)

Trade mark or design may be corrected by the court.

43. The registered proprietor of any registered trade mark or industrial design may apply to the Exchequer Court of Canada for leave to add to or alter any such trade mark or industrial design in any particular not being an essential particular, and the court may refuse or grant leave on such terms as it may think fit.

Notice to minister.

2. Notice of any intended application to the court under this section for leave to add to or alter any such trade mark or industrial design shall be given to the minister, and he shall be entitled to be heard on the application. (54-55 V., c. 35, s. 1.)

Consequent rectification of register.

44. A certified copy of any order of the court for the making, expunging or varying of any entry in the register of trade marks or in the register of industrial designs, or for adding to or altering any registered trade mark or registered industrial design, shall be transmitted to the minister by the Registrar of the Court, and such register shall thereupon be rectified or altered in conformity with such order, or the purport of the order otherwise duly entered therein, as the case may be. (R. S., c. 63, s. 34; 54-55 V., c. 35, s. 1.)

EVIDENCE.

No proof of signature of certificate required.

45. Every certificate under this act that any trade mark or industrial design has been duly registered in accordance with the provisions of this act, which purports to be signed by the Minister or the Deputy Minister of Agriculture shall, without proof of the signature, be received in all courts in Canada as *prima facie* evidence of the facts therein alleged. (R. S., c. 63, ss. 13, 22 and 28.)

FEES.

Table of fees.

46. The following shall be the fees in respect to registration under this act which shall be paid to the minister in advance, that is to say:

On every application to register a general trade mark, including certificate	$30.00
On every application to register a specific trade mark, including certificate	25.00
On every application for the renewal of the registration of a specific trade mark, including certificate	20.00
On every application to register a design, including certificate	5.00

On every application as to a design for an extension of time, for each year of such extension, including certificate	$2 00
For a copy of every certificate of registration separate from the return of the duplicate	1 00
For the recording of every assignment	2.00
For copies of documents not above mentioned, for every hundred words or for every fraction thereof	.50

For each copy of any drawing or emblematic trade mark, and for each copy of any drawn copy of an industrial design,—the reasonable expense of preparing the same. (R. S., c. 63, ss. 10 and 26.)

Payable to Minister of Finance.

47. All fees received by the minister, under this act, shall be paid over by him to the Minister of Finance. (R. S., c. 63, ss. 10 and 26.)

Return of fees if application is refused.

48. In case any trade mark or industrial design in respect of which application for registry is made under this act shall not be registered, all fees paid the minister for registration shall be returned to the applicant or his agent, less, in the case of trade marks, the sum of five dollars, and in the case of industrial designs, the sum of two dollars, which shall be retained as compensation for office expenses. (R. S., c. 63, ss. 10 and 26.)

CHAPTER 72.

AN ACT respecting the Marking of Timber.

SHORT TITLE.

1. This act may be cited as the Timber Marking **Act.**

MARKS AND REGISTRATION.

Persons engaged in lumbering to select, register and use proper marks.

2. Every person engaged in the business of lumbering or the getting out of timber, and of the floating or rafting of the same on the inland waters of Canada, within the Provinces of Ontario, Quebec and New Brunswick, shall, within one month after he engages therein, select a mark or marks, and cause such mark or marks to be registered in the manner herein provided. (R. S., c. 64, s. 1. 7-8 Edward VII, c. 72, s. 1.)

Minister of Agriculture to register marks and deliver certificates.

3. The Minister of Agriculture shall keep at the Department of Agriculture a book to be called the Timber Mark Register, in which any person engaged in the business of lumbering or getting out timber as aforesaid, may have his timber mark registered upon depositing with the minister a drawing or impression and description in duplicate of such timber mark, together with a declaration that the same is not and was not in use, to his knowledge, by any person other than himself at the time of his adoption thereof.

On certain conditions—Certificates shall be evidence.

2. The minister, on receipt of the fee hereinafter provided, shall cause the said timber mark to be examined, to ascertain whether it resembles any other mark already registered; and, if he finds that such mark is not identical with, or does not so closely resemble any other timber mark already registered as to be confounded therewith, he shall register the same, and shall return to the proprietor thereof one copy of the drawing and description, with a certificate signed by the Minister or the Deputy Minister of Agriculture, to the effect that the said mark has been duly registered in accordance with the provisions of this act; and such certificate shall further set forth the day, month and year of the entry thereof, in the proper register; and every such certificate shall be received in all courts in Canada as evidence of the facts therein alleged, without proof of the signature. (R. S., c. 64, s. 2.)

Exclusive right to use registered mark.

4. The person who registers such timber mark shall thereafter have the exclusive right to use the same, to designate the timber got out by him and floated or rafted as aforesaid; and he shall put the same in a conspicuous place on each log or piece of timber so floated or rafted. (R. S., c. 64, ss. 1 and 3.)

Marks may be cancelled.

5. Any person who has registered a timber mark may petition for the cancellation of the same, and the minister may, on

receiving such petition, cause the said mark to be cancelled; and the same shall, after such cancellation, be considered as if it had never been registered under the name of the said person. (R. S., c. 64, s. 4.)

Registered marks assignable and how.

6. Every timber mark registered at the Department of Agriculture shall be assignable in law; and, on the production of the assignment and the payment of the fee hereinafter mentioned, the minister shall cause the name of the assignee, with the date of the assignment, and such other details as he sees fit, to be entered on the margin of the register of timber marks on the folio where such mark is registered. (R. S., c. 64, s. 5.)

Different marks to be used.

7. If any person makes application to register, as his own, any timber mark which is already registered, the minister shall give notice of the fact to such person, who may then select some other mark and forward the same for registration. (R. S., c. 64, s. 6.)

Prohibition against using another person's mark.

8. No person, other than the person who has registered the same, shall mark any timber of any description with any mark registered under the provisions of this act, or with any part of such mark. (R. S., c. 64, s. 7.)

FEES.

Table of fees.

9. The following fees shall be payable, that is to say:

On every application to register a timber mark, including certificate	$2.00
For each certificate of registration not already provided for	.50
For each copy of any drawing, the reasonable expenses of preparing the same.	
For recording any assignment	1.00

2. Such fees shall be paid over by the Minister of Agriculture to the Minister of Finance, and shall form part of the Consolidated Revenue Fund of Canada. (R. S., c. 64, s. 8.)

Minister may make rules and adopt forms.

10. The minister may, from time to time, subject to the approval of the Governor in Council, make rules and regulations and adopt forms for the purposes of this act. (R. S., c. 64, s. 9.)

OFFENSES AND PENALTIES.

Failing to select, register and use proper marks by lumberman, etc.—Penalty.

11. Every person engaged in the business of lumbering or getting out timber, and floating or rafting the same on the inland waters of Canada, within the Provinces of Ontario, Quebec and New Brunswick, who fails, within one month after he engages therein, to select a mark or marks, and cause such mark or marks to be registered in the manner hereinbefore provided, or to put the same in a conspicuous place on each log or piece of timber so floated or rafted, shall incur a penalty of fifty dollars (R. S., c. 64, s. 1. 7-8 Edward VII, c. 72, s. 2.)

Marking timber with a mark registered by another—Penalty.

12. Every person, other than the person who has registered the same, who marks any timber of any description with any mark registered under the provisions of this act, or with any part of such mark, shall, on summary conviction before two justices of the peace, be liable, for each offense, to a penalty not exceeding one hundred dollars and not less than twenty dollars, which amount shall be paid to the proprietor of such mark, together with the costs incurred in enforcing and recovering the same.

Who may complain.

2. Every complaint of violation of this section shall be made by the proprietor of such timber mark, or by some one acting on his behalf and thereunto duly authorized. (R. S., c. 64, s. 7.)

RULES AND FORMS of the Department of Agriculture under the Trade Mark and Design Act and the Timber Marking Act. Approved by the Governor in Council, on the 25th day of October, 1907.

RULES.

1. There is no necessity for any personal appearance at the Department of Agriculture, unless specially called for by order

of the minister or the deputy, every transaction being carried on by writing.

II. In every case the applicant or depositor of any paper is responsible for the merits of his allegations and for the validity of the instruments furnished by him or his agent.

III. The correspondence is carried on with the applicant or his agent, but with one person only, and will be conveyed through the Canadian mails free of charge.

IV. All papers are to be clearly and neatly written on foolscap paper, and every word of them is to be distinctly legible.

Drawings are not to exceed thirteen inches in length and eight inches in width.

V. An application for registration shall be signed by the applicant or by an agent duly authorized.

A partner may sign for a firm. A director or secretary or other principal officer of a company may sign for the company.

VI. All communications to be addressed in the following words: To the Minister of Agriculture (Trade-mark and Copyright Branch), Ottawa.

VII. As regards proceedings not specially provided for in the following forms, any form being conformable to the letter and spirit of the law will be accepted, and if not so conformable will be returned for correction.

VIII. A copy of the Act and the Rules with a particular section marked, sent to any person making an inquiry, is intended as a respectful answer by the office.

IX. Information as to subsisting registrations will not be furnished by the office, the registers and indexes being open for inspection free of charge.

FORMS.

FORM I.—DOMINION OF CANADA.

THE TRADE MARK AND DESIGN ACT.

Application for registration of a General Trade Mark. [*To be made in duplicate.*]

I, [*or* we] ——— of the ——— of ——— in the ——— of ———, hereby request you to register in the name of ———, a General Trade Mark, which I [*or* we] verily believe is mine [*or* ours], on account of having been the first to make use of the same [*or*, on account of having acquired it from ———, who, I [*or* we] verily believe, was [*or* were] the first to make use of the same]. I [*or* we] hereby declare that the said General Trade Mark was not in use to my [*or* our] knowledge by any other person than myself [*or* ourselves] at the time of my [*or* our] adoption thereof. The said General Trade Mark consists of ——— [*verbal description of the trade mark*].

A drawing of the said General Trade Mark is hereunto annexed.

Signed at ———, this ——— day of ———, 19—, in the presence of the two undersigned witnesses.

Witnesses:

To the Minister of Agriculture, Ottawa.

FORM II.—DOMINION OF CANADA.

THE TRADE MARK AND DESIGN ACT.

Application for registration of a Specific Trade Mark. [*To be made in duplicate.*]

I, [*or* we] ——— of the ——— of ——— in the ——— of ———, hereby request you to register in the name of ——— a Specific Trade Mark to be used in connection with the sale of ——— which I [*or* we] verily believe is mine [*or* ours] on account of having been the first to make use of the same [*or*, on account of having acquired it from ——— who, I [*or* we] verily believe, was [*or* were] the first to make use of the same]. I [*or* we] hereby declare that the said Specific Trademark was not in use to my [*or* our] knowledge by any other person than myself [*or* ourselves] at the time of my [*or* our] adoption thereof. The said Specific Trade Mark consists of [*verbal description of the Trade Mark*].

A drawing of the said Specific Trade Mark is hereunto annexed.

Signed at ———, this ——— day of ———, 19—, in the presence of the two undersigned witnesses.

Witnesses:

To the Minister of Agriculture, Ottawa.

FORM III.—DOMINION OF CANADA.

THE TRADE MARK AND DESIGN ACT.

Application for registration of an Industrial Design. [*To be made in duplicate.*]

I, [*or* we] ——— of ——— of ———, in the Province of ———, Dominion of Canada, hereby request you to register in the name of ———, an Industrial Design of a ———, of which I [*or* we] am [*or* are] the ——— proprietor [s]. I [*or* we] declare that the said Industrial Design was not in use to my [*or* our] knowledge by any other person than myself [*or* ourselves] at the time of my [*or* our] adoption thereof. The said Industrial Design consists of [*verbal description of the Industrial Design*].

A drawing of the said Industrial Design is hereunto annexed.

Signed at ———, this ——— day of ———, 19—, in the presence of the two undersigned witnesses.

Witnesses:

The Minister of Agriculture, Ottawa.

FORM IV.—DOMINION OF CANADA.

THE TIMBER MARKING ACT.

Application for registration of a Timber Mark. [*To be made in duplicate.*]

I, [*or* we] ——— of the ——— of ——— in the ——— of ———, hereby request you to register in the name of ———, a Timber Mark which I [*or* we] hereby declare is not and was not in use to my [*or* our] knowledge by any person other than myself [*or* ourselves] at the time of my [*or* our] adoption thereof. The said timber mark consists of ——— [*verbal description of the timber mark*].

A drawing of the said timber mark is hereunto annexed.

Signed at ———, this ——— day of ———, 19—, in the presence of the two undersigned witnesses.

Witnesses:

The Minister of Agriculture, Ottawa.

APPENDIX H

FORMS OF BILLS AND ANSWERS.

DECLARATION.

(Warner v. Roehr, Fed. Case No. 17189A.)

In the Circuit Court of the United States in and for the Northern District of Illinois.

HULBERT H. WARNER, trading and doing business under the name and style of H. H. WARNER & Co., vs. FRANK ROEHR. } No. 18765. Case. Damages, $25,000.

H. H. W., a citizen of the state of New York, trading and doing business under the firm name and style of H. H. W. & Co., at the city of Rochester, in the county of Monroe, in said state of New York, plaintiff, by W. H. B. and J. F. L., his attorneys, complains of F. R., a citizen of the state of Illinois, and residing and doing business at the city of Chicago, in the county of Cook, in the said state of Illinois and in the district aforesaid, defendant, of a plea of trespass on the case.

For that whereas, the said plaintiff shows that for several years last past he has been engaged, at the said city of Rochester, in the manufacture and sale of a certain medicinal preparation known as "Warner's Safe Kidney and Liver Cure," which preparation has become widely known through the domain of commerce, and especially in all parts of the United States, as a valuable medicine for various kinds of diseases of human beings.

That in the introduction of said medicinal preparation, and to bring it to the attention of the public, he expended in advertising the sum of about five hundred thousand dollars ($500,000), and in various ways has expended enormous sums of money to that end; that for a better protection of his right as proprietor, manufacturer and vendor of said medicine he has caused peculiar bottles to be manufactured to contain the same, which bottles have blown into the glass thereof the name of said medicine, and which name contains a word-symbol, to-wit, the word "Safe," as the essential element of a trademark, and also the symbolic "trademark" consisting of the representation of a fire-proof safe; which said "trademark" is his sole property, no other person, firm or corporation having a right to the use of the same, either in the identical form or in any such near resemblance thereto as might be cal-

culated to deceive, nor to affix to medicine or merchandise of substantially the same descriptive properties as his medicine aforesaid.

That being the owner of said "trademark," by virtue of priority of adoption, in connection with said medicine, this plaintiff caused the same to be recorded in the Patent Office of the United States, with a statement specifying his name, domicile, location and citizenship; the class of merchandise and the particular description of goods comprised in the class to which the particular "trademark" had been appropriated by him; also a description of the "trademark" itself with *facsimiles* thereof, and a statement of the mode in which the same is applied and affixed to goods and the length of time during which the said "trademark" has been used by him for the purpose aforesaid.

Plaintiff further shows that he paid into the treasury of the United States the sum of twenty-five dollars ($25.00) and complied with the regulations prescribed by the Commissioner of Patents as provided in the act of congress entitled "An act to authorize the registration of trademarks and protect the same," approved March 3, 1881, as will more fully appear by reference to the certificate of registry of said trademark, numbered 9597, dated the 8th day of August, 1882, signed by E. M. Marble, Commissioner of Patents, and attested by the seal of the Department of the Interior, which certificate is hereto attached and made part of this declaration.

Plaintiff further shows that said "trademark" is applied and affixed to goods by blowing it in the glass, as aforementioned, and by printing it on paper, which in the form of labels is afterwards pasted on the bottles containing the medicine, and it is also printed on wrappers, or otherwise affixed to packages to be used in any manner calculated to notify purchasers of the contents and to guard against fraud.

This plaintiff shows that he is the sole owner by right of priority of adoption and use of a certain other trademark consisting of a *facsimile* of his firm signature, "H. H. Warner & Co.," which said lattermentioned "trademark" is printed on a separate label, and pasted over the cork of each bottle, after the same has been filled with said medicine

Plaintiff further shows that he is the sole owner by right of priority of adoption and use of a certain other trademark entitled "Book of $2,000.00 Prize Enigmas," containing the representation of a man, representing a botanist standing beside a palm tree examining a plant through a magnifying glass, and other matters not necessary to be here mentioned, all the same being printed on the cover of a pamphlet.

Plaintiff further shows that he is the sole owner by right of priority of adoption and use of a certain other trademark representing the front of a fire-proof safe, in the central part of which is shown a negro, on one knee gathering herbs, above whom are the words, "Warner's Safe," and below him are the words, "Kidney and Liver Cure."

Plaintiff further shows that for the purpose of guarding against fraudulent imitations of his said medicine, and to authenticate the

genuineness of goods of his manufacture, he caused, and still causes, each bottle of the same to have wrapped about it a pamphlet bearing his said trademarks with loose circulars between the leaves of said pamphlet, and wrapped about the same another printed circular, printed in several different languages; which said pamphlet contained a great many testimonials of the intrinsic value of said medicine as a remedy for various diseases and disorders, and also *fac-similes* of the signatures of the signers of said testimonials; and said pamphlet containing, among other matters, a great many enigmas for the solution of which large prizes were offered by the plaintiff. That as a further precaution against fraud, and as a means of identification, the said medicine is packed in wooden boxes, which boxes contain each one dozen bottles of plaintiff's medicine labeled and wrapped as aforesaid, and bearing upon one side of the boxes the following printed words: "One Dozen Warner's Safe Kidney and Liver Cure, Manufactured by H. H. Warner & Co., Rochester, N. Y."

And the said plaintiff further shows that he has ever since the dates of the adoption of the said trademarks been and now is solely entitled to all the rights, interests and privileges thereby so secured unto him; and that the said medicine with the accompanying trademark has been extensively introduced to public use, and that large quantities thereof, to-wit, several millions of bottles, have been purchased and consumed by the public for which he has received several millions of dollars, and that he would but for the wrongful acts of the said defendant, Frank Roehr, have made further large gains, profits and advantages from the manufacture and sale of said medicine. And plaintiff further shows that heretofore, to-wit, on or about the —— day of October, A. D. 1883, at the city of Chicago, in the district aforesaid, the said defendant Frank Roehr, well knowing the premises, and the rights and privileges theretofore secured unto him the said plaintiff, and in order to deprive him of his profits, benefits and advantages which might and otherwise should and would have accrued to him at the said district, and elsewhere, unlawfully, unjustly, and wrongfully simulated the various aforesaid trademarks, circulars, labels, wrappers, packages and boxes, in which said genuine medicine of this plaintiff has been put up for the purposes of commerce, and for the purpose of carrying into execution his nefarious enterprise in that respect, the said defendant, F. R., employed large capital, and a large number of assistants, including printers, electrotypers, photographers, and other persons skilled in the arts necessary for the accomplishment of his unlawful purpose aforesaid, and did make exact representations of the genuine trademarks, labels, etc., hereinbefore described, so closely resembling the genuine as to be calculated to deceive purchasers, and which in many instances did actually deceive purchasers, who supposed that they were buying the genuine medicine manufactured as aforesaid by this plaintiff, when in fact the simulated packages contained only a base fluid, colored to resemble the genuine medicine of the plaintiff.

Plaintiff further shows that said defendant, F. R., manufactured large quantities of packages made in exact representation of this plaintiff's genuine packages and containing inside thereof the simulated labels, wrappers, etc., hereinbefore described, and bottles filled with a fluid purporting to be this plaintiff's genuine medicine, but which in fact was not so, but only a base imitation thereof, and offered for sale at the district aforesaid and elsewhere, and did sell large quantities of the same, all of which said wrongful acts of said defendant, F. R., were done without the knowledge, consent or acquiescence of the said plaintiff, and with the intent to injure and defraud him, to the damage of this plaintiff of twenty-five thousand dollars ($25,000), and therefore he brings this suit.

W. H. B.,
J. F. L.,
Plaintiff's Attorneys.

Indorsed: Filed Dec. 6, 1883, Wm. H. Bradley, *Clerk.*

BILL OF COMPLAINT.

(Taylor v. Carpenter, 3 Story, 458.)

To the Judges of the Circuit Court of the United States for the District of Massachusetts:

J. T. and W. T., of the borough of Leicester, in that part of the United Kingdom of Great Britain and Ireland called England, manufacturers, subjects of Victoria the First, queen of said kingdom, and aliens to each and all of the United States of America, and the territories and districts thereof, bring this bill of complaint against D. C., of F., in the said district of Massachusetts, manufacturer, a citizen of the said state of Massachusetts. And thereupon the said J. T. and W. T., complaining, say that for many years past they have been very extensively engaged in manufacturing cotton thread at Leicester aforesaid, and vending the same in large quantities, not only in England, but throughout the United States, and in particular in the city of B., in said district. That their said thread is, and for many years has been, put up for sale on spools, and labeled on the top of the spools "Taylor's Persian Thread" in a circle, in the center of which is the number of the thread, and on the bottom of some of the spools "J. & W. Taylor, Leicester," and on the botton of others, "J. & W. Taylor," with the number of yards of thread on each spool, each spool usually containing two hundred yards or three hundred yards of thread, and the spools containing two hundred yards being black and labeled "200 yds." on the bottom of the spool, and those containing three hundred yards being red, and labeled "300 yds." on the bottom of the spools. And on the center of some of the said labels on the bottom of each spool is stamped the symbol or print of the head and forepart of a lion rampant. And on the center of other of said labels is stamped a coat-of-

arms, the shield whereon contains a lion rampant, and over the same three balls with the motto "In Deo Confido." And your orators further say that their spools so marked, stamped, colored, or labeled as aforesaid, are put up for sale in paper envelopes, each containing one dozen of spools; which said envelopes are prepared and stamped by your orators for said purpose, and some of said envelopes bear in raised letters stamped on them the inscription, "The Persian Thread, made by J. & W. Taylor, labeled on the top of each spool, Taylor's Persian Thread, and on the bottom J. & W. Taylor, Leicester. The above is for the protection of buyers against certain piratical articles of inferior quality, fraudulently labeled with the name of Taylor." And on other of the said envelopes is stamped a coat-of-arms representing a shield, the upper division of which is gilt, and contains three red balls, and the lower division thereof is red and contains the effigy of a lion rampant, with the motto under the same, "In Deo Confido." Your orators further show unto your honors that their said thread has been and is manufactured of various sizes and numbers, to meet the wants of the trade; and by means of the care, skill and fidelity with which your orators have conducted the manufacture thereof for a series of years, their said thread has acquired a great reputation in the trade throughout the United States, and large quantities of the same are constantly required from your orators to supply the regular demand for the consumption of the country. And your orators have established agencies for the sale thereof to the wholesale dealers and jobbers in the cities of B., N. Y., P. and N. O., and in addition thereto your orators employ B. W., now residing in said city of N. Y., as their general agent for the United States, in relation to the sale of their said spool sewing cotton thread; and a mercantile firm of H. & C. are the agents of your orators for the sale of the same in the city of B.; and your orators further show unto your honors that their said thread is known and distinguished by the trade and the public as "Taylor's Persian Thread," and that your orators were the original manufacturers thereof, and the first who introduced the same to the public. That your orators' said general agent, on or about the first day of March last past, hearing that complaints were made of the quality of "Taylor's Persian Thread," proceeded to investigate the cause of said complaint and thereupon ascertained that a spurious article of spool sewing cotton thread was offered for sale by sundry jobbers in the said city of B., as and for your orators' "Persian Thread," and that such complaints had arisen from the fraudulent imposition of such spurious article on the public. Your orators further show unto your honors that their said agent further ascertained upon inquiry, and your orators charge the facts to be, that the said spurious thread so sold and offered for sale in the said city of B., or some of it, was furnished to the said jobbers of D. C., either by him personally or by one F. D. E., of B., his agent in that behalf, and your orators are informed and believe that the said D. C. has sold the said thread, put up, marked and designated

as aforesaid, in the said city of B.; that the said D. C., disregarding the rights of your orators, and fraudulently designing to procure the custom and trade of persons who are in the habit of vending or using your orators' said "Persian Thread," and to induce them and the public to believe that his said thread was in fact manufactured by your orators, had engaged extensively in the manufacture of sewing cotton thread, and caused the same to be put up for sale in envelopes and on spools similar to those used by your orators, and so colored and stamped and labeled as to resemble exactly the said spools and envelopes used by your orators. And the said spool sewing cotton thread, prepared by the said D. C. and sold by him, and which he is engaged in selling as aforesaid, is an exact imitation of the same article which your orators had been manufacturing as aforesaid, and selling in the United States for many years before the said D. C. commenced his said fraudulent imitation thereof. And the said spurious article, although inferior in quality to the genuine Persian Thread manufactured by your orators, can only be distinguished therefrom, so exact is the said D. C.'s imitation as aforesaid, by a careful examination of its quality, and by its falling short in the number of yards contained on each spool from the number marked thereon as the contents thereof. And that the general appearance of the spurious article is the same as that of your orators' genuine thread, and well calculated to deceive those dealing in the purchase and sale thereof. Your orators further show unto your honors that their said general agent has obtained specimens of the said spurious Persian Thread so sold by the said D. C. That in some of the specimens thus obtained, the thread is put upon black spools, and in other of said specimens the thread is put upon red spools, and said black and red spools are of the same size and appearance with those used by your orators, on the top of which spurious spools there is pasted a round paper label, partly gilt, on which is printed in a circle the words "Taylor's Persian Thread," and in the center of the circle the number of the thread; and on the other end on the bottom of such spurious spools there is pasted a round paper label on some of which is printed in a circle the words, "J. & W. Taylor, Leicester," and on others, "J. & W. Taylor," with the number of yards of thread on the spools, and across others of the labels on said black spools the letters and figures "200 yds.," and on said red spools the letters and figures "300 yards" are printed, and in the center of the said label there is impressed the figure or symbol of the head and forepart of a lion rampant. And in other of said specimens the thread is put on spools corresponding in all particulars to those herein just before described, except that the labels on the bottom thereof bear a coat-of-arms, the center of the shield whereof contains a lion rampant, with three balls over the same, and with the motto under, "In Deo Confido." Your orators have also obtained specimens of the envelopes in which said D. C.'s spurious thread is put up and sold by him or his agents, which bear the same inscription, letters and stamps that those used and employed by your orators bear. And in all these

particulars of the labels on each end of the said spurious spools of thread, and the envelopes in which they are put up, they are exactly like the envelopes and the labels on the respective ends of the spools of your orators' genuine Persian Thread, as hereinbefore stated. Your orators further show unto your honors that they have not yet ascertained the extent to which the said D. C. has carried his said fraudulent imitation and sale of your orators' said thread. But your orators' said general agent has found the same offered for sale to the trade in at least six wholesale or jobbing houses in the city of B., as "Taylor's Persian Thread"—from which your orators believe, and they therefore charge, on their belief, that the said D. C. has been and is engaged in selling his said fraudulent and spurious imitation of your orators' "Persian Thread" to a large extent in various places in the United States, with intent that the same should circulate and be received and used by the public as Taylor's genuine "Persian Thread." And your orators further show unto your honors that the fraudulent and inequitable conduct of the said D. C. is not only injuring them in the sales of their said genuine "Persian Thread," and the profits which they would otherwise reasonably make thereon, but by the inferior quality and false measure the said spurious "Persian Thread" is greatly prejudicing the reputation of your orators' said "Persian Thread" in the market, and, unless the said imitation is discontinued or prevented, will ultimately destroy the character and standing of the genuine article. And your orators also charge that the said spurious article is a fraud and deception upon such of the citizens of the state of Massachusetts, and of the United States, as purchase the same, believing it to be the genuine article manufactured by your orators. And your orators further show unto your honors that in the month of March last past, having discovered a portion of the aforesaid fraudulent conduct of the said D. C., your orators did file their bill of complaint before the chancellor of the state of New York, wherein they set forth many of the facts which are in substance hereinbefore stated, and prayed for an injunction to restrain the said D. C. from the aforesaid fraudulent use of the name and trademarks of your orators, and the same was granted by the court; and the said D. C. having appeared and filed his answer to the said bill, did therein admit that he had used the name and trademark of your orators in manner set forth in the bill aforesaid; but denied that the article manufactured by him was of inferior quality to that manufactured by your orators; and afterwards an application was made to the chancellor to dissolve the injunction aforesaid, which last mentioned motion is now before the said chancellor, and by reason of the great number of causes depending before him, the aforesaid cause can not be decided without great delay. And your orators are informed and believe it to be true that the said D. C. residing out of the jurisdiction of the chancellor of the state of New York, can, with impunity, disregard the injunction aforesaid, and that he has continued to make sales in the city of B. and elsewhere of the said thread, put up, labeled, and appearing precisely like that made,

put up, and sold by your orators, and your orators continue to be greatly injured thereby.

In consideration whereof, and for as much as your orators are remediless in the premises at common law, and can not have adequate relief save by the aid and interposition of this court, to the end, therefore, that the said D. C., if he can, show why your orators should not have the relief hereby prayed, and may upon his corporal oath, and according to the best and utmost of his knowledge, remembrance, information and belief, full, true, direct and perfect answers make to the several interrogatories hereinafter numbered and set forth; and the said D. C. and his attorneys, solicitors, counselors, agents and servants may be enjoined and restrained from manufacturing, selling or offering for sale, directly or indirectly, any spool cotton sewing thread manufactured by him or any person other than your orators, under the denomination of "Taylor's Persian Thread," or on spools with the words, "Taylor's Persian Thread," or "J. & W. Taylor, Leicester," or "J. & W. Taylor," printed, painted, written, or stamped, or attached or pasted thereon, or with your orators' said device of a lion rampant, or with their said coat-of-arms thereon; or on spools so made or having any label, printing or device thereon, in such manner as to be colorable imitations of your orators' said spool thread, usually known as "Taylor's Persian Thread," and that the said D. C. may be decreed to account to your orators for all the profits which he has made by the sale of his said fraudulent imitation of your orators' thread, and all the profits which your orators would have made on the sales of their genuine thread but for the said D. C.'s inequitable and wanton piracy of their said name, spools and labels; and that your orators may have their costs and charges in this behalf paid by the said D. C.; and that your orators may have such other and further relief in the premises as to your honors shall seem meet, and shall be agreeable to equity and good conscience.

May it please your honors to grant unto your orators a writ of injunction, issuing out of and under the seal of this court, to be directed to the said D. C., his attorneys, solicitors, counselors, agents and servants, therein and thereby commanding and enjoining them, under a certain penalty in the said writ to be expressed, according to the foregoing prayer of your orators.

May it also please your honors to grant unto your orators a writ of subpœna, issuing out of and under the seal of this court, to be directed to the said D. C., commanding him on a certain day and under a certain penalty in the said writ to be inserted, personally to be and appear before your honors in this honorable court, then and there to answer the premises, and to stand to, abide by, and perform such order and decree therein as to your honors shall seem meet, and shall be agreeable to equity and good conscience.

C. P. C., *of Counsel.*
C. P. and G. R. C.,
Solicitors.

J. & W. T.,
By W. B., their Agent and Attorney.

United States of America, }
District of Massachusetts, } ss.

Personally appeared before me the above-named B. W., on this second day of December, A. D. 1843, and made oath that this bill in equity by him signed, in as far as it states matters within his knowledge, is true to his knowledge, and in as far as it states matters within his belief, is true to his best belief.

W. W. S., *Commissioner, etc.*

Interrogatories to be answered by D. C.:

1. Whether or not have you manufactured and sold, in Massachusetts or elsewhere, thread put upon black spools, on one end of each of which spools is pasted, or otherwise fastened, a circular paper label partly gilt, on which is printed in a circle the words "Taylor's Persian Thread," and in the center thereof the number of the thread, and on the other end of each of said spools is pasted or otherwise fastened a circular white paper label, on which is printed in a circle the words "J. & W. Taylor, Leicester," and across the same label "200 yds.," and in the center of the same label there is impressed the figure or symbol of a lion rampant?

2. Whether or not you have manufactured and sold, in Massachusetts or elsewhere, thread put upon red spools, corresponding in all respects to the black spools described in the preceding interrogatory, except in the color of the spool and in the quantity of thread thereon; and in the letters and figures "300 yds." printed across the said white paper label?

3. What number of each kind of the said spools of thread have you manufactured and sold? State the same accurately, and distinguish the kind and number of the thread, and the number of black spools and the number of red spools so sold by you since you commenced selling the same, and the times when and the place where the same have been sold.

4. What have been the profits made or realized by you on the manufacture and sale of thread put upon spools colored, decorated and fitted up in the manner described in the first and second interrogatories?

5. To whom and what persons in particular have you sold the said thread put up in the manner described in the first and second interrogatories?

6. Who is, and who has been, your agent in Boston for the sale of your thread put upon spools fitted up in the manner described in the first and second interrogatories?

7. Whether or not did you admit in an answer signed, sworn to and filed by you in the court of chancery in and for the state of New York, to a bill of complaint therein pending wherein the said J. T. and W. T. are complainants, and yourself is defendant, that you have engaged in the manufacture of sewing cotton thread, which you

have caused to be put up for sale on spools similar to those used by the complainants, and so colored, stamped and labeled as to resemble exactly or as nearly as the same could be done, the said spools used by the complainants, and the said spool sewing cotton, which has been prepared and sold by you, is an exact imitation of the same article which the complainants had been selling in the United States many years before you commenced manufacturing your thread?

8. Whether or not have you manufactured and sold in Massachusetts sewing cotton thread upon black spools and upon red spools, on one end of each of which is fastened a circular paper label, described as in interrogatory numbered 1, and on the other end is fastened a circular paper label on which is stamped a coat-of-arms, the shield whereof contains a lion rampant, and over the same three balls, with the motto under the shield, "In Deo Confido," and around said shield is printed in some of said labels, "J. & W. Taylor, Leicester," and in others, "J. & W. Taylor," with the number of yards on said spools?

9. Whether or not have you put up and sold your sewing cotton thread, colored, stamped and labeled in all or some of the modes described in this bill in envelopes or wrappers, some bearing in raised letters the inscription, "The Persian Thread, made by J. & W. Taylor, labeled on top of each spool Taylor's Persian Thread and on the botton J. & W. Taylor, Leicester. The above is for the protection of buyers against certain piratical articles of inferior quality, fraudulently labeled with the name of Taylor," and others bearing a coat-of-arms, the upper division of which is in gilt, and has three red balls thereon, and the lower division is red, and has a lion rampant thereon.

C. P. and B. R. C.

Solicitors.

BILL OF COMPLAINT.

ON MARK REGISTERED UNDER TEN-YEAR CLAUSE, ACT OF 1905.

(233 U. S. 461, 58 L. Ed. 1046.)

United States Circuit Court, Southern District of New York.

Thaddeus Davids Company, *vs.* Cortland I. Davids and Walter I. Davids, Trading as The Davids Manufacturing Co.,	In Equity.

AMENDED BILL OF COMPLAINT.

To the Honorable the Judges of the Circuit Court of the United States in and for the Southern District of New York:

The Thaddeus Davids Company, a corporation duly organized under the laws of the state of New York, and having its principal place of busi-

ness at 127 William street, in the city of New York, in said district, brings this its amended bill of complaint pursuant to an order of this court entered March 13th, 1908, against Cortland J. Davids and Walter J. Davids, citizens of the state of New York, and doing business at 203 Front street, in the city of New York, under the name of The Davids Manufacturing Company, and thereupon your orator complains and says:

1. That your orator is the owner of a trademark used in commerce among the several states of the United States of America, and is domiciled within the territory of the United States, and was such owner and was so domiciled on or before the tenth day of July, 1906, and has been such owner continuously since said date, and also been continually so domiciled, and that your orator is a manufacturer of inks, mucilage, paste, and similar articles, and has been so engaged together with its predecessors in business, in the city of New York continuously ever since 1825, and all of the inks, mucilage, paste and similar articles manufactured and sold by your orator and its predecessors have borne said trademark upon a suitable label on the bottles containing the same and has been sold under said trademark and said trademark has been used continuously by your orator and its predecessors in commerce among the several states for over eighty years now last past, and that said articles have acquired the highest reputation in the market for goods of this description, namely, inks, mucilage and paste, and said goods have become and now are very popular and well-known throughout the United States as "Davids' Inks," "Davids' Mucilage" and "Davids' Paste."

2. That so being the owner of said trademark on the tenth day of July, 1906, your orator filed in the Patent Office of the United States on said date an application for registration for such trademark; said application being in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying its name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which said trademark was appropriated; a description of the trademark itself, and a statement of the mode in which the same was applied and affixed to goods, and the length of time during which the said trademark had been used. With this statement was filed a drawing of the trademark, signed by the applicant, or its attorney, and such number of specimens of the trademark as actually used, as were required by the Commissioner of Patents. And your orator paid into the Treasury of the United States the sum of ten dollars and otherwise complied with the requirements of the Act of Congress entitled "An act to authorize the registration of trademarks used in commerce with foreign nations or among the several states, or with Indian tribes, and to protect the same," which act was approved February 20, 1905. Said application was accompanied by a written declaration verified by an officer of the corporation applying to the effect that the applicant believed the corporation in whose behalf he made the application to be owner of the trademark sought to be registered, and that no other person, firm, corporation or association to the best of the applicant's knowledge

and belief had the right to such use either in the identical form or in such near resemblance thereto as might be calculated to deceive; that such trademark was used in commerce among the several states and that the description and drawing presented truly represented the trademark sought to be registered; which said declaration was strictly in accordance with Section 2 of said act, and duly verified before a proper officer as provided in said section.

3. That thereupon said application being duly filed as aforesaid in the United States Patent Office in accordance with the law, due proceedings were thereupon had according to law and it appearing upon the examination of said application in said Patent Office that said applicant, to wit, your orator, was entitled to have its trademark registered under the provisions of the above mentioned act, due publication thereof took place and no notice of opposition being filed thereto, registration of said trademark was duly granted according to law and a certificate of registration was thereafter, to wit, on the 22nd day of January, 1907, issued to your orator which certificate was numbered 59,898, pursuant to Section 11 of the aforementioned act; which said certificate of registration is still in force, and of which your orator then was and now is the sole and exclusive owner, as by said original certificate of registration or a duly authenticated copy thereof here in court to be produced will more fully and at large appear.

4. That the trademark so registered as above set forth was originally adopted by your orator's predecessors in business, being then the owner of the mark, to wit, about the year 1825, as a mark by which the goods of the said owner may be distinguished from other goods of the same class, and said mark has been continuously used for said purpose by your orator and its predecessors in business since said date and is still so used, and as a matter of fact said mark has distinguished the goods made by your orator and its predecessors as owners of the mark from other goods of the same class, and said mark was in actual and exclusive use a trademark of the applicant or its predecessors from whom it derived title for ten years next preceding the passage of the above mentioned Act of Congress, approved February 20, 1905; all as provided in Section 5 of said act, and your orator is advised and believes that by reason of the fact that said trademark has been in actual and exclusive use as trademark of your orator as applicant or your orator's predecessors from whom your orators derived title for more than ten years next preceding the passage of said act, said trademark was distinctly and in terms declared by said act to be entitled to registration as a good and valid trademark in the United States Patent Office, and that the registration above mentioned was and is a valid registration and is entitled to the protection of this court irrespective of the particular character of said mark.

5. Your orator is advised and believes and therefore shows to your honors that it was the intent of Congress in passing said act and was the legal effect of said act as passed to regard all trademarks, irrespective

of their particular character, which had actually been used exclusively by their owner for ten years or more before the passage of said act, by which the goods of said owner were in fact distinguished from other goods of the same class as vested rights which said act should not in any way take away or diminish but which said rights should, when used in interstate commerce, be endowed with all the rights of registration and protection which was afforded to any lawful trademark under said act. All of which appears by Section 1 and Section 2 of said act, and especially the fourth proviso of Clause *b* of Section 5. Your orator therefore claims the protection of this honorable court for its said registered trademark No. 59,898, dated January 22, 1907, as a vested right of over ten years standing at the date of said Act of Congress; registration of which was in terms provided for in said act.

6. That the way in which said trademark was applied to the goods of your orator and its predecessors in business was placing the same in prominent letters on the label which was pasted on the bottles containing the goods. In doing so, the word Davids' was placed at or near the top of the label and the word or words indicating the special character of the goods was placed at about the middle of the label, and the name of your orator's company, to wit, Thaddeus Davids Company, New York, was placed at or near the bottom of the label. The other words, figures or characters were so arranged that the word Davids', the name of the article, such as Blue Ink, Carmine Ink, Scarlet Ink, Green Ink, Writing and Copying Ink, and so forth, appeared as the most prominent part of the label, so that at a distance at which the smaller type could not be read the mark stood out as, for example, Davids' Blue Ink, Thaddeus Davids Company. All of which will more fully and at large appear from the labels themselves here in court to be produced.

7. That said trademark and the right to the exclusive use thereof is of great value to your orator, and any infringement thereof or any use of a mark so closely resembling the same as to mislead the public into believing that they are procuring your orator's goods when they are not your orator's goods is likely to cause irreparable injury to your orator, and to deprive your orator of the just reward and fruits of its well earned reputation for inks, mucilage and paste, by reason of the fact that your orator's goods have become well and very extensively known by the short designation of Davids' Ink, Davids' Mucilage, and Davids' Paste.

8. That your orator and its predecessors have made and sold under said registered trademark, and are now making and selling thereunder quite a large variety of inks, mucilage and paste, such as several kinds of black ink, blue ink, green ink, carmine ink, scarlet ink, copying ink, and record ink, writing fluids, stylographic pen ink, lettering ink, and several kinds of paste and mucilage, all of which have been known in the market and are called for as Davids' Inks, or Davids' Paste, or Davids' Mucilage. By reason of this fact purchasers and the public generally in the purchase of such articles have come to identify the

same as of your orator's manufacture largely, if not entirely, by reason of the presence upon the label of the word Davids' and the word Ink or the word Paste or the word Mucilage as the most prominent part of the label, paying little, if any attention to the color or other characteristics of the various labels, which color and characteristics are subject to change, and as before stated present quite a large variety of appearances.

9. That defendant, Cortland I. Davids, entered the employ of your orator as book-keeper about the month of June, 1905, and remained in said employ for a period of nine months; and the other defendant, Walter I. Davids, entered your orator's employ as assistant book-keeper some time in the year 1904, and remained in said employ until about the month of March, 1906; that both of said defendants while in said employment became familiar with your orator's manufacture of inks, mucilage and paste from seeing the same constantly about your orator's show rooms and office at 127 William street, New York City, where they were employed and from their position as book-keeper and assistant book-keeper became aware of the popularity and demand for said goods, and to a large extent became familiar with the names of your orator's customers and the quality of said goods usually purchased by said customers.

10. That somewhere about the month of March, 1906, your orator for good cause discharged the said two defendants from its said employ, since which time there has been no business connection or employment of any sort between your orator and the defendants or either of them, and no authority has ever been given by your orator to said defendants or either of them to use said trademark or to manufacture or sell any inks, mucilage or paste bearing in any form the word Davids' thereon, or on any label attached thereto, or to hold themselves out as having any connection with your orator or its products or process of manufacture.

11. That prior to said March, 1906, neither of the defendants, so far as your orator is informed and believes had ever undertaken to make or sell or put on the market any inks or mucilage or paste in any form, nor had held themselves out in any way as being manufacturers of such articles; but that some time after their said discharge, but how long your orator cannot say, defendants associated themselves together in the business of making and selling inks, mucilage, paste, and contriving and intending to injure your orator in its business, and to divert to themselves the benefit and advantage which otherwise would have accrued to your orator from the excellence and popularity of its said goods known to the trade as Davids' Ink, Davids' Mucilage, Davids' Paste, defendants adopted as a tradename the firm name and style "Davids Manufacturing Company", and began putting on the market inks, mucilage and paste in bottles on which were pasted labels at the top of which the word Davids' appeared in prominent type, at the middle of which appeared the word Ink, or the word Mucilage, or the word Paste, as the case might be, appeared in prominent type, and at the bottom of which label

the words Davids Manufacturing Company appeared in prominent type, and sold the same and offered the same for sale as Davids' Ink, Davids' Mucilage and Davids' Paste, by reason of which said goods so labelled were calculated to deceive the public and did actually deceive the public in many instances into the belief that in buying defendant's goods they were buying your orator's goods, whereby great confusion was created in the market as to the origin of said goods to the great damage and injury of your orator and infringement of your orator's registered trademark, as well as your orator's vested rights of trademark at common law.

12. That defendants so manufactured and sold said articles and so labelled them in infringement of your orator's registered trademark as above set forth not only within the Southern District of New York, but in commerce among the several states, and have thereby caused and are threatening to continue to cause great and irreparable injury to your orator's said business unless defendants can be restrained by order of this honorable court.

13. That the specific act of infringement herein complained of as affecting your orator's said registered trademark consisted, not in the mere use of the word Davids' without otherwise labeling their goods to produce confusion (your orator having no objection to the mere use of the name C. I. Davids on defendant's goods) but in setting said word Davids' in prominent type at the top of the label, the word Ink, Paste or Mucilage also in prominent type near the middle of the label, and the arbitrary adopted trade name of Davids Manufacturing Company in imitation of your orator's trade name Thaddeus Davids Company at the bottom of the label.

14. That said use of your orator's registered trademark on the part of said defendants and the putting of their goods on the market as and for your orator's goods constitute, as your orator is advised, not only an infringement of your orator's lawful trademark, but also unfair and unlawful competition on the part of defendants, which, if continued, will cause irreparable loss and injury to your orator.

Wherefore, as your orator can have no adequate relief except in the court of equity, may it please your honors to grant unto your orator a writ of subpœna, issuing out of and under said seal of this honorable court, directed to the said defendants, Cortland I. Davids and Walter I. Davids, trading under the name of Davids' Manufacturing Company, commanding them and each of them to be and appear on a certain day and under penalty in this court then and there to answer this complaint but not under oath, the oath thereto being expressly waived, and to stand to and abide such order and decree as may be made against them, and your orator further prays that said defendants may be compelled to account for and to pay to your orator the profits by them acquired and the damages suffered by your orator from the said unlawful acts, and that said defendants, their servants, agents, and attorneys may be enjoined and restrained by the order of this court from the use of the words Davids Manufacturing Company, and from the use of

the word Davids' at the top of their labels in connection with the business of making and selling inks, mucilage or paste, and from selling or offering for sale their goods as Davids' Ink, Davids' Paste or Davids' Mucilage in such manner as is calculated to deceive the public or mislead it into the belief that any inks, mucilage or paste manufactured by defendants are of the manufacture of your orator; and from doing any other acts or things which are intended or calculated to create confusion as to the origin of your orator's goods, and from attempting to divert to defendants any part of the trade which your orator has built, in connection with its predecessors, or by means of said trademark and by means of your orator's well earned reputation for superiority of goods.

And your orator prays in this regard not only a preliminary injunction restraining defendants, their servants, agents or attorneys as hereinbefore prayed during the pendency of this suit, but also a perpetual injunction and for such other and further relief as your honors may seem meet.

And your orator will ever pray, etc.

By L. A. DAVIDS, *President.*
THADDEUS DAVIDS COMPANY,

W. P. P. Jr.,
Solicitor and of Counsel for Complainant.

BILL OF COMPLAINT.

(Carson v. Ury, 39 Fed. Rep. 777.)

In the Circuit Court of the United States for the Eastern Division of the Eastern Judicial District of Missouri.

JAMES CARSON, Complainant,
vs.
HENRY URY, HARRIET URY, RICHARD URY, ERSKINE MANSFIELD and A. BELINER, Defendants. } In Equity.

J. C., a resident and citizen of the city of New York, in the state of New York, files this his amended bill of complaint, under leave of court had and obtained, against the above defendants, H. U., H. U., R. U., E. M. and A. B., all of whom are citizens of the state of Missouri and residents of the city of St. Louis, in the eastern division of the eastern judicial district of the said state, and thereupon your orator complains and says:

First. That your orator for more than seven years has been and now is a member of the Cigar Makers' International Union of America; that the members of said union are severally cigar makers residing in the United States, and said union is a voluntary unincorporated association of practical cigar makers formed for the purpose of promoting the mental, moral and physical welfare of the members, by assisting them to obtain labor at remunerative wages, by affording

them pecuniary aid in case of sickness and providing money in case of death, and generally to maintain a high standard of workmanship and fair wages of cigar makers.

Second. That the question which is the subject of this action is one of common and general interest to all members of the Cigar Makers' International Union of America, and that they are very numerous, being over twenty-five thousand in number, and that it is impracticable, therefore, to bring them all before the court in this action.

Third. That as your orator is informed and believes, for the purpose of designating the manufacturing of members of the Cigar Makers' International Union of America, the said union through its delegates in convention assembled in Chicago in the month of September, 1880, devised and adopted a trademark, or label to which they gave the name of "Union Label," a *fac-simile* of which is annexed hereto and marked "Exhibit A;" that prior to the adoption of said label the same had not been known or in use in this country or elsewhere, and ever since said adoption the members of the Cigar Makers' International Union of America have exclusively used said labels, and the same have been conspicuously posted on the outside of cigar boxes containing cigars made by the members of said Cigar Makers' International Union of America.

Fourth. That the members of said union are by the constitution and laws of said union allowed to make and sell cigars, and to use on such cigars so made and sold by them labels like said "Exhibit A," provided they do not employ others to make said cigars; and that your orator for about two years last past has been making and selling cigars in the city of New York aforesaid and has used there the labels like said "Exhibit A," and has built up a profitable trade for himself under said label, and that your orator was the owner of the cigars which he thus made and sold under said label to the public.

Fifth. That the said label affixed to cigar boxes is intended as a guaranty that the cigars therein contained are manufactured by members of the Cigar Makers' International Union of America, and that good and clean workmanship has thereby been secured; and that the cigars were not made in tenement houses or state prisons or by coolies, and for these reasons the cigars so labeled command a higher price in the market than cigars of similar appearance, but without such label, can command; that there is a large demand among the public for cigars having said label, which demand has been growing every year since the organization of said union, and the use of said label has been and is a source of great profit and advantage to your orator and to the other members of said union.

Sixth. That it is the practice of said union to furnish gratuitously copies of the genuine label marked "Exhibit A" to all manufacturers of cigars in the United States who employ exclusively members of the said union, who themselves own and sell the cigars which they make.

Seventh. That the wages demanded and received by the members of said union, are about three dollars higher per one thousand cigars than the wages demanded and received by other workmen, and that union-made cigars, that is, boxes of cigars carrying the said labels, bring in the market about three dollars more per thousand than such cigars would bring without such labels; that this is the case because the cigars bearing said labels are known to the public to be made by competent workmen in clean and healthy shops.

Eighth. That by the use of said genuine labels as aforesaid, your orator and other members of said union have made great profits and the public is protected from impure and unhealthy cigars.

Ninth. That said union does not issue labels to manufacturers employing tenement house labor, or prison labor, or coolie labor, or who do not pay the required scale of wages demanded by said union, and that said union does not sell any such labels either to manufacturers or to the public.

Tenth. That as your orator is informed and believes, since the adoption and use of said label by said union, and since the time when your orator commenced to sell cigars bearing said genuine label, the said defendants have conspired and federated together to cheat and defraud your orator and the members of said union so using said label as aforesaid, and fraudulently impose upon manufacturers and dealers in cigars and upon the public by manufacturing and offering for sale and selling and giving away for use on cigar boxes, labels which are spurious and counterfeits of said genuine labels, and in furtherance of this fraudulent and illegal business have adopted the name "B. Alberts." That your orator is informed and believes that the said name of B. Alberts is fictitious and that there is no person of that name, but that the same was first adopted by defendant B.; but however this may be, your orator further says that said defendants under said name have manufactured, offered for sale and sold spurious and counterfeit labels for use as aforesaid—a copy of which said spurious and counterfeit label is hereto annexed, marked "Exhibit B." That the spurious label so offered and given away and sold by said defendants under the said name of B. Alberts is a close imitation and counterfeit of the genuine adopted by said union as aforesaid. That the said defendants have also lately inserted an advertisement in the United States Tobacco Journal, a newspaper published in the city of New York, state of New York, and in other publications, representing to the public that they had for sale copies of said genuine label, issued by authority of said Cigar Makers' International Union of America, and containing a representation of such label. All of which acts of said defendants are done without the authority or permission of your orator or the officers and members of said union, and against its will and protest. That in furtherance of said fraudulent and illegal purposes, and with the intent to cheat and defraud as aforesaid, said defendants have published a fictitious ad

dress, in said name of B. Alberts as aforesaid, to wit: No. 222 Pine Street, in the city of St. Louis, there being no person by the name of B. Alberts at said address, and have caused all mail there received in answer to their advertisements to be delivered to the place of business of said defendants, H. U. and H. U., with whom, as your orator is informed, the other defendants are associated at No. 304 North Main Street, in the city of St. Louis.

Eleventh. That said wrongful and fraudulent acts of said defendants, and their continuation, are calculated to deceive and mislead and do deceive and mislead the public into the belief that said defendants have authority from said union to sell or give away said genuine labels, and further tend to deceive the public into the belief that the cigars thus labeled by the purchasers of said labels from the defendants are the cigars made and sold by your orator and such other makers of cigars as have authority to use the genuine label of said union; and they further tend to deceive the public into the belief that the false and spurious labels sold and offered for sale, or given away by said defendants, are the genuine labels of said union.

Twelfth. That your orator has, and the other members of said Cigar Makers' International Union of America have, a valued and pecuniary interest in the genuine labels issued by said union, and used by the members thereof, and that he has, and they have, suffered irreparable damage by the wrongful acts of said defendants, and that, if suffered to continue, the wrongful acts of said defendants will tend to produce further irreparable damage to your orator and to the other members of said Cigar Makers' International Union of America.

Thirteenth. That your orator has no adequate remedy at law for said injury.

Fourteenth. That said injury can not be adequately compensated in money, but your orator alleges that the matters in dispute and injury to him, exclusive of interest and costs, exceed the sum of two thousand dollars.

Fifteenth. That as your orator is informed and believes, one or more of said defendants, prior to the commencement of said wrongful acts, were members of said union and well acquainted with its constitution, by-laws and practice, but are not now members of said union.

Sixteenth. And your orator further shows unto your honors on information and belief, that said defendants have made and sold, and caused to be made and sold, large quantities of said labels, and have large quantities on hand, which they are now offering for sale, and have made and realized large profits and advantages therefrom; but to what extent and how much exactly your orator does not know and prays a discovery thereof; and that said labels have been used by many manufacturers of cigars in the sale of cigars which were not made by your orator or by any member of the Cigar Makers' International Union of America.

Seventeenth. And your orator further says that the use and sale of said labels by said defendants, and their preparation for and avowed determination to continue the same, and their other aforesaid and unlawful acts in disregard and defiance of your orator, have the effect to and do encourage and induce others to disregard your orator's rights in the premises.

And your orator prays that said defendants, H. U., H. U., R. U., E. M. and A. B., their servants, agents, attorneys and workmen, and each and every of them, may be restrained and enjoined provisionally and perpetually, by the order and injunction of this honorable court, from directly or indirectly making, using, vending, delivering or in anywise counterfeiting or imitating said genuine label of the Cigar Makers, International Union of America, or from making, selling or offering for sale or giving away any labels like or similar to those issued by said Cigar Makers' International Union of America, and that the defendant may be decreed to pay the costs of this suit, and that your orator may have such further or such other relief as to this honorable court shall seem meet and as shall seem agreeabe to equity.

An answer under oath is hereby expressly waived.

May it please your honors to grant unto your orator the writ of injunction, as well provisional as perpetual, issuing out of and under the seal of this honorable court, commanding, enjoining and restraining said defendants, H. U., H. U., R. U., E. M. and A. B., commanding them by a certain day and under certain penalty to be and appear in this honorable court then and there to answer the premises and to stand to and abide such order and decree as may be made against them.

And your orator will ever pray, etc.

A. K., *of Counsel.*

B., S. & K.,
Complainants' Solicitors,
with whom are H. O. & J.

STATE OF NEW YORK,
Southern District of New York, } ss.
City and County of New York,

J. C., being duly sworn, says that he is the complainant named in the foregoing complaint, that he has read said complaint, and that the allegations contained therein are true except those which are stated therein to be alleged on information and belief, and as to those he believes said complaint to be true.

Sworn to before me this 23d day of March, 1889.

H. M. T.,
Notary Public of New York County.

BILL OF COMPLAINT.

(McLean v. Fleming, 96 U. S. 245.)

To the Judges of the Circuit Court of the United States within and for the District of Missouri.

C. F. of Pittsburg, in the State of Pennsylvania, a citizen of said State, brings this his bill of complaint against J. H. McL., of St. Louis, in the Eastern District of Missouri, and a citizen of the State of Missouri, and thereupon your orator complains and says that he now, and for the last sixteen months has been extensively engaged individually in the manufacture of a certain pill, designated and known in trade and by public advertisement, and by dealers and consumers as "Dr. C. McLane's Liver Pills," and that said pills have become very extensively known and used in the United States and in other countries.

Your orator states further that said pills were first made and sold by Dr. Charles McLane, at Morgantown, Virginia, where said McLane resided—that said McLane was the original and exclusive inventor and proprietor of said pills, and first made and sold the same by the name and description of "Dr. McLane's Liver Pills," and by that name they were known and designated and were made and sold only by said Dr. Charles McLane, till June 19th, 1844, when said McLane, by bill of sale of that date, sold his interest therein to one J. K. of Pittsburg, Pennsylvania, giving said K. the right to make and vend the same in the United States, reserving only the privilege of making and vending the same himself in Morgantown, aforesaid, as will appear by said bill of sale, a copy of which is herewith filed marked "A.," and thereby said J. K. became the sole owner and proprietor thereof with the exclusive right to make and sell the same and to use the name thereof, excepting only the personal privilege reserved as aforesaid, and thereupon said K. began at Pittsburg, Pennsylvania, the manufacture and sale of said pills, according to the recipe of said Dr. McLane, and continued such manufacture at said place till about the 11th day of April, 1845, when said K. formed a partnership with one J. F. under the name and style of J. K. & Co., and said K. invested said firm with the full right to make and sell said pills, and to use the name thereof, and said firm engaged largely in the business of making and selling said pills, and in order to designate the same as an article of their own manufacture, and to prevent imposition and fraud upon the public and persons desiring to purchase the same, said firm, during or before the year 1847 commenced putting up said pills in wooden boxes of uniform size, shape and appearance, having perpendicular sides, with top and bottom of elliptical shape, said box containing twenty-two pills, and caused the words "McLane's Liver Pill" to be stamped in red wax upon the cover of each box; and in further pursuance of their said design to designate said pill as the genuine article so manufactured by them as aforesaid, said firm procured at their own expense certain plates, and caused to be made there-

from a certain token-label or trademark, consisting of a wrapper which was placed by them around each box of pills, and which was printed with ink of a light red color; the portion thereof covering the top of each box being engraved with a narrow border of scalloped pattern, surrounding a panel with background or wave line engraving, and with the words "Dr. McLane's Celebrated Liver Pills. In sick headache and in all bilious complaints surpassed by none—25 cts.," engraved thereon and appearing in white letters shaded by red lines; and on the portion of said wrapper covering the rear side of the box a panel of similar background surrounded by a border of dark red and white lines appearing interlaced or woven, and with the words following to-wit: "In future my liver pills will have a red steel engraved wrapper, and my name in red wax on each box," appearing thereon in white letters shaded by red lines, and having also a *fac-simile* of the signature of C. McLane engraved and printed in red ink at the bottom thereof; and upon the portion of the said wrapper covering the front side of the box a panel with a border and background similar to that last mentioned, having the words "Prepared for the proprietor by J. K. & Co., No. 60 Wood St., Pittsburgh, Pa.," thereon in white letters shaded with red lines and also the words "None can be genuine without the signature of J. K. & Co.," printed thereon in red ink the words "J. K. & Co." being a *fac-simile* of said firm's signature. A copy of said label is hereto annexed marked "B," and made part hereof, one of which labels or trademarks was placed on and around each box of said pills made and sold by said firm.

The said firm being thus the sole and exclusive owners of said pills and of the recipe for making the same, and of the said token-label or trademark, and the plates for the same, exclusively made, put up and sold said pills and said label and trademark thereon, and brought the same into notice, and, by the expenditure of large sums of money in advertising and by the exercise of energy and skill, they gave to said pills a wide and enviable reputation, and they derived from the manufacture and sale thereof large profits.

Your orator states further that on the 29th day of March, 1853, said J. K. died leaving the said J. F. the sole surviving partner of said firm of J. K. & Co., who continued the business of said firm, and on or about the 30th day of April, 1853, the executors of said J. K. for the sum of thirty-four thousand dollars, and other considerations, conveyed to said surviving partner, J. F. and to your orator jointly, who formed a partnership under the name and style of F. Bros., all the right, title, interest and claim of said J. K. in and to the goods, chattels, notes, accounts, claims, rights, and credits of every description belonging to the late firm of J. K. & Co. in the drug business in Pittsburg, aforesaid, as will appear by bill of sale thereof dated April 30, 1853, a copy of which is hereto annexed and marked "C."

Under said bill of sale, said J. F. and C. F., composing the firm of F. Bros., at once took possession of the business of making and selling

said "Dr. McLane's Liver Pills," and of said plates, tokens, labels and trademarks, and thereby became the exclusive owners of the same and of the right to make and sell the same with the said labels, tokens, and trademarks thereon, except the right reserved by the said Dr. Charles McLane as aforesaid. On or about January 11th, 1854, L. W. Jr., became a partner in the said firm of F. Bros. and afterwards said Dr. C. McLane relinquished to said F. Bros. all his right thereto, and further recognized and confirmed to said F. Bros. the full and exclusive right in said pills and said labels and trademarks, by contract dated January 8th, 1857, a copy of which is herewith filed marked "D."

Said firm of F. Bros. greatly enlarged the business of making and selling said pills until the year 1855, since which time until the year 1872, while putting them up in boxes of the same material, size and shape as already hereinbefore described, and placing a seal with the words "McLane's Liver Pills" stamped in red wax upon the cover of each box containing said pills as before described, they folded around each box a circular containing remarks upon the nature and effect of said pills and the diseases for which they are recommended with directions for their use, printed in the English, German, French and Spanish languages, a copy of which circular is hereto attached and marked "E;" and in order to still further and more readily distinguish article of pills manufactured by them as aforesaid, as of their own manufacture, they procured new steel plates and caused to be printed therefrom labels or trademarks forming an external wrapper, consisting of a fine steel engraving with a *fac-simile* of the signatures of C. McLane and said firm of F. Bros. engraved thereon, the ground work of said engraved wrapper on the top of the box being composed of fine lines crossing the box diagonally and at right angles with each other and the words "Dr. C. McLane's celebrated liver pills, in sick-headache and in all bilious complaints surpassed by none. Price 25 cts." engraved thereon, showing the letters and figures in white, the said words "celebrated liver pills" being upon a scroll similar to a double ogee in form, with black background. On said engraved wrapper covering one side of said boxes, said firm caused to be engraved and printed the words: "Prepared only by F. Bros. successors to J. K. & Co." all in white letters, also a *fac-simile* of their signature in black, and the words "without whose signature none can be genuine" printed in black letters, and on the opposite side of said boxes are printed other words in white letters as follows: "In future my genuine liver pills will have a fine steel engraved wrapper, and my name in red wax on each box," with a *fac-simile* of the signature of C. McLane in black script, a copy of which label is hereto attached marked "F."

The business of making and selling said pills with said labels, tokens, and trademarks thereon, was carried on by said firm of F. Bros. from the 30th day of April, 1853, in their said firm name, and said firm from said last mentioned date, owned and held among their firm assets the right of making and selling said pills and using thereon said tokens,

labels, and trademarks, notwithstanding the changes that were made from time to time from said 30th day of April, 1853, until the present time, in the individual members of said firm which were as follows:

On the 11th day of January, A. D. 1854, L. W. Jr. became a member of said firm, which was composed of said J. F., C. F. and said W., until the 12th day of October, 1857, when said L. W. Jr. withdrew from said firm, and in consideration of the sum of seventeen thousand dollars conveyed to said J. F. all his right, title and interest and claim of, in and to the property, assets and effects whatever of said firm of F. Bros. including the right to make and sell said pills, and to use said tokens, labels, and trademarks, as will appear by said W. bill of sale of that date, a copy of which is hereto attached, marked "F2," and from and after said 12th day of October, 1857, said firm composed of said J. F. and C. F. carried on the business of making and selling said pills, put up as aforesaid with said labels thereon, until the first day of July, A. D. 1865, when said C. F. withdrew from said firm, and in consideration of the sum of thirty-five thousand dollars, relinquished to said J. F. all his said C's interest, right, title or claim in and to all the property and assets of said firm of F. Bros., and said J. F. thereafter, under said firm name of F. Bros., continued to carry on the business of making and selling and putting up said pills as above described at Pittsburg, Pa., till about the 2nd day of November, 1870, when the said J. F. died, and by will, a copy of which is herewith filed marked "G" and made part hereof, bequeathed to your orator the goodwill and proprietorship of McLane's and other medicines, owned and controlled by him, which included said Liver Pills, and the right to make, put up and sell the same as described last aforesaid, upon certain conditions; in effect that your orator should take charge of and carry on said business, and pay off the pecuniary legacies given in said will, all of which your orator has done, and by his said will, said J. F. bequeathed to your orator after payments of the legacies of said will, all the residue of his estate, and thereby your orator became, and is now, the sole and exclusive owner and proprietor of said pills, and the recipe for making the same, and of said tokens, labels and trademarks, and the plates therefor, and has the sole and exclusive right to make and sell said pills and to use said labels, tokens, and trademarks, and as residuary legatee of said J. F., your orator is entitled to recover all damages or profits, that accrued to him in his lifetime, or to said firm of F. Bros.

And your orator has, since the death of said J. F., continued, and still continues the business of making and selling said pills and using thereon the said label and trademark under the said name of F. Bros., as hereinbefore described, and your orator is now using said label as shown by Exhibit "F," with these exceptions only that within the last few months, he has used and now uses as a ground work on his labels shaded curved lines cutting and crossing each other in such a way as to produce the effect of alternate light and shade crossing the top of

the box diagonally, in place of straight lines crossing each other diagonally as hereinabove described, and he now omits on his labels as now used by him the words "Successors of J. K. & Co." and has also substituted "24" in place of "60" as the number of Wood street, as will appear in Exhibit "H" hereto annexed, and that both said firm of F. Bros. until the death of J. F., and from that time, your orator doing business in said firm name as aforesaid, have, since the passage of the Act of Congress requiring the same, placed across the bottom and ends of each box of said pills when put up for sale, and over the folds of the external wrapper, their proprietary United States Revenue stamp. And your orator says that being the sole and exclusive owner and proprietor of said pills and of the recipe for making the same and of said tokens, labels and trademarks, and the plates therefor as aforesaid, and having the sole and exclusive right to make and sell said pills prepared and put up as aforesaid, with said tokens, labels and trademarks thereon, your orator hoped he might be permitted to exclusively manufacture and sell the same as put up, and to exclusively use, for the purpose of indicating the origin of said pills, said tokens, labels and trademarks, but the defendant, with the intent to injure and defraud your orator in the premises, and to reap the advantages, benefits and profits of the credit and reputation of said pills, is now engaged, and has been engaged for some time, to-wit—a period unknown to your orator, but believed by him to be several years, making and vending, and causing to be vended by others, a spurious, counterfeit and inferior article of pills, prepared in imitation of and calculated and intended to be sold as the genuine "Dr. C. McLane Liver Pills," of your orator's own manufacture, and having thereon a false, forged and counterfeit token-label or trademark, made in imitation of and closely resembling that of your orator, so as to enable the defendant to reap the benefits and profits of the credit and reputation of the genuine pills made and sold by your orator, and his predecessors in ownership, as aforesaid at great expense, and when thus prepared, the defendant has sold, and is now selling and causing to be sold, said spurious and counterfeit pills as the genuine article of your orator's own manufacture, intending to deceive and thereby actually deceiving the public and customers of your orator, and supplanting your orator's trade and injuring him to a large amount, but which your orator is unable to state or fix without a statement or account of the amount of sales made as aforesaid by said defendant.

And the defendant, for the purpose of more completely and effectually deceiving the public, and persons wishing to buy the genuine pills of your orator's own manufacture, puts up his said false, counterfeit and spurious pills in boxes of the same material, size and shape as those used by your orator as aforesaid, and places upon the cover of each box a seal in red wax of the same style, size, and appearance as the red seal used by your orator as aforesaid, and which is specially used and referred to by your orator in his circulars and advertisements,

and relied upon by him to indicate to the public and his customers, the genuine article of pills, made and sold by your orator as aforesaid, and while endeavoring completely to deceive the public and those seeking the genuine pills of your orator, by the use of the red seal so placed upon the cover of the boxes used by the defendant, as aforesaid, he seeks to shield himself from the inevitable consequence of his attempt to injure and defraud your orator by using a stamp impressing in faint and obscure letters on said red wax the words "J. H. McLean, St. Louis," which are yet as illegible as not to undeceive those who are cheated into supposing, from the mere pressure of the seal on the cover of the box, that the same contains the genuine pills manufactured by your orator, and the defendant places around the boxes of pills so put up by him, a circular printed in the English, German, French, Spanish and other languages, a copy of which is hereto attached marked "J." and encloses the whole with a wrapper consisting of a lithograph impression similar in general appearance to the outer wrapper used by your orator, the body thereof being formed like that of your orator, of lines crossing the box diagonally and at right angles to each other, with the words "Dr. J. H. McLean's Universal pills or vegetable liver pills, prepared only by Dr. J. H. McLean, N. 314 Chestnut Street, St. Louis, Mo." printed thereon across the top of each box in white letters; the words "Universal pills" being upon a background of black and on a strip or scroll circular in form; the whole presenting a general appearance similar to the label covering the top of the box used by your orator as aforesaid, while upon the label covering the side of said boxes put up by defendant, are printed the words, "To prevent counterfeiting I have changed the color of my label" in white letters upon a dark background, such as is used by your orator, and with the defendant's name "Dr. J. H. McLean" signed in black script, but in such obscured lettering as to be almost illegible; and on the label covering the other side of said box, the defendant causes to be printed in white letters, in style and appearance resembling the label used by your orator, the words "For the cure of liver complaint, headache, bilious diseases, etc." A copy of said counterfeit label is hereto attached marked "K."

And your orator avers that the defendant caused to be printed and uses said label as aforesaid, as your orator believes and charges the fact to be, for the sole purposes of enabling him to defraud your orator of trade and profit by selling his spurious and counterfeit goods as and for the goods so advertised, manufactured and sold by your orator.

And your orator further says that the illegal and wrongful acts set forth and complained of aforesaid, are but the carrying out of fraudulent designs of the defendant, which he long ago conceived for the purpose of drawing your orator's trade to himself by the wrongful use of fraudulent imitations of said tokens, labels and trademarks of your orator, and in furtherance of the purpose, as your orator believes and charges the fact to be, the defendant did, prior to the year 1855 print

or cause to be printed a certain false or counterfeit label, token or trademark, in imitation of or closely resembling the token label and trademark then and for many years theretofore exclusively used and owned by J. K. & Co. aforesaid, being the label of a light red color hereinbefore fully described and referred to as Exhibit "B." And defendant placed said false and counterfeit labels on boxes of pills of his own manufacture, which boxes were similar to the boxes then used by said J. K. & Co., and on the lid of each box of pills so put up and sold by him he placed a seal stamped in red wax in imitation of that used by said K. & Co. as aforesaid, and then wrapped each box of pills in one of the counterfeit labels last above described, which label consisted of an engraved wrapper printed with ink of a light red color, nearly resembling in shade and general appearance that used by said K. & Co. and with the words "Dr. McLean's Universal Pills for cure of liver complaint, headache, bilious diseases, etc." printed on the portion covering the top of each box, in white letters shaded by a red line, and below the above, the words "Price (see directions inside) 25 cts." On the side of the box were printed on the wrapper the words "Dr. McLean's Universal pillen zur heilung von Leber Krankheiten Kopfweh bilosen Krankheiten U. L. W." appearing in white letters shaded by red lines, as in the genuine label, and with the words "Vorschrift auf der innern seite" printed in red letters underneath, while on the portion of said wrapper covering the opposite side of said box are printed the words "Prepared by J. H. McLean, N. E. Corner 3rd and Pine streets, St. Louis, Mo."

A copy of said label is hereto attached marked "L."

And your orator believes and charges that the defendant procured and used the said last described label solely for the purpose of deceiving the public and those wishing to buy the genuine pills made and sold as aforesaid by said J. K. & Co., but he says that defendant's fraudulent designs were to some extent frustrated and the effects of his wrongful acts partially averted from the rightful proprietor of said label and trademark by the circumstances of the said firm of F. Bros. in the year 1855, having changed the label and wrapper used by them and by said J. K. & Co. prior to that time, and adopted the label lately used by your orator as aforesaid, but your orator says that after the adoption by him of said last named label as aforesaid, the defendant continued for many years to use the red label procured and used by him in imitation of the trademark used by said firm of F. Bros. as aforesaid, but finding the carrying on of his said business unprofitable while he was using his said fraudulent red label, and your orator was using the dark label above described, defendant conceived the design of changing the color of his label, and adopting in place of the red label theretofore used by him, another dark label in imitation of the label or trademark of your orator, which was done, as your orator believes and charges for the purpose of wrongfully diverting the trade of your orator to himself and enabling him to sell his goods as and

for the goods manufactured and sold by your orator, and not for the purpose of preventing counterfeiting as defendant falsely publishes on his own fraudulent label.

Your orator states further that said defendant was never authorized by him to make, put up, or sell said pills as of your orator's own manufacture, or to use or make said tokens, labels or trademarks in imitation of or resemblance to those of your orator as said defendant is charged to have done above, nor to make or sell any such false or counterfeit pills with such false or counterfeit labels attached thereto, but said defendant well knows that your orator is now, and his predecessors were, the sole and exclusive proprietors of Dr. C. McLane's celebrated liver pills and of the said labels and trademarks, marked "B" and "F" as hereinbefore set forth, and said defendant also well knows that said false and counterfeit labels or trademarks used by him are mere imitations of the labels and trademarks of your orator and his predecessors, made, contrived and got up by said defendant with the intent to deceive the public and purchasers thereof, and to defraud your orator.

All of which said acts and things and pretenses are against equity and good conscience, and a great loss and damage to your orator, and inasmuch as your orator is without full redress at law, and can only obtain adequate relief in equity, and as he avers that a continuance of the acts aforesaid, will occasion irreparable loss and injury to him; to the end, therefore, that the said defendant may, if he can, show why your orator should not have the relief hereby prayed, and may upon his corporal oath, and according to the best and utmost of his knowledge, remembrance, information and belief, full, true and perfect answer make to all the allegations hereof, and to the several interrogatories hereinafter numbered and set forth; that is to say:

(Interrogatories and prayer for relief).

M. L. G. & D.,
Solicitors for Complainant.

BILL OF COMPLAINT.

(Richmond Nervine Co. v. Richmond, 159 U. S. 293.)

To the Judges of the Circuit Court of the United States for the Southern District of Illinois:

The Dr. S. A. R. Nervine Co., of Saint Joseph, Missouri, a corporation duly incorporated and organized under and by virtue of the laws of the State of Missouri and a citizen of said state, brings this its bill of complaint against S. A. R., resident of the County of Douglas, State of Illinois, and a citizen of said State of Illinois, and for cause thereof your orator complains and states that heretofore and prior to the 20th day of December, 1877, the said S. A. R. being then engaged in the business of making and selling a medicine known as "Samaritan

nervine," a medicine for the relief of epileptic fits and all other nervous diseases, adopted and used as his trademark on such medicine the figure of a man in an epileptic fit falling backward, with his arms extended and his cane and hat dropping to the ground, with the word "trade" printed in small capitals on the right of said figure and the word "mark" printed in small capitals on the left side of said figure. A copy or specimen of which said trademark, adopted and used by said S. A. R. in his said business and on his said medicine herein aforesaid, as registered in the United States Patent Office March 26th, 1878, is hereto attached, marked Exhibit "A," for the purpose of illustrating and explaining the said trademark, so used and adopted by the said S. A. R. as aforesaid.

Your orator further represents to your honors that after the said S. A. R. had used and adopted said device as and for his trademark in his business the "Dr. S. A. Richmond Medical Company" was incorporated and organized under and by virtue of the laws of the State of Missouri and succeeded the said S. A. R. in the business of manufacturing and selling the medicine aforesaid on which said trademark was used, and acquired all the right, title, and interest in and to said trademark theretofore owned and enjoyed by said S. A. R.

Your orator further represents to your honors that the incorporation of the "Dr. S. A. Richmond Medical Company" about the latter part of the year 1883 or early part of the year 1884, the particular date of which your orator is unable to state, said "Dr. S. A. Richmond Medical Company" adopted and used, in connection with the trademark aforesaid, an engraved portrait of Dr. S. A. Richmond, placed on the outside wrapper in which the bottle of medicine was encased, forming the front side of bottle, and on circulars and other mediums of advertising, and was also blown in the bottles and photographed on paper and pasted on opposite side of the bottles; the words "new style" printed in small capitals on the upper right hand corner of said outside wrapper, and the word "adopted" and figures "1884" printed in same manner in upper left hand corner of said wrapper; also the portrait of said Dr. S. A. R., surrounded by four globes, was placed on outside wrapper on the back of said bottles.

A copy or specimen of said portrait and globes as used, as aforesaid, by said "Dr. S. A. Richmond Medical Company" is hereto attached and marked Exhibit "B" for the purpose of illustration and explanation.

Your orator further represents to your honors that on or about the 13th day of May, 1884, the said "Dr. S. A. Richmond Medical Company" made an assignment for the benefit of its creditors under and pursuant to the laws of the State of Missouri. That said assignment was duly made, prosecuted and wound up according to law. A copy of the resolution of said company authorizing the president thereof to make such assignment is hereto attached, marked Exhibit "C," and made a part of this bill.

That by order of the court in said proceedings of assignment, the formula for compounding said medicine, the goodwill of the business, and the trademark and all other designs used by the said "Dr. S. A. Richmond Medical Company," including the portrait, and portrait connected with globes used by said company as herein aforesaid for the purpose of advertising said medicine, was duly and lawfully sold by the assignee of said "Dr. Richmond Medical Company," and that J. A. R. became the purchaser thereof; that afterwards your orator, "The Dr. S. A. Richmond Nervine Company," was incorporated and organized under and by virtue of the laws of the State of Missouri, and by purchase of and transfer by said J. A. R., succeeded the "Dr. S. A. Richmond Medical Company," in the manufacture and sale of said medicine, the "Samaritan nervine," and acquired all the right, title and interest in and to said personal property, formula, trademark and all devices used in connection therewith, as aforesaid, theretofore owned, adopted, used and enjoyed by the said "Dr. S. A. Richmond Medical Company," and that thereby your orator became and now is the sole, exclusive and rightful owner of said property, formula, trademark, and devices adopted and used in connection therewith, and is entitled to the sole and exclusive use and enjoyment of the same, and is now and for several years last past has been engaged in making and selling said "Samaritan nervine" and using thereon and in connection therewith the trademark and portrait of said Dr. Richmond and said other devices in connection therewith, as hereinbefore mentioned and set out.

Your orator further represents to your honors that after your orator had succeeded to all of the rights of the "Dr. S. A. Richmond Medical Company" and had engaged in the business of making the said medicine aforesaid under said trademark, etc., and about May 1st, 1884, it was adopted as and for an additional trademark for medicine for relieving epileptic fits and other nervous diseases, said portrait of Dr. S. A. Richmond with the word "trade" printed in small capitals on the left side of said portrait, and the word "mark" printed in small capitals on the right of said portrait. A copy or specimen of which said trademark so used and adopted by your orator as registered in the United States Patent Office March 6th, 1888, is hereto attached, marked Exhibit "D," for the purpose of illustrating and explaining the said trademark so adopted by your orator.

That after your orator acquired the said trademark as aforesaid it has been extensively engaged in manufacturing and selling said medicine under said trademarks and said other devices used in connection therewith; that it has extensively advertised said medicine under said trademarks and devices used in connection therewith, and has spent large sums of money in so advertising said medicine and bringing it to the knowledge of the public; that said medicine under said trademarks, etc., has acquired an extensive and valuable reputation all over the United States and in foreign countries through the efforts and labors of your orator and its large expenditures of money in advertising and pushing the sale of said

medicine under said trademarks, etc., and that your orator has acquired a valuable property interest in and to said trademarks that makes their exclusive enjoyment in your orator of great pecuniary value and importance.

Your orator, in further complaint, further represents to your honors that notwithstanding the long use and enjoyment of said trademarks and the portrait, etc., used in connection therewith as aforesaid, which your orator charges and avers was used by the "Dr. S. A. Richmond Medical Company" and by the assignee thereof was sold to your orator and used by it continuously from thence to the present time with the knowledge and consent of the said Dr. S. A. R., and notwithstanding its rights to the exclusive use and enjoyment of said trademarks, etc., the said defendant, S. A. R., for the purpose of defrauding your orator, well knowing the premises and the rights and privileges secured to your orator by the use and adoption of said trademarks, and to appropriate to himself the profits, benefits and advantages which would have accrued to it from the exclusive use of said trademarks, etc., within the district aforesaid, has made what he styles "Samaritan nervine," and is now wrongfully engaged in making the same in Tuscola, county of Douglas and State of Illinois, unlawfully, wrongfully and deceitfully wrapped and packed such so-called "Samaritan nervine" similar to that used by your orator, and is now wrongfully making, and wrongfully and deceitfully wrapping and packing said so-called "Samaritan nervine" in packages similar to that used by your orator and have used thereon both the trademarks aforesaid and the devices connected therewith as aforesaid, in direct violation of the exclusive right to use the same vested in your orator, and that he has by means of said trademarks and devices sold large quantities of so-called "Samaritan nervine" throughout the United States and in said district where your orator is selling its nervine under said trademarks aforesaid in direct infringement of said trademarks. The fact that said defendant is engaged in the manufacture and sale of said medicine and using said trademarks and devices in connection therewith will more fully appear by defendant's affidavit filed in the Patent Office of the United States, a copy of which is hereto attached, marked Exhibit "E", and made a part of this bill.

Your orator further states that what amount of goods said defendant, S. A. R., has sold under said trademarks it is unable to state nor does it know but upon information and belief, but your orator avers that he has sold large quantities of the same, using said trademarks, is now making said so-called "Samaritan nervine" and using said trademarks thereon, and have received and are receiving for such sales great gains and profits, but to what amount your orator is ignorant and cannot set forth, except that it alleges that such gains and profits amount to more than five thousand dollars, exclusive of costs, and that your orator has been damaged to an amount exceeding five thousand dollars, exclusive of costs.

Your orator further represents to your honors that said S. A. R., the defendant herein, well knowing the exclusive right of your orator to

make and vend said medicine, "Samaritan nervine," and the exclusive right and privilege of your orator to use said trademarks and devices in the sale of said medicine and in connection therewith, and in the advertisement of the same, and the great benefit secured to your orator by the use and adoption of said trademarks, intending to injure your said orator and appropriate to himself the profits, benefits, and advantages which would accrue to it from the exclusive use of said trademarks within the district aforesaid, has wrongfully and fraudulently applied to the Patent Office of the United States of America for registration of said portrait of said Dr. S. A. R. adopted and long used by your orator as its trademark aforesaid as and for his trademark; all of which will fully appear by copy of his statement and the declaration filed in the Patent Office of the United States of America, which is hereto attached, marked Exhibit "F", and made part hereof; that said S. A. R. has no interest in the formula for compounding the medicine in suit nor is he entitled to adopt or use said portrait as his trademark.

Your orator further represents to your honors that said S. A. R. is wholly insolvent and worthless, and that he would be unable to pay any damages that your orator might sustain by means of the premises aforesaid; that your said orator has no speedy or adequate remedy at law in the premises, and it can only be protected in its several rights herein by the equitable interposition of this court.

Your orator prays that the defendant may be required to make a disclosure of all such sales and profits, and that they may be required to account with and pay over to your orator all the damages it may have sustained and profits which he has received from such unlawful use of said trademark, and that they may be enjoined provisionally and preliminarily pending a hearing herein.

Wherefore, the premises considered, your orator prays that upon a final hearing the defendant be enjoined and restrained by decree from in any manner making and selling said medicine, "Samaritan nervine," under the name of "Samaritan nervine" or under any other name whatever, and from in any manner using said trademarks or devices enumerated therewith, or either of them or any trademark or marks so nearly resembling them as will be calculated to deceive on any of their preparations and from infringing upon your orator's exclusive right to use the same; that the defendant be enjoined and restrained from the further prosecution of the registration of said portrait as his said trademark before the Patent Office of the United States, and that he be required to account with and pay over to your orator all damages sustained by it and profits by him received from such unlawful use of said trademarks.

That your orator may have such other and further relief in the premises as equity and good conscience will allow and as to this court shall seem meet; and may it please your honors to grant unto your orator a writ of subpœna of the United States of America under the seal of this honorable court, directed to the defendant, S. A. R.,

commanding him to appear in this honorable court, then and there to answer all and singular the premises and to stand to and perform and abide such further orders, directions, and decree as may be made against him; and your orator will ever pray.

H. & P. and B. & B. & P.,
Solicitors for Complainant.

BILL OF COMPLAINT.

(Saxlehner v. Eisner & Mendelson Co., 179 U. S. 19).

To the Honorable the Judges of the Circuit Court of the United States for the Southern District of New York:

Emilie Saxlehner brings this bill of complaint against Eisner & Mendelson Company, and thereupon your orator complains and says, upon information and belief:

1. That your orator is the widow of Andreas Saxlehner, deceased, and resides at the City of Budapest, in the Kingdom of Hungary, and is a subject of the King of Hungary.

2. That the defendant, the said Eisner & Mendelson Company, during the time when the acts hereinafter complained of were committed was, and now is, a corporation duly incorporated under the laws of the State of West Virginia, having an office for the transaction of its business in the City of New York, and is a citizen of the State of West Virginia.

3. That the said Andreas Saxlehner, late of the City of Budapest, in the Kingdom of Hungary, was at all the times herein mentioned, until the 24th day of May, 1889, the proprietor of a certain well situated at Orsöd, within the city limits of the city of Buda (otherwise known in the German language as the city of Ofen), which city has for about twenty-five years last past been, and is now, united with the city of Pest, under the name of Budapest, in said Kingdom of Hungary, the waters of which said well possess valuable medicinal properties.

4. That in or about the year 1863 said Andreas Saxlehner commenced to bottle the waters of said well and to sell the same in the market, and for the purpose of distinguishing his said bitter waters from other bitter waters then known and sold in the market, adopted the arbitrary and fanciful name or trademark of "Hunyadi Janos" for his said bitter waters.

5. That by reason of the great care exercised by him in the business of obtaining, caring for and bottling said waters and selling the same in the market, and the valuable properties of said water, said business soon increased and additional territory was thereafter acquired by said Andreas Saxlehner in which new wells, all giving forth the same water, were opened by him, all being situated near said first-mentioned well, and in a valley surrounded by considerable hills, the geographical

name of which valley and territory contained in it is Orsöd, and thereupon said Andreas Saxlehner applied said name of "Hunyadi Janos" to the bottled water of said spring sold by him in the market.

6. That at or about the time when said Andreas Saxlehner adopted said name of "Hunyadi Janos" as aforesaid, he also adopted a characteristic and novel style of bottles in which said water was sold by him in the market, the same being of a straight shape with a short neck to the top of which was attached a metal capsule bearing the inscription "Hunyadi Janos Budai Keserüviz" (meaning Hunyadi Janos bitter water of Buda) together with a portrait supposed to be a portrait of the mediæval Hungarian hero Hunyadi Janos stamped thereon, and a novel and peculiar label covering almost the whole body of the bottle, the characteristic features of which said label were a division of the same into three longitudinal fields, the middle field bearing said portrait in a medallion with the name "Hunyadi Janos" written in large letters on the top part of said label, the color of the middle field being red. That thence hitherto said natural mineral waters bottled and sold by said Andreas Saxlehner in Hungary and other European countries and in all markets of the world, have been known and called by said name and trademark of "Hunyadi Janos" water. That the said name "Hunyadi Janos" is in no way descriptive of the nature or quality of the water of the said well or wells, but was adopted by the said proprietor as a fancy or ideal name and as a trademark to distinguish the water of his said wells in commerce from all other waters.

7. That soon after said business of bottling and exporting said Hunyadi Janos water had been commenced by said Andreas Saxlehner in the year 1863, said water, named, bottled, and labeled as aforesaid, became popular and was exported to and sold in all the principal countries of Europe and also in the United States of America. That in the countries inhabited by the Latin races, the word "Janos" became the common appellation of said water, it being known as "Eau de Janos" or "Aqua di Janos," while in England and the United States of America the name "Hunyadi" became the common appellation thereof, it being known as "Hunyadi water." That in the month of March, 1876, said Andreas Saxlehner executed a contract to a corporation known as the "Apollinaris Company, Limited," of London, by which he granted to said company the exclusive right to sell his said natural "Hunyadi Janos" bitter water in Great Britain, its colonies and possessions and the United States of America, and other transmarine countries for the term of ten years, which contract was thereafter further extended and terminated on the 25th day of March, 1896.

8. That about the time when said contract was entered into, a label was designed to be used on the bottles of such water which were to be sold through said "Apollinaris Company, Limited," of substantially the same contents and characteristic parts as the label theretofore used, but of a different color, the body of the label being of blue color, while the red color of the central field was substantially retained. That the name

"Hunyadi Janos," together with the historical portrait and the name of "Andreas Saxlehner," were retained on same label in the same manner as before, as was also the division into three longitudinal fields; and the general style of the bottles, as also the capsule and imprint thereon above described remained the same. That said label was substantially like the label used by your orator, the successor of Andreas Saxlehner in said business, as hereinafter referred to. That soon thereafter there was added to said blue and red label a small, narrow strip on the top thereof, in the same blue color, containing the printed words "Sole exporters: The Apollinaris Company, Limited, London," which strip has been since retained, the reading of the print being thereafter changed to "Proprietor: Firm of Andreas Saxlehner, Budapest, Hungary."

9. That ever since the adoption of said red and blue label, as afore said, in or about the year 1876, large quantities of such bitter water thus bottled and labeled were exported by the said Andreas Saxlehner through said Apollinaris Company, Limited, to the United States of America, and there sold to the public, and said water became known in the United States of America under the name of "Hunyadi water," and became known under the name as the property of said Andreas Saxlehner, and was ordered and sold under such name, the same being an abbreviation of the name "Hunyadi Janos." That a large traffic and business in exporting to the United States, and vending therein said water, was established and continuously carried on and is now carried on by your orator as successor in business of said Andreas Saxlehner.

10. That on May 24, 1889, said Andreas Saxlehner died, and your orator, his widow, thereupon succeeded him in said business of bottling and exporting said Hunyadi Janos water, and became and is the proprietor thereof.

11. That since the termination of said contract with said Apollinaris Company, Limited, your orator has continued said business of shipping to the United States, and selling therein said Hunyadi Janos water, commonly known as Hunyadi water, in bottles and with labels and capsules thereon substantially as hereinbefore last described, excepting that upon said labels the statement is contained, "Proprietor: Firm of Andreas Saxlehner, Budapest, Hungary," in place of an indication of the Apollinaris Company as exporters. That your orator is the sole proprietor of the firm of Andreas Saxlehner, and lawfully doing business in Austria-Hungary, under said firm name.

12. That on or about the 12th day of November, 1886, said Andreas Saxlehner duly made application to the United States Patent Office, according to the statute of the United States therefore provided, for registration of the name "Hunyadi" as his trademark for natural aperient waters, and such proceedings were thereafter had, that on or about the 5th day of April, 1887, a certificate of registration of said trademark "Hunyadi" was duly issued to him by said United States Patent Office, dated on said last-mentioned day, and numbered 14,252 to which certificate, or a certified copy thereof, ready in court to be produced, your orator refers for greater certainty.

13. That by reason of said sales by your orator and her predecessors in business, and his and your orator's agents as aforesaid, the said word "Hunyadi" on said label by her used and her predecessor as aforesaid, dealers in mineral water, and the purchasers and consumers of said water generally have come to know and have long known your orator's mineral water under the names and trademarks, "Hunyadi" or "Hunyadi Janos," and under the said label, and in the style of bottles, capsules and labels as before described, and that the water so furnished and sold by your orator in the United States is procured directly from the well or wells aforesaid, and, therefore, to rely upon the said label and trademark as an assurance and guarantee of the genuineness, strength and purity of the said water, and your orator alleges that said assurance and guarantee was and is of great value to your orator and to the dealers and consumers of said water. And that said water so sold by your orator has come generally to be known and designated by the trade so called, and by purchasers and consumers of the water in the United States of America by the first and characteristic word of said trademark, "Hunyadi," the "Janos" being comparatively seldom used in common parlance in this country.

14. And your orator further shows unto your honors that the defendant above named, well knowing the premises and the rights existing in and secured to your orator as aforesaid, but contriving to injure your orator and deprive her of the benefits and advantages which might and otherwise would accrue unto her from the enjoyment of such rights and to injure and impose upon the public, subsequent to the adoption of the said trademark, label, bottle and capsules by your orator and her predecessor, recently and before the commencement of the suit, as your orator is informed and believes, in the city of New York and elsewhere, without license or allowance and against the will of your orator, in violation of the rights of your orator and infringing the said trademark, did unlawfully and wrongfully import for sale and sell and offer for sale bitter water not coming from your orator's said wells in bottles of identical shape and size as those used by your orator and with certain capsules thereon stamped with a portrait in imitation of that impressed on your orator's capsules, surrounded by a circular inscription and the initials H. L. and with labels on said bottles bearing the name "Hunyadi Laszlo," Budai Keserüviz, and a portrait in the middle field of said label, set in a medallion, all in close and fraudulent simulation of your orator's trademark; and that defendant's said labels also further imitate your orator's labels by being divided in three longitudinal fields, covering almost the whole body of the bottle, the color of the middle field being red, and that of the body of the label being blue, and in many other particulars, all contrived to induce the public to take defendant's said water as and in place of your orator's water.

And that other bottles of such water, sold by said defendant, imitate your orator's bottles in shape, size and color, capsule and label, being marked with the name "Hunyadi Matyas," and bearing a label designed

in close and fraudulent simulation of your orator's said label in color, division into three panels and printed matter contained thereon, including a medallion portrait in the central panel and repeated on the capsule.

15. And your orator further shows that the similarity between the said bottles, capsules, labels and names used respectively by your orator and the defendant is so great that the public and consumers and purchasers are likely to be deceived thereby, and are in fact deceived to suppose the water so sold by the said defendant to be that sold by your orator and thereby to cause your orator great loss and damage.

16. That until the year 1890 your orator and her said predecessor in business did not enjoy adequate protection in Hungary in the use of her and his trademarks, tradenames and labels on account of the lack of statutes regulating such matter, by reason of which fact other persons used the name "Hunyadi" in connection with other names as trademarks for other bitter waters, and closely imitated your orator's labels, capsules and bottles, and your orator's predecessor was unable to stop such fraudulent practices. That since 1890, the law of Hungary has been changed, and your orator has succeeded in causing all these fraudulent marks and labels to be suppressed by proper proceedings brought for this purpose, including also the use of the name "Hunyadi Laszlo" and "Hunyadi Matyas," and the labels upon which said names were used by the proprietors of the springs from which said defendant's water came, and that the further use of said names is now a criminal offense in Hungary.

That your orator has duly notified said defendant of her rights and claims in the premises and requested it to desist from such further sales, but said defendant has refused and still refuses so to do.

19. That the value of the matter in dispute between your orator and the defendant, exclusive of interest and costs, exceeds the sum of two thousand dollars.

20. That by reason of the said acts done or threatened and intended to be done by said defendant, all in defiance of the rights of your orator, as aforesaid, great and irreparable loss and injury has been, is and will be caused to your orator, and she has been and is and will be deprived of great gains, profits and advantages which might and otherwise would be obtained and enjoyed; and your orator is informed and believes that the said defendant, by reason of the said sales of the said water under the names of "Hunyadi Laszlo," and "Hunyadi Matyas," and the said labels, capsules and bottles, has made and realized large profits and advantages, and now has in its possession or under its control, or subject to its order a large quantity of said waters, so bottled, capsuled and labeled which it proposes to sell, but to what extent said sales have been made and how large profits have been derived therefrom, your orator does not know and prays a discovery thereof. And your orator further says that such sales made by the said defendant, and the threats and intention of defendant to make such further sales and said unlawful acts in dis-

regard and defiance of the rights of your orator have the effect to and do encourage and induce others to interfere with the said trademark and label, and to violate and disregard your orator's rights.

And, forasmuch as your orator can have no adequate relief except in this court, to the end, therefore, that the said defendant may, if it can, show why your orator should not have the relief hereby prayed and may, according to the best and utmost knowledge, remembrance, information and belief of its officers, full, true, direct and perfect answers make to the premises and to all the several matters hereinbefore stated and charged as fully and particularly as if severally and separately interrogated as to each and every of such matters, and may be compelled to account for and pay to your orator the profits by it acquired and the damages suffered by your orator from the aforesaid unlawful acts. But an answer under oath is hereby expressly waived.

Your orator prays that the said defendant, its officers, servants, agents, attorneys and workmen, and each and every of them, may be restrained and enjoined provisionally and permanently by the order and injunction of this honorable court from procuring, parting with, selling or attempting to sell within the United States of America any water or liquid not coming from the said wells of your orator under the name or designation of "Hunyadi Laszlo" or "Hunyadi Matyas" or any name or designation in which the word "Hunyadi" occurs, and also from procuring, parting with, selling or attempting to sell within the said limits any such water in any bottle or vessel imitating or resembling in form, color and general appearance those used as aforesaid by your orator and her predecessor in business, or bearing upon it any capsule stamped in any manner imitating or resembling the said capsules of your orator, or any label in form, color, design and general appearance imitating or resembling the said label of your orator on the said bottles of Hunyadi Janos water, and also from procuring, parting with or selling or attempting to sell within said limits any such water put up or contained in bottles resembling and bearing capsules, marks and labels resembling those of your orator or bearing the name "Hunyadi."

And your orator also prays that defendant may be decreed to deliver up unto your orator or to this honorable court any and all labels in its possession upon which the words "Hunyadi" or "Hunyadi Laszlo" and "Hunyadi Matyas" appear, or which are made in imitation of or resembling those adopted and used by your orator, and any and all bottles, whether filled or unfilled, and all capsules which imitate or resemble the bottles and capsules used by your orator for said "Hunyadi Janos" water, and to pay unto your orator all profits derived by the said defendant from the sale of any water under the said name "Hunyadi Laszlo" or "Hunyadi Matyas," or any name or designation in which the word "Hunyadi" appears, or any vessel upon which was or is affixed the label or capsules resembling those adopted and used as aforesaid by your orator, as well as the costs of this suit; and that your orator may have such further relief or such other or different relief as to this honorable court shall seem meet and as shall be agreeable to equity.

May it please your honors to grant unto your orator the writ of injunction, as well provisional as permanent, issuing out of and under the seal of this honorable court, commanding, enjoining and restraining the said defendant, its officers, servants, agents, attorneys and workmen, and each and every of them as is hereinbefore and in that behalf prayed.

May it please your honors to grant unto your orator the writ of subpœna issuing out of and under the seal of this honorable court directed to the said defendant, Eisner & Mendelson Company, by a certain day and under a certain penalty to be and appear in this honorable court, there and then to answer the premises and to stand to and abide such order and decree as may be made against it.

And your orator will ever pray, etc.

B. & K.,
Complainant's Solicitors.

BILL OF COMPLAINT.

(Hennessy v. Herrmann, 89 Fed. Rep. 669.)

In the Circuit Court of the United States for the Northern Judicial District of the State of California.

JACQUES RICHARD MAURICE HENNESSY, JACQUES FRANCIS HENRY HENNESSY, JAMES RICHARD CHARLES HENNESSY, ARMAND CASTILLON and EMMANUEL CASTAIGNE,
against
J. H. and C. S.
} In Equity.

To the Honorable Judges of the Circuit Court of the United States for the Northern Judicial District of California:

First. J. R. M. H., J. F. H. H., J. R. C. H., A. C. and E. C., all of Cognac in France, and citizens of the Republic of France, bring this their bill of complaint against J. H. and C. S., of the city and county of San Francisco, State of California, residents of the Northern Judicial District aforesaid, and citizens thereof, and thereupon your orators complain and say:

Second. Complainants state that at all the times hereinafter mentioned they were copartners under the firm name and style of James Hennessy and Company. That the complainants are, and for a long time previous to the commission of the grievances hereinafter mentioned have been, exporters, bottlers and vendors of a cordial or liquor known as Hennessy brandy, which the complainants and their predecessors in the partnership business have for upwards of thirty years last past produced, bottled and sold.

Third. That said brandy when bottled by these complainants is put up in peculiar tall, dark colored bottles, to-wit, twelve inches in height,

bearing (a) a rectangular label bearing the inscription, "Jas. Hennessy & Co., Cognac," in gold letters on a white ground, encircled by a wreath of vine leaves and grapes, in gold, said wreath being surmounted by an arm bearing a battle axe, also in gold; (b) a small oblong label of white with gold border lines, bearing the word "France" in gold; (c) a crescent-shaped label; (d) a cork branded with the words "James Hennessy & Co."; (e) a metal capsule; all with their own proper devices and trademarks adopted by the complainants for that purpose the year A. D. 1870, and all encased in square wooden boxes holding twelve bottles each.

Fourth. That complainants' trademarks have been duly registered under the provisions of the statute of the United States in the year A. D. 1881. That by reason of the long experience and great care of the complainants in their said business, and the good quality of said brandy, distinguished as it was by its trademarks, tradenames, labels, corks, capsules, and the shape, size and color of its bottles, the same has become widely known in the community and throughout the world as a useful and valuable cordial and acquired a high reputation as such, and has commanded and still commands an extensive sale throughout the United States and Europe, which is and has been a source of great profit to these complainants. That your orators' tradename and trademarks are of a value of two thousand dollars and upwards. That said brandy when bottled by complainants is known as such brandy to the public, buyers and consumers thereof by the said name of James Hennessy & Company's brandy, or Hennessy brandy, or Hennessy cognac, together with the complainants' own proper devices, tradenames, and trademarks aforesaid, and by its straw wrappers or casings accompanying and enclosing said bottles, and by the peculiar shape and color of the bottles themselves.

Fifth. Complainants state that, notwithstanding the long and quiet use and enjoyment by the complainants of said tradename and trademark and to the form, device and descriptive matter of said labels, the defendants, well knowing the premises and with the preconceived intention to injure the complainants, and with the purpose to defraud them, and with the purpose to deprive these complainants of the benefits and profits resulting from the great reputation acquired for said brandy, and the consequent demand therefor, and with the intent to acquire for themselves the benefits and profits of said reputation, and with the intent to assist others to palm off on the public brandy not being exported, sold or bottled by complainants, as the goods of the complainants, and in wilful disregard of complainants' rights in the premises, kept, offered for sale and sold, and advertised for sale, and now keep, offer for sale and sell in the city and county of San Francisco and State of California, and elsewhere in the United States of America, counterfeit labels in imitation of complainants' labels under the name of "Hennessy & Co.," using *facsimiles* of complainants' tradename, devices and labels, which with intent to deceive and defraud the public and the buyers and consumers thereof, they have caused to be sold to dealers engaged in counterfeiting the bottled brandy of your orators; that defendants sold said labels for the

purpose and with the intent that they should so be used, and that in fact they have been so used, in fraud of your orators' rights.

Sixth. That such imitation labels are calculated to deceive the purchasers and consumers of said brandy, and are calculated to cause the public and the buyers and consumers thereof to believe that the brandy kept and offered for sale and sold by defendants' customers is the brandy exported, bottled and sold by the complainants.

Seventh. That such imitation is calculated to deceive and mislead the purchasers and consumers of the complainants' brandy, and has actually deceived and misled and still does mislead many of them to buy the brandy or liquor sold by the defendants' customers in the belief that it is the brandy exported and bottled by the complainants, to the great loss, injury and damage of the complainants. That the article so put up and sold by the defendants' customers is of greatly inferior quality to that of the complainants, and deleterious to the health of the consumer, and the general esteem and reputation of the brandy exported by the complainants has been and is now being injured and damaged thereby.

Eighth. Forasmuch as your orators can have no adequate relief except in this court, and to the end, therefore, that the defendants may, if they can, show why your orators should not have the relief hereby prayed, and may make a full disclosure and discovery of all the matters aforesaid, and according to the best and utmost of their knowledge, remembrance, information and belief, full, true, direct and perfect answer make to the matters hereinbefore stated and charged, but not under oath, an answer under oath being expressly waived.

And that the defendants may be decreed to account for and pay over adequate damages arising from their aforesaid acts in violation of your orators' rights, your orators pray that your honors may grant a writ of injunction issuing out of and under the seal of this honorable court, perpetually enjoining and restraining the said defendants, their clerks, attorneys, agents and servants from keeping, offering for sale, or selling any brandy not being the brandy exported and bottled by your orators, put up in bottles of the general form, shape and color of complainants' bottles, and wrapped with labels of the form, device and in the manner complained of, or in any other form and device which shall be a colorable imitation of complainants' brandy, or from applying to any such brandy the name "Hennessy Brandy," or from using upon or in connection with said brandy or any counterfeit of your orators' labels or cases the name "Hennessy," or any combination of such name or name of like sound, and that the defendants deliver up to your orators all bottles having thereon said false label, and also all such false labels in their possession or under their control, to the end and purpose that the same may be destroyed.

And that your honors upon the rendering of the decree above prayed may assess, or cause to be assessed, the damages your orators have sustained by reason of the premises.

May it please your honors to grant unto your orators not only a writ of injunction conformable to the prayer of this bill, but also a writ of subpœna of the United States of America, directed to the said J. H. and C. S., commanding them on a day certain to appear and answer unto this bill of complaint, and to abide and perform such order and decree in the premises as to the court shall seem proper and required by the principles of equity and good conscience.

J. L. H.,
Of Counsel.

A. L. P. and J. L. H.,
Solicitors for Complainants.

UNITED STATES OF AMERICA,
Northern Judicial District of California, ss.

J. L. H., on behalf of the said complainants, Jacques Richard Maurice Hennessy, Jacques Francis Henry Hennessy, James Richard Charles Hennessy, Armand Castillon and Emmanuel Castaigne, and duly authorized to act for them herein, being on his oath sworn, deposeth and says that he has read the above bill of complaint, and that the matters therein set forth are true to his best knowledge, information and belief.

Subscribed and sworn to before me, this 19th day of July, 1898.

S. H.,
Clerk U. S. Cir. Ct., N. D. C.

ANSWER.

(Benkert v. Feder, 34 Fed. Rep. 534.)

In the Circuit Court of the United States in and for the Ninth Circuit and District of California.

WILLIAM J. BENKERT, Complainant,
vs.
MORRIS ROSENTHAL and SAMUEL FEDER, Defendants.
} No. 3507.

The answer of M. R. and S. F. to the bill of complaint of W. J. B., complainant.

These defendants, saving and reserving to themselves all right of exception to said bill of complaint on account of the many errors therein contained, for answer thereto or to so much and such parts thereof as they are advised by counsel it is necessary or important for them to make answer unto, answering, say:

That they have no knowledge or information other than from said bill of complaint as to the partnership or business of the complainant and Casper Benkert, or the continuance thereof, and can not admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the sale by Casper Benkert to com-

plainant of his interest in said alleged business and the carrying on and ownership and proprietorship thereof, and can not admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the business of the partnership of C. Benkert & Son and of complainant, or of the boots and shoes manufactured and sold by them or either of them, or of the quality, quantity and price of such boots and shoes, or the mark or other designation thereof or thereon, and can not admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the placing as a trademark upon said boots and shoes, and to indicate the ownership and origin thereof, the words "C. Benkert & Son," and to the knowing of said boots and shoes by the name of "C. Benkert & Son," and can not admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants say that they have no knowledge or information other than from said bill of complaint as to the name of "C. Benkert & Son" being a trademark, or the ownership of said name, or the right to use and place the same upon boots or shoes, and can not admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

These defendants and each of them deny that they have for more than five years last past been partners in trade as set forth in said bill of complaint, except as follows: for the four years previous to the month of March, 1884, they, with one Bromberger, were partners in trade under the firm name of Rosenthal, Feder & Co., and in said month said Bromberger retired from the co-partnership formed by them; since said month these defendants have been partners in trade as set forth in said bill of complaint.

These defendants and each of them deny that within five years or at any time or times whatsoever they or either of them had manufactured or sold, or are now manufacturing or selling, large or any quantities of boots and shoes or boots or shoes, or each or either, on any of which they have placed in plain or conspicuous letters, or at all, the name of "C. F. Benkert & Son," in imitation of the name of "C. Benkert & Son," as alleged in said bill of complaint, or at all.

Defendants and each of them deny that they or either of them have stamped in sole-leather or buttons or any other part of said boots and shoes, or any boots or shoes whatsoever, in plain conspicuous letters or otherwise, the name or words "C. F. Benkert & Son, Phila."

Defendants deny that they have manufactured or are still manufacturing said boots and shoes or any boots or shoes marked with the name of "C. F. Benkert & Son" in San Francisco, Hawaiian Islands, other domestic or foreign markets or elsewhere, and admit and show to this court that they have sold in San Francisco and elsewhere a small

quantity of boots and shoes marked "C. F. Benkert & Son," comprising not more than two hundred and fifty dozen pairs thereof; and further state and show that the boots and shoes so sold were of an entirely different class, style, nature and grade from the boots and shoes alleged in said bill of complaint to be manufactured by the complainant and as such were recognized by and sold to the customers and patrons of these defendants.

Defendants say they have no knowledge or information other than from said bill of complaint as to the relative quality, cost of manufacture and prices of sale of said boots and shoes and the boots and shoes made by the complainant, and can not admit or deny the allegations of said bill relative thereto, and insist that complainant make proof thereof.

Defendants and each of them deny that they have had manufactured for them as set forth in said bill of complaint large or any quantities of boots or shoes or any boots or shoes whatever on which was printed the name "C. F. Benkert & Son" or stamped "C. F. Benkert & Son, Phila.," as set forth in said bill of complaint, excepting not more than three hundred and twenty-one dozens thereof, and the defendants and each of them deny that they have sold or are still selling boots and shoes with said words printed or stamped thereon in San Francisco or elsewhere, excepting that they have heretofore sold not more than the two hundred and fifty dozens thereof aforesaid.

The defendants and each of them deny that they have placed or caused to be placed on said boots or shoes alleged to have been sold by them or upon any other boots or shoes whatsoever said words, to wit, "C. F. Benkert & Son," for the purpose of deceiving the public or purchasers generally, or any other person, or causing them or any of them to believe the said boots or shoes were manufactured by the complainant or at all. They deny that the public or purchasers generally or any of them have been deceived or have believed on account of said names being on said boots or shoes that the same were genuine or other boots or shoes manufactured by the complainant, and that being deceived as alleged in said bill of complaint, or being deceived at all, have purchased or are now purchasing, or these defendants have sold or are now selling, said boots or shoes as or for genuine or other boots or shoes manufactured by the complainant. They deny that by any of the acts and doings set forth in said bill of complaint they or either of them have unlawfully or otherwise greatly or at all injured or depreciated the complainants' trade in fine or other boots or shoes, or the good or other reputation or standing of said boots or shoes, alleged in said bill of complaint to have been had by them.

Defendants and each of them deny that, unless restrained by injunction, they by using said name on the boots and shoes sold by them will infringe on the alleged name and trademark of the complainant and deny that they have already at any time been doing the same.

The defendants state and show that they have sold not more than two hundred and fifty dozens of boots and shoes marked "C. F. Benkert

& Son," and have realized therefrom a profit of about and not more than five hundred (500) dollars.

The defendants and each of them deny that by reason of the said alleged infringement, or of any other act or doing of these defendants or either of them, the complainant has suffered loss or damage to a very large or other amount or any loss or damage whatsoever.

Without this that there is any other matter, cause or thing in the said bill of complaint contained material or necessary for these defendants or either of them to make answer unto and not herein and hereby well and sufficiently answered, confessed, traversed and avoided is true to the knowledge or belief of these defendants; all of which matters and things these defendants are ready and willing to aver, maintain and prove as this honorable court shall direct, and humbly pray to be hence dismissed with their reasonable costs and charges in this behalf most wrongfully sustained.

M., B. & M.,
Solicitors for Defendants.

I. S. B.,
Of Counsel for Defendants.

ANSWER.

(Brown Chemical Co. v. Meyer, 139 U. S. 540.)

THE JOINT ANSWER OF CHRISTIAN F. G. MEYER, et al. to the Bill of Complaint of the BROWN CHEMICAL COMPANY.

These defendants now and at all times hereafter saving and reserving unto themselves all benefit and advantage of exception which can or may be had or taken to the many errors, uncertainties and other imperfections in the said bill contained for answer thereto or to so much and parts thereof as these defendants are advised it is material or necessary for them to make answer unto, say, etc.

These defendants have no information sufficient to form a belief as to whether or not said complainant has for a period of many years last past been engaged in the preparation and sale of a certain medicine at the city of Baltimore and therefore call for strict proof of same although defendants are informed and believe that complainant has been engaged in the preparation and sale of a medicine, but these defendants on information and belief deny that said medicine has acquired or long enjoyed a very high or any particular reputation as a remedy for the prevention or cure of many or any diseases, but whether it is sold in immense or any considerable quantities to complainant's great profit these defendants have no information sufficient to form a belief although defendants believe that complainant has sold enough of said medicine to make some profit.

These defendants further answering said bill of complaint admit, on information and belief, that said complainant as alleged in said bill has adopted, applied and used, and is using a certain label with the words and representations as described and set forth in said bill, but as

to whether or not as set forth in said bill said label has been used since about the year 1879, or as to whether or not said complainant devised or originated said label, these defendants have no information sufficient to form a belief, and therefore calls for strict proof of said allegations.

These defendants further answering said bill of complaint admit on information and belief that the designation "Brown's Iron Bitters" has come to be associated with complainant's medicine or product, but whether or not to the exclusion of all others, defendants can not say as matter of law, but defendants say as matter of fact, no other Brown Iron Bitters are known to these defendants, and that those desiring complainant's medicine are in the habit of using the designation "Brown's Iron Bitters" with the understanding that it means complainant's medicine alone since there are no other Brown's Iron Bitters made up or sold to the trade as defendants are informed and believe; and that whenever the said designation, Brown's Iron Bitters are used, it means a medicine prepared and put up by complainant at the city of Baltimore, in the state of Maryland.

These defendants further answering said bill of complaint say they have no information sufficient to form a belief as to whether or not said complainant has spent large sums of money in advertising amounting to hundreds of thousands annually, although defendants believe complainant has advertised extensively. Defendants admit that complainant's output has been of great magnitude, amounting to many thousands of bottles annually, but as to whether or not said bottles have all borne a label consisting in part of the words "Brown's Iron Bitters," these defendants do not know, but believe and suppose it is so.

These defendants admit on information and belief that the said designation "Brown's Iron Bitters" has come to be identified with said complainant's product, but not to the exclusion of all others as matter of legal right, although as before stated, these defendants know of no other "Brown's Iron Bitters" in the trade. Defendants do not know whether or not said designation is known and is now used in all parts of the United States by consumers generally when they desire to obtain the said preparation of complainant, although these defendants know of no other preparation of the same designation.

These defendants further answering said bill of complaint say they have no information sufficient to form a belief as to whether or not said designation has ever been employed in connection with any other preparation or remedy, and therefore calls for strict proof of the same; but these defendants deny that the said designation is to all intents and purposes, or to any intent or purpose complainant's tradename or trademark, or that said complainant now has or has ever had the exclusive right to the use of said designation as a tradename or trademark for a medicinal preparation or otherwise, or that no one except complainant has had, or now has any right to use said designation as a tradename or trademark for a medicinal preparation or otherwise; and these defendants further answering deny that they have done anything which is fraudulent or which will be restrained by this Honorable Court.

These defendants further answering said bill of complaint admit that they were engaged in business as wholesale druggists at the city of St. Louis, in the state of Missouri, but deny that they have been long or at all cognizant of the high reputation or any particular reputation of complainant's medicine, but admit that for some time they have known of the said designation "Brown's Iron Bitters."

These defendants further answering said bill of complaint admit that prior to the commencement of this suit and as well since they had and have sold medicine put up in bottles to which have been attached and applied labels containing the words "Brown's Iron Tonic," but these defendants explicitly deny that such sales or any of them were or have been made in order to injure complainant by diverting any profits of complainant in the sale of its medicine or otherwise, or that such sales were fraudulently made, or that the bottles or the labels thereon containing the words "Brown's Iron Tonic," were intended by these defendants or any of them to indicate that the medicine contained in said bottles was prepared and put up by complainant; and these defendants deny that they ever have fraudulently offered or caused to be offered or sold or that they still fraudulently offer or cause to be offered or sold in large or any quantities the said medicine so as aforesaid labelled "Brown's Iron Tonic," although these defendants admit that they have, as of right they might, offered and sold and still offer for sale said "Brown's Iron Tonic;" as they have bought and sold complainant's said medicine, but without loss or injury to said complainant.

These defendants further answering said bill of complaint, deny that large or small, or any quantities or quality of said Brown's Iron Tonic have been, through any act of these defendants, or any of them, or through any use by them of said designation of "Brown's Iron Tonic" at any time sold as or for complainant's "Brown's Iron Bitters" or mistaken therefor in any instance, or that said complainant has lost anything or been injured thereby.

These defendants further answering said bill of complaint, deny that it was their purpose to offer or sell said "Brown's Iron Tonic" upon any reputation established by complainant or as or for complainant's said alleged celebrated "Brown's Iron Bitters"; and defendants deny that any of their acts in the premises have been or are contrary to equity or good conscience, or that they ought to be enjoined from the further sale of said "Brown's Iron Tonic."

These defendants further answering said bill of complaint state that while they claim and allege that the words "Brown's Iron Bitters" are not the subject of trademark or tradename, and that defendants or anybody else might legally use the same words especially if as in this case, the entire designation is not used but is changed so as to exclude the idea of any misleading or fraudulent purpose; yet these defendants have as good right as complainant possibly could have to the use of the entire designation "Brown's Iron Bitters" and as ground of this claim and as further answer to said bill of complaint, these defendants aver

on information and belief, and charge the truth to be that in or near the summer of 1881, one E. L. B. in connection with one C. J. L. commenced putting up and selling the said preparation "Brown's Iron Tonic" at Little Rock, Arkansas, as a wholly distinct preparation from "Brown's Iron Bitters," and without any intention or purpose to imitate complainant's said preparation, which at that time had not been advertised or sold to any great extent, as these defendants on information and belief aver. Subsequently to this date, as these defendants on information and belief, aver, said B. sold out his interest in said preparation to said C. J. L., who has since that time been putting up, at Little Rock, Arkansas, said medicine, and offering it to the public, and these defendants have bought some of it and sold some of it, viz: Four gross bottles before March 24th, 1886, and since that date about seven gross bottles.

These defendants further aver that the said preparation "Brown's Iron Tonic" as offered and sold by him, as well as by said B. & L. and since by said L., has been put up in cartons and bottles wholly differing in size, color and appearance from said complainant's bottles and with labels adapted and applied to the bottles wholly differing in size, color, appearance and details from complainant's labels, which are enclosed in wrappers wholly different from said cartons of "Brown's Iron Tonic," so that the public could not be misled or the complainant injured, which has always been very far from these defendants' purpose or object, and as well very far from said B. and L.'s purpose or object as these defendants believe; these defendants exhibit and file with this answer a bottle of "Brown's Iron Tonic" with its carton and label marked exhibit "C" and as well a label, wrapper and bottle of complainant's preparation, marked Exhibit "D," and pray that the court will consider them as part of this answer.

These defendants further answering said bill of complaint, on information and belief, aver and charge the truth to be that early in 1882, the said complainant entered into a correspondence with said L. & B. with respect to said "Brown's Iron Tonic," and said L. & B. sent complainant a sample bottle of their Tonic, wrapper and label. Whereupon as a result of said correspondence and examination, said complainant in a letter to said L. & B. expressed themselves as satisfied that said "Brown's Iron Tonic" did not conflict with said "Brown's Iron Bitters," which letter was and is in words and figures as follows:—

BALTIMORE, August 28th, 1882.

MESS. C. J. LINCOLN & CO.,
Little Rock, Ark.

Gentlemen:—Inclosing your invoice thank you for your kind and satisfactory letter. We wish the Brown's Iron Tonic a success as upon examination we can not see where it can conflict with us except in the multiplicity of the Brown family.

Your fr'ds,
Brown Chemical Co.

Said complainant has, as these defendants are informed and believe, ever since the date of said letter, with full knowledge of all the facts and after examination with respect to same, made no complaint of or objections to the putting up and sale of said "Brown's Iron Tonic" until just before this suit was brought, and so by its said letter and its long silence and acquiescence in the manufacture and sale of said "Brown's Iron Tonic" said complainant ought not in equity and good conscience, if for no other reason, to be granted in a court of equity any relief in the premises.

These defendants further answering said bill of complaint, deny that the complainant has suffered by the acts of these defendants, damage to the extent of Ten Thousand Dollars, or any other sum, or that said complainant has been done any wrong by these defendants or is entitled to any relief in the premises.

And these defendants deny all and all manner of unlawful combination and confederacy, wherewith they are by the said bill charged, without this, that any other matter, cause or thing in the complainant's said bill of complaint contained, material or necessary for these defendants to make answer unto, and not herein and hereby well and sufficiently answered, confessed, traversed and avoided or denied, is true, to the knowledge or belief of these defendants; all which matter and things these defendants are ready and willing to aver, maintain and prove, as this Honorable Court shall direct; and pray to be hence dismissed with their reasonable costs and charges in this behalf most wrongfully sustained.

B. A. & McK.,

Solicitors for Defendants.

APPENDIX I

FORMS OF INJUNCTION.

INTERLOCUTORY DECREE.

(Benkert v. Feder, 34 Fed. Rep. 534.)

In the United States Circuit Court, Northern District of California, Ninth Judicial Circuit.

WILLIAM J. BENKERT, Complainant, *vs.* SAMUEL FEDER and AURELIA ROSENTHAL, Executrix of the Last Will and Testament of MORRIS ROSENTHAL, Deceased, Defendants.	No. 3507.

At a stated term, to-wit, the February term, 1888, of the Circuit Court of the United States of America of the ninth judicial circuit, in and for the northern district of California, held at the court room thereof, in the city and county of San Francisco, on Monday, the 1st day of June, A. D., 1888.

Present: The Honorable Lorenzo Sawyer, circuit judge.

This cause having come on to be heard upon the bill of complaint herein, the answer of the defendants, and replication of the complainant, the bill of revivor, the stipulation of the parties in regard thereto, and the proofs, documentary and written, taken and filed in said cause, and having been argued by counsel for the respective parties and submitted to the court for consideration and decision:

Now, therefore, on consideration thereof, it is ordered, adjudged and decreed, and the court doth hereby order, adjudge and decree, as follows, to-wit:

That the name of "C. Benkert & Son" has been a tradename and also a trademark upon boots and shoes for upwards of twenty-five years last past, and as such tradename and trademark is good and valid in law.

That the complainant, William J. Benkert, is, and ever since the year 1876 has been, the exclusive owner of said tradename and trademark, and during all said time, at the city of Philadelphia, in the state of Pennsylvania, has carried on the business, under the said tradename, of manufacturing and selling boots and shoes, and during all said time has stamped and printed, and used upon all the said boots and shoes so made and sold by him, the said words "C. Benkert & Son" as a trademark.

That the original defendants herein, Samuel Feder and Morris Rosenthal, made and sold by him, the said words "C. Benkert & Son" as a trademark, exclusive rights of the complainant under the same—that is to say, by

manufacturing and selling within the ten years last past, and prior to the commencement of this suit, large quantities of boots and shoes upon each of which they have placed in plain, conspicuous, printed letters the name "C. F. Benkert & Son" in imitation of the name "C. Benkert & Son" as charged in the bill of complaint.

And it is further ordered, adjudged and decreed, that the complainant do have and recover of and from the defendants, Samuel Feder and Aurelia Rosenthal, executrix of the last will and testament of Morris Rosenthal, deceased, the profits, gains and advantages which the said defendants or either of them have received or made, or which have arisen or accrued to them, or either of them, from the infringement of the said tradename and said trademark of "C. Benkert & Son" by the making, using and selling, or the making, using or selling of said boots and shoes having placed thereon the name "C. F. Benkert & Son" or any other name in imitation of complainant's tradename and trademark of "C. Benkert & Son."

And it is further ordered, adjudged and decreed, that the said complainant do recover of the defendants his costs and charges and disbursements in this suit to be taxed.

And it is further ordered, adjudged and decreed, that it be referred to S. C. Houghton, Esq., the standing master in chancery of this court, residing in the city and county of San Francisco, northern district, and state of California, to ascertain and take, and state, and report to this court, an account of the number of pairs of boots and shoes manufactured and sold or manufactured or sold by the original defendants, Samuel Feder and Morris Rosenthal, or either of them, and also the gains, profits and advantages which the said original defendants or either of them, or the estate of said Morris Rosenthal, have received, or made, or which have arisen or accrued to them or either of them, or it, from infringing the said exclusive rights of the said complainant by the manufacturing and selling, or manufacturing or selling, of boots and shoes having stamped and placed upon them the infringing trademark in imitation of the trademark of "C. Benkert & Son."

And it is further ordered, adjudged and decreed, that the complainant on such accounting have the right to cause an examination of the defendants, Samuel Feder and Aurelia Rosenthal, and each of them, and their and each of their agents, servants, or workmen or other witnesses as may be necessary to take said accounting, and also the production of the books, vouchers and documents of which said defendants, Samuel Feder or Aurelia Rosenthal, and their and each of their attorneys, servants, agents and workmen may be possessed, and cause them to attend for such purposes before said master from time to time as such master shall direct.

And it is further ordered, adjudged and decreed, that a perpetual injunction be issued in this case, against the said defendants, Samuel Feder and Aurelia Rosenthal, restraining and perpetually enjoining them and each of them, and their and each of their servants, agents, clerks and workmen, and all persons claiming or holding under or through them, from manufacturing or using or selling, or in any way disposing of, boots

and shoes or boots or shoes having stamped, or printed, or in any way marked thereon the name "C. F. Benkert & Son," or any other name in imitation or simulation of the said trademark "C. Benkert & Son," pursuant to the prayer of the said bill of complaint

LORENZO SAWYER.
United States Circuit Judge, Ninth Judicial Circuit.

WRIT OF INJUNCTION.

In the Circuit Court of the United States for the Ninth Judicial Circuit in and for the Northern District of California.

BOORD & SON, Complainant,
vs.
E. G. LYONS COMPANY, Respondent.
} In Equity.

The President of the United States, To E. G. Lyons Company, its clerks, agents, servants and employes, Greeting:

Whereas, It has been represented to us in the Circuit Court of the United States for the northern district of California that Boord & Son, a corporation, of London, England, have a valid trademark in a device consisting of a cat standing upon a barrel, as applied to bottled gin, and that you, the said E. G. Lyons Company, have infringed said right by dealing in bottled gin bearing an imitation of said trademark:

Now, therefore, you, the said E. G. Lyons Company, your clerks, agents, servants and employes, are strictly commanded and enjoined under the pains and penalties which may fall upon you, and each of you, in case of disobedience, that you forthwith and until the further order, judgment and decree of this court, desist from dealing in any gin bottled in imitation of complainant's gin and bearing the device of a cat standing upon a barrel.

Witness, the Honorable Melville W. Fuller, Chief Justice of the United States, this 14th day of October, in the year of our [SEAL] Lord one thousand eight hundred and ninety-eight, and of our Independence the 123d.

SOUTHARD HOFFMAN, *Clerk.*

FINAL DECREE.

(Royal Baking Powder Co. v. Royal Chemical Co., Price & Steuart, 1.)

This cause having been tried at a special term of this court, before the Hon. Hooper C. Van Vorst, one of the justices thereof, without a jury, and the proofs and allegations of the parties having been heard, the said court gave its decision in writing in favor of the plaintiffs,

and against the defendants, with costs; which decision has been filed with the clerk of this court:

Now, in pursuance thereof, it is hereby adjudged that the plaintiffs are entitled to judgment on all the issues, and judgment is hereby rendered in favor of the plaintiffs, and against the defendants thereon, and it is hereby also adjudged that the plaintiffs are entitled to the exclusive use of the term "Royal," as their trademark, on labels attached to baking powder manufactured by them, and in connection with the words "baking powder." And it is further adjudged, that the use by the defendants of the word "Royal" on labels affixed to baking powder, made by the defendants, or printed or written on boxes, labels or otherwise howsoever, in connection with baking powder made by them, was in violation of the plaintiff's rights.

And it is further adjudged, that the defendants, their agents, clerks, workmen, servants and attorneys, perpetually refrain, and they are hereby perpetually enjoined and restrained, from using the term or designation "Royal" on, or around, or in connection with, any cans, boxes or other packages, of any nature or kind whatever, containing baking powder, or in any sign, invoice, billhead, card, circular, advertisement, in connection with baking powder, and from using the name "Royal Baking Powder," and from selling and disposing of any baking powder with the word "Royal" attached thereto, except on such baking powder as is obtained from the plaintiffs.

And it is further adjudged, that the plaintiffs recover of the defendants their costs and disbursements in this action.

INJUNCTION.

(Gillis v. Hall, 2 Brewst. 342.)

Defendants enjoined "from making and selling any preparation as and for the preparations specified in plaintiff's label, and from using the name of Hall, or R. P. Hall, or Reuben P. Hall, either singly or in connection with others, upon any such preparation; or from making or using any trademark, label or wrapper in imitation of those now in use by plaintiff."

(Colton v. Thomas, 2 Brewst. 308.)

Injunction against defendant "restraining the further use of the cards and signs complained against in the bill; and also to restrain the employment by him of any device by which the patients and patrons of the plaintiff, without the exercise of excessive care, will be induced to suppose that the defendant's place of business is the place of business of the Colton Dental Association."

(Gillott v. Esterbrook, 47 Barb. 455.)

"Ordered and adjudged that the said defendants, R. E., R. E., Jr., J. C., Jr., and J. B., and each of them, their agents and servants, do

absolutely and perpetually desist and refrain from infringing or using the said trademark of the plaintiff, and from making or selling pens with said numerals '303' impressed on the boxes or packages containing steel pens."

(Jurgensen v. Alexander, 24 How. Pr. 269; Cox, 298.)

Ordered: (1) "That the defendant, his agents, clerks, servants and all others employed under or in connection with him be perpetually enjoined and restrained from disposing of, selling or causing to be disposed of or sold, any watches bearing the false, simulated and spurious stamp or mark, 'Jules Jurgensen, Copenhagen.'"

2. "That the defendant do produce before Nathaniel Jarvis, Esq., appointed herein referee for such purpose, the said watches, which at the time of the commencement of this suit were in defendant's possession, and had upon them the said false, simulated and spurious trademark, to be erased or obliterated therefrom, by or under the direction of the said referee, at the cost and expense of the said defendant."

(Coffeen v. Brunton, 4 McLean, 516; Cox, 82.)

"To enjoin the defendant from using the label or directions accompanying the liniment he sells as aforesaid, or other labels or directions, or any advertisements or handbills respecting the same words which are used by the complainant on his label or directions, and which tend to produce an impression on the purchaser and the public that the liniment sold by the defendant contains the same ingredients as the 'Chinese Liniment,' and is, in effect, the same medicine."

(N. K. Fairbank Co. v. R. W. Bell Mfg. Co., 77 Fed. Rep. 869.)

Defendant enjoined from putting up and selling or offering for sale "The particular form of packages which has been referred to in the bill and put in evidence as 'defendant's second package,' or any other form of package which shall, by reason of the collocation of size, shape, colors, lettering, spacing and ornamentation, present a general appearance as closely resembling the 'complainant's package,' referred to in the bill and marked in evidence, as does the said 'defendant's second package.' This injunction shall not be construed as restraining defendant from selling packages of the size, weight, and shape of complainant's package, nor from using the designation 'Buffalo soap powder' nor from making a powder having the appearance of complainant's 'Gold Dust,' nor from using paper of a yellow color as wrappers for its packages, provided such packages are so differentiated in general appearance from said 'complainant's package' that they are not calculated to deceive the ordinary purchaser."

MANDATE OF CIRCUIT COURT OF APPEALS, AFFIRMING DECREE OF INJUNCTION.

(Feder v. Benkert, 76 Fed. Rep. 613.)

UNITED STATES OF AMERICA—ss.

The President of the United States of America, To the Honorable the Judges of the Circuit Court of the United States for the Northern District of California, Greeting:

WHEREAS, lately in the Circuit Court of the United States for the northern district of California, before you, or some of you, in a cause between William J. Benkert, complainant, and Samuel Feder, and Aurelia Rosenthal, executrix of the last will and testament of Morris Rosenthal, deceased, respondents, a decree was duly entered in favor of the said complainant, which said decree is of record in the office of the clerk of the said circuit court, to which record reference is hereby made and the same is hereby expressly made a part hereof, and as by the inspection of the transcript of the record of the said circuit court, which was brought into the United States Circuit Court of Appeals for the ninth circuit, by virtue of an appeal agreeably to the Act of Congress, in such cases made and provided, fully and at large appears.

AND WHEREAS, in the year of our Lord one thousand eight hundred and ninety-five, the said cause came to be heard before the said circuit court of appeals, on the said transcript of record, and was argued by counsel:

On consideration whereof, it is now here ordered, adjudged and decreed, that the decree of the said circuit court in this cause be, and the same is hereby, affirmed, with costs.

You, therefore, are hereby commanded that such further proceedings be had in said cause as according to right and justice, and the laws of the United States, ought to be had, the said appeal notwithstanding.

Witness, the Honorable Melville W. Fuller, Chief Justice of the United States, the 16th day of November, in the year of our Lord one thousand eight hundred and ninety-five.

F. D. MONCKTON,
Clerk of the United States Circuit Court of Appeals for the Ninth Circuit.

APPENDIX J

CLASSIFICATION OF TRADEMARKS.

The following classification of registered trademarks has been published in connection with the rules of the Patent Office. It is understood to be a classification of pre-existing registrations rather than as a guide to the classification to be observed in filing application:

CLASSIFICATION OF MERCHANDISE UNDER THE ACT OF MAY 4, 1906.

1. Raw or partly prepared materials.
2. Receptacles.
3. Baggage, horse equipments, portfolios, and pocketbooks.
4. Abrasive, detergent, and polishing materials.
5. Adhesives.
6. Chemicals, medicines, and pharmaceutical preparations.
7. Cordage.
8. Smokers' articles, not including tobacco products.
9. Explosives, firearms, equipments, and projectiles.
10. Fertilizers.
11. Inks and inking materials.
12. Construction materials.
13. Hardware and plumbing and steam-fitting supplies.
14. Metals and metal castings and forgings.
15. Oils and greases.
16. Paints and painters' materials.
17. Tobacco products.
19. Vehicles, not including engines.
20. Linoleum and oiled cloth.
21. Electrical apparatus, machines, and supplies.
22. Games, toys, and sporting goods.
23. Cutlery, machinery, and tools, and parts thereof.
24. Laundry appliances and machines.
25. Locks and safes.
26. Measuring and scientific appliances.
27. Horological instruments.
28. Jewelry and precious-metal ware.
29. Brooms, brushes, and dusters.
30. Crockery, earthenware, and porcelain.
31. Filters and refrigerators.
32. Furniture and upholstery.
33. Glassware.

34. Heating, lighting, and ventilating apparatus, not including electrical apparatus.
35. Belting, hose, machinery packing, and non-metallic tires.
36. Musical instruments and supplies.
37. Paper and stationery.
38. Prints and publications.
39. Clothing.
40. Fancy goods, furnishings, and notions.
41. Canes, parasols, and umbrellas.
42. Knitted, netted, and textile fabrics.
43. Thread and yarn.
44. Dental, medical, and surgical appliances.
45. Beverages, non-alcoholic.
46. Foods and ingredients of foods.
47. Wines.
48. Malt extracts and liquors.
49. Distilled alcoholic liquors.
50. Merchandise not otherwise classified.

NOTE.—Class 18 was abolished February 24, 1909.

APPENDIX K

INTERNATIONAL ARRANGEMENTS.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

(Signed at Paris, March 20, 1883. Ratifications exchanged at Paris, June 6, 1884.)

(Official Translation.)

His Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure by mutual agreement complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a convention to that effect, and have named as their plenipotentiaries, that is to say: [Here follow the appointments of the plenipotentiaries.]

Who having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles:

Article I.

The governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia and Switzerland constitute themselves into a union for the protection of industrial property.

Article II.

The subjects or citizens of each of the contracting states shall, in all the other states of the union, as regards patents, industrial designs or models, trademarks and tradenames, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each state.

ARTICLE III.

Subjects or citizens of states not forming part of the union, who are domiciled or have industrial or commercial establishments in the territory of any of the states of the union, shall be assimilated to the subjects or citizens of the contracting states.

ARTICLE IV.

Any person who has duly applied for a patent, industrial design or model, or trademark in one of the contracting states, shall enjoy, as regards registration in the other states, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other states of the union before expiry of these periods shall not be invalidated through any acts accomplished in the interval; either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trademark.

The above mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trademarks. A month longer is allowed for countries beyond sea.

ARTICLE V.

(Relates only to patents.)

ARTICLE VI.

Every trademark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the union. (No effect can be given to this or any other article of the convention by the Courts of Great Britain, except so far as it is embodied in section 103 of the Patents Act, 1883. Re California Fig Syrup Co., 40 Ch. D. 620. And to be registered in Great Britain, a foreign mark must contain one of the essential particulars defined in section 64 of said act. Re Carter Medicine Co., L. R. (1892), 3 Ch. D. 472.)

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

ARTICLE VII.

The nature of the goods on which the trademark is to be used can, in no case, be an obstacle to the registration of the trademark.

ARTICLE VIII.

A tradename shall be protected in all the countries of the union, without necessity of registration, whether it form part or not of a trademark.

ARTICLE IX.

All goods illegally bearing a trademark or tradename may be seized on importation into those states of the union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper public department or of the interested party, pursuant to the internal legislation of each country.

ARTICLE X.

The provisions of the preceding article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a tradename of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

ARTICLE XI.

The high contracting parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trademarks, for articles exhibited at official or officially recognized international exhibitions.

ARTICLE XII.

Each of the high contracting parties agrees to establish a special government department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trademarks.

ARTICLE XIII.

An international office shall be organized under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the governments of all the contracting states, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the states of the union.

ARTICLE XIV.

The present convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the union.

To this end conferences shall be successively held in one of the contracting states by delegates of the said states. The next meeting shall take place in 1885 at Rome.

ARTICLE XV.

It is agreed that the high contracting parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present convention.

ARTICLE XVI.

States which have not taken part in the present convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the classes and admission to all the advantages stipulated by the present convention.

ARTICLE XVII.

The execution of the reciprocal engagements contained in the present convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ARTICLE XVIII.

The present convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the government commissioned to receive adhesions. It shall only affect the denouncing state, the convention remaining in operation as regards the other contracting parties.

ARTICLE XIX.

The present convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective plenipotentiaries have signed the same, and have affixed thereto their seals.

Dated at Paris the 20th March, 1883.

(Signed by the Plenipotentiaries.)

FINAL PROTOCOL.

(Official Translation.)

On proceeding to the signature of the convention concluded this day between the governments of Belgium, Brazil, Spain, France, Guatemala,

Italy, the Netherlands, Portugal, Salvador, Servia and Switzerland, for the protection of industrial property, the undersigned plenipotentiaries have agreed as follows:

1. The words "industrial property" are to be understood in their broadest sense; they are not to apply simply to industrial products proper so called, but also to agricultural products (wines, corn, fruits, cattle, etc.), and to mineral products employed in commerce (mineral waters, etc.).

2. (Relates only to patents.)

3. The last paragraph of article 11 does not affect the legislation of each of the contracting states, as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

4. Paragraph 1 of article VI is to be understood as meaning that no trademark shall be excluded from protection in any state of the union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that state; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other articles of the convention, the internal legislation of each state remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of article VI.

5. The organization of the special department for industrial property mentioned in article XII shall comprise, so far as possible, the publication in each state of a periodical official paper.

6. [After providing for the common expenses of the international office, continues:]

The Swiss Government will superintend the expenses of the international office, advance the necessary funds, and render an annual account, which will be communicated to all the other administrations.

The international office will centralize information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement, which will be distributed to all the administrations. It will interest itself in all matters of common utility to the union, and will edit, with the help of the documents supplied to it by the various administrations, a periodical paper in the French language dealing with questions regarding the object of the union.

The numbers of this paper, as well as all the documents published by the international office, will be circulated among the administrations of the states of the union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said administrations, or by societies or private persons, will be paid for separately.

The international office shall at all times hold itself at the service of members of the union, in order to supply them with any special infor-

mation they may need on questions relating to the internal system of industrial property.

The administration of the country in which the next conference is to be held will make preparation for the transactions of the conference, with the assistance of the international office.

The director of the international office will be present at the meetings of the conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the union.

The official language of the international office will be French.

7. The present final protocol, which shall be ratified together with the convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as, the said convention.

In witness whereof the undersigned plenipotentiaries have drawn up the present protocol.

(Signed by the Plenipotentiaries.)

ACCESSION OF GREAT BRITAIN AND IRELAND TO THE CONVENTION.

The undersigned, ambassador extraordinary and plenipotentiary of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that Her Britannic Majesty, having had the International Convention for the Protection of Industrial Property, concluded at Paris on the 20th March, 1883, and the protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by article XVI of that convention to states not parties to the original convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said international convention for the protection of industrial property, and to the said protocol, which are to be considered as inserted word for word in the present declaration, and formally engages, as far as regards the President of the French Republic and the other high contracting parties, to cooperate on her part in the execution of the stipulations contained in the convention and protocol aforesaid.

The undersigned makes this declaration on the part of Her Britannic Majesty, with the express understanding that power is reserved to Her Britannic Majesty to accede to the convention on behalf of the Isle of Man and the Channel Islands, and any of Her Majesty's possessions, on due notice to that effect being given through Her Majesty's government.

In witness whereof the undersigned, duly authorized, has signed the present declaration of accession, and has affixed thereto the seal of his arms.

Done at Paris, on the 17th day of March, 1884.

(Signed) LYONS.

[L. S.]

DECLARATION OF ACCEPTANCE OF ACCESSION OF GREAT BRITAIN.

(Official Translation.)

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the protection of industrial property, concluded at Paris, March 20th, 1883, together with a protocol dated the same day, by the declaration of accession delivered by her ambassador extraordinary and plenipotentiary to the Government of the French Republic; the text of which declaration is word for word as follows:

[Here is inserted the text of the declaration of accession in English.]

The President of the French Republic has authorized the undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of Her Britannic Majesty, engaging as well in his own name as in that of the other high contracting parties to assist in the accomplishments of the obligations stipulated in the convention and the protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the undersigned, duly authorized, has drawn up the present declaration of acceptance and has affixed thereto his seal.

Done at Paris, the 2d April, 1884.

(Signed) JULES FERRY.

[L. S.]

This convention is not self-executing, but requires legislation to make it effective in the United States. Opinion of Miller, Attorney-General, 47 Off. Gaz. 397; Ex parte Zwack & Co., 73 Off. Gaz. 1855.

ORDER IN COUNCIL.

(The Patents Act, 1883.)

At the Court at Windsor, the 26th of June, 1884. Present, the Queen's Most Excellent Majesty in Council.

WHEREAS, by the provisions of the Patents, Designs, and Trademarks Act, 1883, it is, amongst other things, provided:

That if Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs and trademarks, or any of them, then any person who has applied for protection for any invention, design or trademark in any such state shall, subject to the conditions further provided and set forth in the said act, be entitled to a patent for his invention, or to registration of his design or trademark (as the case may be) under the said act in priority to other applicants, and such patent

or registration shall have the same date as the date of the protection obtained in such foreign state:

And Whereas it has pleased Her Majesty to make an arrangement of the nature contemplated by the said act by and in virtue of a declaration signed and sealed by Her Majesty's ambassador at Paris on the 17th of March, 1884, duly conveying the accession of Great Britain to the International Convention and Protocol for the Protection of Industrial Property, signed by representatives of certain powers on the 20th of March, 1883, and duly ratified on the 6th of June, 1884, power being reserved to Her Majesty to hereafter accede to the provisions of said convention and protocol on behalf of the Isle of Man, the Channel Islands, and any of Her Majesty's possessions, which declaration of accession was duly accepted by the French government on behalf of the signatory powers by and in virtue of a declaration dated the 2nd of April, 1884:

Now, therefore, Her Majesty, by and with the advice and consent of her Privy Council, and by virtue of the authority committed to her by the said act, doth declare, and it is hereby declared, that the provisions of the said act hereinbefore specified shall apply to the following countries, viz: Belgium, Brazil, France, Guatemala, Italy, Netherlands, Portugal, Salvador, Servia, Spain, Switzerland, Ecuador, and Tunis.

And it is hereby further ordered and declared that this order shall take effect from the 7th of July, 1884.

C. L. Peel.

SUBSEQUENT ORDERS IN COUNCIL (a)

ORDERS IN COUNCIL ADMITTING FOREIGN COUNTRIES.

Santo Domingo.—Date of order, January 27, 1885. To take effect from January 27, 1885. *London Gazette*, 1885, p. 418.

Sweden and Norway.—Date of order, July 9, 1885. To take effect from July 1, 1885. *London Gazette*, 1885, p. 3173.

Paraguay and Urugnay.*—Date of order, September 24, 1886. To take effect from September 24, 1886. *London Gazette*, 1886, p. 4725.

United States of America.—Date of order, July 12, 1887. To take effect from July 12, 1887. *London Gazette*, 1887, p. 3827.

Netherlands East Indies.—Date of order, November 17, 1888. To take effect from March 17, 1889. *London Gazette*, 1888, p. 6412.

Mexico.—Date of order, May 28, 1889. To take effect from September 28, 1889. *London Gazette*, 1889, p. 2954.

Curaçao and Surinam.—Date of order, May 17, 1890. To take effect from September 17, 1890. *London Gazette*, 1890, p. 2891.

Santo Domingo.—Date of order, October 21, 1890. To take effect from February 21, 1891. *London Gazette*, 1890, p. 5661.

Roumania.*—Date of order, August 5, 1892. To take effect from December 5, 1892. *London Gazette*, 1892, p. 4554.

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* These countries without acceding to the Convention, entered into corresponding arrangement with this country.

Ecuador.*—Date of order, May 16, 1893. To take effect from September 16, 1893. *London Gazette*, 1893, p. 2899.

Greece.*—Date of order, October 15, 1894. To take effect from February 15, 1895. *London Gazette*, 1894, p. 5918.

Denmark.—Date of order, November 20, 1894. To take effect from March 20, 1895. *London Gazette*, 1894, p. 6879.

Japan.—Date of order, October 7, 1899. To take effect from October 7, 1899. *London Gazette*, 1899, p. 6241.

Honduras.*—Date of order, September 26, 1901. To take effect from September 25, 1901. *London Gazette*, 1901, p. 6383.

Germany.—Date of order, October 9, 1903. To take effect from May 1, 1903. *London Gazette*, 1903, p. 6220.

Cuba.—Date of order, January 12, 1905. To take effect from November 17, 1904. *London Gazette*, 1905, p. 321.

Austria and Hungary.—Date of order, May 17, 1909. To take effect from January 1, 1909. *London Gazette*, 1909, p. 3863.

ORDERS IN COUNCIL ADMITTING BRITISH POSSESSIONS.

Queensland.—Date of order, September 17, 1885. To take effect from September 17, 1885. *London Gazette*, 1885, p. 4429.

New Zealand.—Date of order, February 8, 1890. To take effect from June 8, 1890. *London Gazette*, 1890, p. 727.

Tasmania.—Date of order, April 30, 1894. To take effect from August 30, 1894. *London Gazette*, 1894, p. 2578.

Western Australia.—Date of order, May 11, 1895. To take effect from September 11, 1895. *London Gazette*, 1895, p. 2848.

Ceylon.—Date of order, August 7, 1905. To take effect from June 10, 1905. *London Gazette*, 1905, p. 5459.

Australia, Commonwealth of.—Date of order, March 26, 1907. To take effect from February 1, 1907. *London Gazette*, 1907, p. 2178.

Trinidad and Tobago.—Date of order, August 12, 1907. To take effect from August 12, 1907. *London Gazette*, 1907, p. 5603.

ORDERS IN COUNCIL REVOKING ORDERS OF ADMISSION.

Ecuador.—Date of order, April 16, 1886. To take effect from December 26, 1886. *London Gazette*, 1886, p. 1894.

Salvador.—Date of order, September 24, 1886. To take effect from August 17, 1887. *London Gazette*, 1886, p. 4726.

Santo Domingo.—Date of order, May 28, 1889. To take effect from May 28, 1889. *London Gazette*, 1889, p. 3035.

Guatemala.—Date of order, February 2, 1895. To take effect from November 8, 1895. *London Gazette*, 1895, p. 754.

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* These countries, without acceding to the Convention, entered into corresponding arrangement with this country.

Queensland.—Date of order, March 26, 1907. To take effect from February 1, 1907. *London Gazette*, 1907, p. 2178.

Western Australia.—Date of order, March 26, 1907. To take effect from February 1, 1907. *London Gazette*, 1907, p. 2178.

Tasmania.—Date of order, August 12, 1907. To take effect from August 12, 1907. *London Gazette*, 1907, p. 5603.

ADDITIONAL ACT MODIFYING THE INDUSTRIAL PROPERTY CONVENTION OF MARCH 20, 1883.

SIGNED AT BRUSSELS, DECEMBER 14, 1900.

(Official Translation.)

Her Majesty, the Queen of the United Kingdom of Great Britain and Ireland, Empress of India; His Majesty, the King of the Belgians; the President of the United States of Brazil; His Majesty, the King of Denmark; the President of the Dominician Republic; Her Majesty, the Queen-Regent of Spain, in the name of His Majesty, the King of Spain; the President of the United States of America; the President of the French Republic; His Majesty, the King of Italy; His Majesty, the Emperor of Japan; Her Majesty, the Queen of the Netherlands; His Majesty, the King of Portugal and the Algarves; His Majesty, the King of Servia; His Majesty, the King of Sweden and Norway; the Federal Council of the Swiss Confederation; and the Tunisian Government, having deemed it expedient to make certain modifications in, and additions to, the International Convention of the 20th of March, 1883, and also as regards the Final Protocol annexed to the said convention, have named as their plenipotentiaries, that is to say: [*Here follow the appointments of the plenipotentiaries*] Who, after having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles:

ARTICLE I.

The International Convention of the 20th March, 1883, shall be modified as follows:

1. Article III of the convention shall run as follows:

"Art. III. The subjects or citizens of states which are not parties to the union shall be assimilated to the subjects or citizens of the contracting states, provided that they are domiciled in, or have industrial or commercial establishments, real and effective, in the territory of one of the states of the union."

2. Article IV shall run as follows:

"Art. IV. Any person who shall have duly applied for a patent, industrial design, or model or trademark in one of the contracting states, shall enjoy, in order to admit of such request being lodged in the other states,

during the periods of time mentioned below, a right of priority, the rights of third parties being reserved.

"Consequently, subsequent registration in one of the other states of the union, before the expiration of such periods of time, shall not be invalidated by any acts accomplished in the interval—either, for instance, by another registration, by the publication of the invention, or by the working of it, by the sale of patterns of the design or model, or by the use of the trademark.

"The above-mentioned periods of time during which priority is guaranteed shall be twelve months for patents with respect to inventions, and four months for patents for industrial designs or models, as well as for trade or merchandise marks."

3. There shall be inserted in the convention an Article IV *bis* in the following terms:

"Art. IV *bis*." (Relates only to patents.)

4. The two following paragraphs shall be added to Article IX:

"In states the laws of which do not admit of seizure upon importation, prohibition of importation may take the place of such seizure.

"The authorities shall not be compelled to effect the seizure in the case of goods in transit."

5. Article X shall run as follows:

"Art. X. The stipulations of the preceding article shall be applicable to every production which may falsely bear as indication of origin the name of a specified locality, when such indication shall be joined to a tradename of a fictitious character or used with intent to defraud.

"Any producer, manufacturer, or trader engaged in the production, manufacture, or trade of such goods, and established either in the locality falsely designated as the place of origin, or in the district where the locality is situated, is to be deemed a party concerned."

6. There shall be inserted in the convention an Article X *bis* in the terms following:

"Art. X *bis*. Persons resorting to the countries referred to in the convention (Articles II and III) shall enjoy in all the states of the union the protection accorded to nationals against dishonest competition."

7. Article XI shall run as follows:

"Art. XI. The high contracting parties shall, in conformity with the legislation of each county, accord temporary protection to inventions susceptible of being patented, and to industrial designs or models, as well as to trademarks or merchandise marks, in respect of products which shall be exhibited at official or officially recognized international exhibitions held in the territory of one of them."

8. Article XIV shall run as follows:

"Art. XIV. The present convention shall be submitted to periodical revisions with a view to the introduction of amendments calculated to improve the system of the union.

"For this purpose, conferences shall be held successively, in one of the contracting states, between the delegates of the said states."

9. Article XVI shall run as follows:

"Art. XVI. States which are not parties to the present convention shall be allowed to accede to it upon their request.

"The accession shall be modified through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the other states.

"It shall entail, as a matter of right, accession to all the clauses, as well as admission to all the advantages stipulated in the present convention, and shall take effect one month after the dispatch of the notification by the Swiss Government to the other states of the union, unless a subsequent date have been indicated by the acceding state."

ARTICLE II.

The final protocol annexed to the International Convention of the 20th March, 1883, shall be completed by the addition of No. 3 *bis* in the following terms:

"3 *bis*." (Relates only to patents.)

ARTICLE III.

The present additional act shall have the same value and duration as the convention of the 20th of March, 1883.

It shall be ratifed, and the ratification shall be deposited at the Ministry for Foreign Affairs, Brussels, as soon as possible, and at the latest within a period of eighteen months from the date of signature.

It shall come into force three months after the protocol of deposit shall have been closed.

In witness whereof the respective plenipotentiaries have signed the present additional act.

Done at Brussels, in single copy, the 14th December, 1900.

[*Signed by the Plenipotentiaries.*]

PROCESS—VERBAL.

The contracting parties having unanimously agreed that the exchange of the ratifications of the additional act to the Convention of the 20th March, 1883, signed at Brussels on the 14th December, 1900, shall be effected by means of the deposit of the respective instruments in the archives of the Belgian Ministry for Foreign Affairs, the present protocol recording the deposit has been, for this purpose, drawn up at the Ministry for Foreign Affairs this 3rd day of May, 1901.

(Ratified under dates as follows):

United States of America, May 3, 1901.
Switzerland, August 5, 1901.
Denmark, October 10, 1901.
Portugal, November 5, 1901.

United Kingdom, December 6, 1901.
Belgium, December 10, 1901.
Italy, December 12, 1901.
Japan, April 21, 1902.
France, May 23, 1902.
Tunis, May 23, 1902.
Sweden, June 5, 1902.
Norway, June 5, 1902.
Netherlands, June 10, 1902.

In conformity with Article III of the additional act of the 14th December, 1900, the present protocol has been closed on this date.

The Belgian Minister for Foreign Affairs,
(Signed) P. DE FAVEREAU.

Brussels, June 14, 1902.

APPENDIX L

Section 4 of the Act of January 5, 1906 (33 Stat. L. 600), incorporating the American National Red Cross, is as follows:

* * * * * * * *

SECTION 4. That from and after the passage of this act it shall be unlawful for any person within the jurisdiction of the United States to falsely and fraudulently hold himself out as, or represent or pretend himself to be, a member of, or an agent for, the American National Red Cross, for the purpose of soliciting, collecting, or receiving money or material; or for any person to wear or display the sign of the Red Cross, or any insignia colored in imitation thereof for the fraudulent purpose of inducing the belief that he is a member of, or an agent for, the American National Red Cross. Nor shall it be lawful for any person or corporation, other than the Red Cross of America, not now lawfully entitled to use the sign of the Red Cross, hereafter to use such sign or any insignia colored in imitation thereof for the purposes of trade or as an advertisement to induce the sale of any article whatsoever. If any person violates the provisions of this section, he shall be guilty of a misdemeanor and shall be liable to a fine of not less than one nor more than five hundred dollars, or imprisonment for a term not exceeding one year, or both, for each and every offense. The fine so collected shall be paid to the American National Red Cross.

* * * * * * *

Approved, January 5, 1906.

Under this section registration has been refused to "the representation of a cross inclosed in a circle which cuts the arms of the cross," printed in red. *Ex parte Streator Metal Co.*, 130 Off. Gaz. 1483; similarly a mark including the words "Red Cross" was refused registration in *Ex parte Strauss*, C. D. 1907, 133, 128 Off. Gaz. 885.

APPENDIX M

THE FEDERAL TRADE COMMISSION ACT.

(Act September 26, 1914, 38 Stat. L. 717.)

AN ACT to create a Federal Trade Commission, to define its powers and duties, and for other purposes.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*: That a Commission is hereby created and established to be known as the Federal Trade Commission (hereinafter referred to as the Commission), which shall be composed of five commissioners, who shall be appointed by the President, by and with the advice and consent of the Senate. Not more than three of the commissioners shall be members of the same political party. The first commissioners appointed shall continue in office for terms of three, four, five, six, and seven years, respectively, from the date of the taking effect of this act, the term of each to be designated by the President, but their successors shall be appointed for terms of seven years, except that any person chosen to fill a vacancy shall be appointed only for the unexpired term of the commissioner whom he shall succeed. The Commission shall choose a chairman from its own membership. No commissioner shall engage in any other business, vocation, or employment. Any commissioner may be removed by the President for inefficiency, neglect of duty, or malfeasance in office. A vacancy in the Commission shall not impair the right of the remaining commissioners to exercise all the powers of the Commission.

The Commission shall have an official seal, which shall be judicially noticed.

SECTION 2. [*Salaries—employees—classified civil service—expenditures—rent of offices.*] That each commissioner shall receive a salary of $10,000 a year, payable in the same manner as the salaries of the judges of the courts of the United States. The commission shall appoint a secretary, who shall re-

ceive a salary of $5,000 a year, payable in like manner, and it shall have authority to employ and fix the compensation of such attorneys, special experts, examiners, clerks, and other employees as it may from time to time find necessary for the proper performance of its duties and as may be from time to time appropriated for by Congress.

With the exception of the secretary, a clerk to each commissioner, the attorneys, and such special experts and examiners as the commission may from time to time find necessary for the conduct of its work, all employees of the commission shall be a part of the classified civil service, and shall enter the service under such rules and regulations as may be prescribed by the commission and by the Civil Service Commission.

All of the expenses of the commission, including all necessary expenses for transportation incurred by the commissioners or by their employees under their orders, in making any investigation, or upon official business in any other places than in the city of Washington, shall be allowed and paid on the presentation of itemized vouchers therefor approved by the commission.

Until otherwise provided by law, the commission may rent suitable offices for its use.

The Auditor for the State and Other Departments shall receive and examine all accounts of expenditures of the commission.

SECTION 3. [*Bureau of corporations abolished—transfer of employees, etc.—principal office—inquiries elsewhere.*] That upon the organization of the commission and election of its chairman, the Bureau of Corporations and the offices of Commissioner and Deputy Commissioner of Corporations shall cease to exist; and all pending investigations and proceedings of the Bureau of Corporations shall be continued by the commission.

All clerks and employees of the said bureau shall be transferred to and become clerks and employees of the commission at their present grades and salaries. All records, papers, and property of the said bureau shall become records, papers, and property of the commission, and all unexpended funds and appropriations for the use and maintenance of the said bureau, including any allotment already made to it by the Secretary of Commerce from the contingent appropriation for the Department of Commerce for the fiscal year nineteen hundred and fif-

teen, or from the departmental printing fund for the fiscal year nineteen hundred and fifteen, shall become funds and appropriations available to be expended by the commission in the exercise of the powers, authority, and duties conferred on it by this Act.

The principal office of the commission shall be in the city of Washington, but it may meet and exercise all its powers at any other place. The commission may, by one or more of its members, or by such examiners as it may designate, prosecute any inquiry necessary to its duties in any part of the United States.

SECTION 4. [*Definitions.*] That the words defined in this section shall have the following meaning when found in this Act, to wit:

"Commerce" means commerce among the several States or with foreign nations, or in any territory of the United States or in the District of Columbia, or between any such Territory and another, or between any such Territory and any State or foreign nation, or between the District of Columbia and any State or Territory or foreign nation.

"Corporation" means any company or association incorporated or unincorporated, which is organized to carry on business for profit and has shares of capital or capital stock, and any company or association, incorporated or unincorporated, without shares of capital or capital stock, except partnerships, which is organized to carry on business for its own profit or that of its members.

"Documentary evidence" means all documents, papers, and correspondence in existence at and after the passage of this Act.

"Acts to regulate commerce" means the Act entitled "An Act to regulate commerce," approved February fourteenth, eighteen hundred and eighty-seven, and all Acts amendatory thereof and supplementary thereto.

"Antitrust acts" means the Act entitled "An Act to protect trade and commerce against unlawful restraints and monopolies," approved July second, eighteen hundred and ninety; also the sections seventy-three to seventy-seven, inclusive, of an Act entitled "An Act to reduce taxation, to provide revenue for the Government, and for other purposes," approved August twenty-seventh, eighteen hundred and ninety-four; and also the Act entitled "An Act to amend sections seventy-three and seventy-

six of the Act of August twenty-seventh, eighteen hundred and ninety-four, entitled 'An Act to reduce taxation, to provide revenue for the Government, and for other purposes,' " approved February twelfth, nineteen hundred and thirteen.

SECTION 5. That unfair methods of competition in commerce are hereby declared unlawful.

The commission is hereby empowered and directed to prevent persons, partnerships, or corporations, except banks, and common carriers subject to the Acts to regulate commerce, from using unfair methods of competition in commerce.

Whenever the commission shall have reason to believe that any such person, partnership, or corporation has been or is using any unfair method of competition in commerce, and if it shall appear to the commission that a proceeding by it in respect thereof would be to the interest of the public, it shall issue and serve upon such person, partnership, or corporation a complaint stating its charges in that respect, and containing a notice of a hearing upon a day and at a place therein fixed at least thirty days after the service of said complaint. The person, partnership, or corporation so complained of shall have the right to appear at the place and time so fixed and show cause why an order should not be entered by the commission requiring such person, partnership, or corporation to cease and desist from the violation of the law so charged in said complaint. Any person, partnership, or corporation may make application, and upon good cause shown may be allowed by the commission, to intervene and appear in said proceeding by counsel or in person. The testimony in any such proceeding shall be reduced to writing and filed in the office of the commission. If upon such hearing the commission shall be of the opinion that the method of competition in question is prohibited by this Act, it shall make a report in writing in which it shall state its findings as to the facts, and shall issue and cause to be served on such person, partnership, or corporation an order requiring such person, partnership, or corporation to cease and desist from using such method of competition. Until a transcript of the record in such hearing shall have been filed in a circuit court of appeals of the United States, as hereinafter provided, the commission may at any time, upon such notice and in such manner as it shall deem proper, modify

or set aside, in whole or in part, any report or any order made or issued by it under this section.

If such person, partnership, or corporation fails or neglects to obey such order of the commission while the same is in effect, the commission may apply to the circuit court of appeals of the United States, within any circuit where the method of competition in question was used or where such person, partnership, or corporation resides or carries on business, for the enforcement of its order, and shall certify and file with its application a transcript of the entire record in the proceeding, including all the testimony taken and the report and order of the commission. Upon such filing of the application and transcript the court shall cause notice thereof to be served upon such person, partnership, or corporation and thereupon shall have jurisdiction of the proceeding and of the question determined therein, and shall have power to make and enter upon the pleadings, testimony, and proceedings set forth in such transcript a decree affirming, modifying, or setting aside the order of the commission. The findings of the commission as to the facts, if supported by testimony, shall be conclusive. If either party shall apply to the court for leave to adduce additional evidence, and shall show to the satisfaction of the court that such additional evidence is material and that there were reasonable grounds for the failure to adduce such evidence in the proceedings before the commission, the court may order such additional evidence to be taken before the commission and to be adduced upon the hearing in such manner and upon such terms and conditions as to the court may seem proper. The commission may modify its findings as to the facts, or make new findings, by reason of the additional evidence so taken, and it shall file such modified or new findings, which, if supported by testimony, shall be conclusive, and its recommendations, if any, for the modification or setting aside of its original order, with the return of such additional evidence. The judgment and decree of the court shall be final, except that the same shall be subject to review by the Supreme Court upon certiorari as provided in section two hundred and forty of the Judicial Code.

Any party required by such order of the commission to cease and desist from using such method of competition may obtain a

review of such order in said circuit court of appeals by filing in the court a written petition praying that the order of the commission be set aside. A copy of such petition shall be forthwith served upon the commission, and thereupon the commission forthwith shall certify and file in the court a transcript of the record as hereinbefore provided. Upon the filing of the transcript the court shall have the same jurisdiction to affirm, set aside, or modify the order of the commission as in the case of an application by the commission for the enforcement of its order, and the findings of the commission as to the facts, if supported by testimony, shall in like manner be conclusive.

The jurisdiction of the circuit court of appeals of the United States to enforce, set aside, or modify orders of the commission shall be exclusive.

Such proceedings in the circuit court of appeals shall be given precedence over other cases pending therein, and shall be in every way expedited. No order of the commission or judgment of the court to enforce the same shall in any wise relieve or absolve any person, partnership, or corporation from any liability under the antitrust Acts.

Complaints, orders, and other processes of the commission under this section may be served by anyone duly authorized by the commission, either (a) by delivering a copy thereof to the person to be served, or to a member of the partnership to be served, or to the president, secretary, or other executive officer or a director of the corporation to be served; or (b) by leaving a copy thereof at the principal office or place of business of such person, partnership, or corporation; or (c) by registering and mailing a copy thereof addressed to such person, partnership, or corporation at his or its principal office or place of business. The verified return by the person so serving said complaint, order, or other process setting forth the manner of said service shall be proof of the same, and the return post office receipt for said complaint, order, or other process registered and mailed as aforesaid shall be proof of the service of the same.

SECTION 6. [*Additional powers.*] That the commission shall also have power—

(a) To gather and compile information concerning, and to investigate from time to time the organization, business, conduct,

practices, and management of any corporation engaged in commerce, excepting banks and common carriers subject to the Act to regulate commerce, and its relation to other corporations and to individuals, associations, and partnerships.

(b) To require, by general or special orders, corporations engaged in commerce, excepting banks, and common carriers subject to the Act to regulate commerce, or any class of them, or any of them, respectively, to file with the commission in such form as the commission may prescribe annual or special, or both annual and special, reports or answers in writing to specific questions, furnishing to the commission such information as it may require as to the organization, business, conduct, practices, management, and relation to other corporations, partnerships, and individuals of the respective corporations filing such reports or answers in writing. Such reports and answers shall be made under oath, or otherwise, as the commission may prescribe, and shall be filed with the commission within such reasonable period as the commission may prescribe, unless additional time be granted in any case by the commission.

(c) Whenever a final decree has been entered against any defendant corporation in any suit brought by the United States to prevent and restrain any violation of the antitrust Acts, to make investigation, upon its own initiative, of the manner in which the decree has been or is being carried out, and upon the application of the Attorney General it shall be its duty to make such investigation. It shall transmit to the Attorney General a report embodying its findings and recommendations as a result of any such investigation, and the report shall be made public in the discretion of the commission.

(d) Upon the direction of the President or either House of Congress to investigate and report the facts relating to any alleged violations of the antitrust Acts by any corporation.

(e) Upon the application of the Attorney General to investigate and make recommendations for the readjustment of the business of any corporation alleged to be violating the antitrust Acts in order that the corporation may thereafter maintain its organization, management, and conduct of business in accordance with law.

(f) To make public from time to time such portions of the information obtained by it hereunder, except trade secrets and names of customers, as it shall deem expedient in the public interest; and to make annual and special reports to the Congress and to submit therewith recommendations for additional legislation; and to provide for the publication of its reports and decisions in such form and manner as may be best adapted for public information and use.

(g) From time to time to classify corporations and to make rules and regulations for the purpose of carrying out the provisions of this Act.

(h) To investigate, from time to time, trade conditions in and with foreign countries where associations, combinations, or practices of manufacturers, merchants, or traders, or other conditions, may affect the foreign trade of the United States, and to report to Congress thereon, with such recommendations as it deems advisable.

SECTION 7. [*May act as master in chancery when.*] That in any suit in equity brought by or under the direction of the Attorney General as provided in the antitrust Acts, the court may, upon the conclusion of the testimony therein, if it shall be then of opinion that the complainant is entitled to relief, refer said suit to the commission, as a master in chancery, to ascertain and report an appropriate form of decree therein. The commission shall proceed upon such notice to the parties and under such rules of procedure as the court may prescribe, and upon the coming in of such report such exceptions may be filed and such proceedings had in relation thereto as upon the report of a master in other equity causes, but the court may adopt or reject such report, in whole or in part, and enter such decree as the nature of the case may in its judgment require.

SECTION 8. [*Records, etc., of governmental departments furnished commission.*] That the several departments and bureaus of the Government when directed by the President shall furnish the commission, upon its request, all records, papers, and information in their possession relating to any corporation subject to any of the provisions of this Act, and shall detail from

time to time such officials and employees to the commission as he may direct.

SECTION 9. [*Documentary evidence—attendance of witnesses—depositions—incriminating evidence.*] That for the purposes of this Act the commission, or its duly authorized agent or agents, shall at all reasonable times have access to, for the purpose of examination, and the right to copy any documentary evidence of any corporation being investigated or proceeded against; and the commission shall have power to require by subpœna the attendance and testimony of witnesses and the production of all such documentary evidence relating to any matter under investigation. Any member of the commission may sign subpœnas, and members and examiners of the commission may administer oaths and affirmations, examine witnesses, and receive evidence.

Such attendance of witnesses, and the production of such documentary evidence, may be required from any place in the United States, at any designated place of hearing. And in case of disobedience to a subpœna the commission may invoke the aid of any court of the United States in requiring the attendance and testimony of witnesses and the production of documentary evidence.

Any of the district courts of the United States within the jurisdiction of which such inquiry is carried on may, in case of contumacy or refusal to obey a subpœna issued to any corporation or other person, issue an order requiring such corporation or other person to appear before the commission, or to produce documentary evidence if so ordered, or to give evidence touching the matter in question; and any failure to obey such order of the court may be punished by such court as a contempt thereof.

Upon the application of the Attorney General of the United States, at the request of the commission, the district courts of the United States shall have jurisdiction to issue writs of mandamus commanding any person or corporation to comply with the provisions of this Act or any order of the commission made in pursuance thereof.

The commission may order testimony to be taken by deposition in any proceeding or investigation pending under this

Act at any stage of such proceeding or investigation. Such depositions may be taken before any person designated by the commission and having power to administer oaths. Such testimony shall be reduced to writing by the person taking the deposition, or under his direction, and shall then be subscribed by the deponent. Any person may be compelled to appear and depose and to produce documentary evidence in the same manner as witnesses may be compelled to appear and testify and produce documentary evidence before the commission as hereinbefore provided.

Witnesses summoned before the commission shall be paid the same fees and mileage that are paid witnesses in the courts of the United States, and witnesses whose depositions are taken and the persons taking the same shall severally be entitled to the same fees as are paid for like services in the courts of the United States.

No person shall be excused from attending and testifying or from producing documentary evidence before the commission or in obedience to the subpœna of the commission on the ground or for the reason that the testimony or evidence, documentary or otherwise, required of him may tend to criminate him or subject him to a penalty or forfeiture. But no natural person shall be prosecuted or subjected to any penalty or forfeiture for or on account of any transaction, matter, or thing concerning which he may testify, or produce evidence, documentary or otherwise, before the commission in obedience to a subpœna issued by it: *Provided*, That no natural person so testifying shall be exempt from prosecution and punishment for perjury committed in so testifying.

SECTION 10. [*Penalties.*] That any person who shall neglect or refuse to attend and testify, or to answer any lawful inquiry, or to produce documentary evidence, if in his power to do so, in obedience to the subpœna or lawful requirement of the commission, shall be guilty of an offense and upon conviction thereof by a court of competent jurisdiction shall be punished by a fine of not less than $1,000 or more than $5,000, or by imprisonment for not more than one year, or by both such fine and imprisonment.

Any person who shall willfully make, or cause to be made, any false entry or statement of fact in any report required to be made under this Act, or who shall willfully make, or cause to be made, any false entry in any account, record, or memorandum kept by any corporation subject to this Act, or who shall willfully neglect or fail to make, or cause to be made, full, true, and correct entries in such accounts, records, or memoranda, of all facts and transactions appertaining to the business of such corporation, or who shall willfully remove out of the jurisdiction of the United States, or willfully mutilate, alter, or by any other means falsify any documentary evidence of such corporation, or who shall willfully refuse to submit to the commission or to any of its authorized agents, for the purpose of inspection and taking copies, any documentary evidence of such corporation in his possession or within his control, shall be deemed guilty of an offense against the United States, and shall be subject, upon conviction in any court of the United States of competent jurisdiction, to a fine of not less than $1,000 or more than $5,000, or to imprisonment for a term of not more than three years, or to both such fine and imprisonment.

If any corporation required by this Act to file an annual or special report shall fail so to do within the time fixed by the commission for filing the same, and such failure shall continue for thirty days after notice of such default, the corporation shall forfeit to the United States the sum of $100 for each and every day of the continuance of such failure, which forfeiture shall be payable into the Treasury of the United States, and shall be recoverable in a civil suit in the name of the United States brought in the district where the corporation has its principal office, or in any district in which it shall do business. It shall be the duty of the various district attorneys, under the direction of the Attorney General of the United States, to prosecute for the recovery of forfeitures. The costs and expenses of such prosecution shall be paid out of the appropriation for the expenses of the courts of the United States.

Any officer or employe of the commission who shall make public any information obtained by the commission without its authority, unless directed by a court, shall be deemed guilty of a misdemeanor, and, upon conviction thereof, shall be punished

by a fine not exceeding $5,000, or by imprisonment not exceeding one year, or by fine and imprisonment, in the discretion of the court.

SECTION 11. [*Antitrust Acts and Acts to regulate commerce not repealed.*] Nothing contained in this Act shall be construed to prevent or interfere with the enforcement of the provisions of the antitrust Acts or the Acts to regulate commerce, nor shall anything contained in the Act be construed to alter, modify, or repeal the said antitrust Acts or the Acts to regulate commerce or any part or parts thereof.

PROVISIONS OF THE CLAYTON ANTITRUST ACT, DEFINING OFFENSES AND CONFERRING JURISDICTION UPON THE FEDERAL TRADE COMMISSION.

(Act October 15, 1914, 38 Stat. L. 730.)

SECTION 2. That it shall be unlawful for any person engaged in commerce, in the course of such commerce, either directly or indirectly to discriminate in price between different purchasers of commodities, which commodities are sold for use, consumption or resale within the United States or any territory thereof or the District of Columbia or any insular possession or other place under the jurisdiction of the United States, where the effect of such discrimination may be to substantially lessen competition or tend to create a monopoly in any line of commerce: *Provided,* That nothing herein contained shall prevent discrimination in price between purchasers of commodities on account of differences in the grade, quality, or quantity of the commodity sold, or that makes only due allowance for difference in the cost of selling or transportation, or discrimination in price in the same or different communities made in good faith to meet competition: *And provided, further,* That nothing herein contained shall prevent persons engaged in selling goods, wares, or merchandise in commerce from selecting their own customers in bona fide transactions and not in restraint of trade.

SECTION 3. That it shall be unlawful for any person engaged in commerce, in the course of such commerce, to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies or other commodities, whether patented or un-

patented, for use, consumption or resale within the United States or any Territory thereof or the District of Columbia or any insular possession or other place under the jurisdiction of the United States, or fix a price charged therefor, or discount from, or rebate upon, such price, on the condition, agreement or understanding that the lessee or purchaser thereof shall not use or deal in the goods, wares, merchandise, machinery, supplies or other commodities of a competitor or competitors of the lessor or seller, where the effect of such lease, sale, or contract for sale or such condition, agreement or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce.

SECTION 11. [*Enforcement of provisions by interstate commerce commission, etc.—procedure.*] That authority to enforce compliance with sections two, three, seven and eight of this Act by the persons respectively subject thereto is hereby vested: in the Interstate Commerce Commission where applicable to common carriers, in the Federal Reserve Board where applicable to banks, banking associations and trust companies, and in the Federal Trade Commission where applicable to all other character of commerce, to be exercised as follows:

Whenever the commission or board vested with jurisdiction thereof shall have reason to believe that any person is violating or has violated any of the provisions of sections two, three, seven and eight of this Act, it shall issue and serve upon such person a complaint stating its charges in that respect, and containing a notice of a hearing upon a day and at a place therein fixed at least thirty days after the service of said complaint. The person so complained of shall have the right to appear at the place and time so fixed and show cause why an order should not be entered by the commission or board requiring such person to cease and desist from the violation of the law so charged in said complaint. Any person may make application, and upon good cause shown may be allowed by the commission or board, to intervene and appear in said proceeding by counsel or in person. The testimony in any such proceeding shall be reduced to writing and filed in the office of the commission or board. If upon such hearing the commission or board, as the case may be, shall be of the opinion that any of the provisions of said

sections have been or are being violated, it shall make a report in writing in which it shall state its findings as to the facts, and shall issue and cause to be served on such person an order requiring such person to cease and desist from such violations, and divest itself of the stock held or rid itself of the directors chosen contrary to the provisions of sections seven and eight of this Act, if any there be, in the manner and within the time fixed by said order. Until a transcript of the record in such hearing shall have been filed in a circuit court of appeals of the United States, as hereinafter provided, the commission or board may at any time, upon such notice and in such manner as it shall deem proper, modify or set aside, in whole or in part, any report or any order made or issued by it under this section.

If such person fails or neglects to obey such order of the commission or board while the same is in effect, the commission or board may apply to the circuit court of appeals of the United States, within any circuit where the violation complained of was or is being committed or where such person resides or carries on business, for the enforcement of its order, and shall certify and file with its application a transcript of the entire record in the proceeding, including all the testimony taken and the report and order of the commission or board. Upon such filing of the application and transcript the court shall cause notice thereof to be served upon such person and thereupon shall have jurisdiction of the proceeding and of the question determined therein, and shall have power to make and enter upon the pleadings, testimony, and proceedings set forth in such transcript a decree affirming, modifying, or setting aside the order of the commission or board. The findings of the commission or board as to the facts, if supported by testimony, shall be conclusive. If either party shall apply to the court for leave to adduce additional evidence, and shall show to the satisfaction of the court that such additional evidence is material and that there were reasonable grounds for the failure to adduce such evidence in the proceeding before the commission or board, the court may order such additional evidence to be taken before the commission or board and to be adduced upon the hearing in such manner and upon such terms and con-

ditions as to the court may seem proper. The commission or board may modify its findings as to the facts, or make new findings, by reason of the additional evidence so taken, and it shall file such modified or new findings, which, if supported by testimony, shall be conclusive, and its recommendation, if any, for the modification or setting aside of its original order, with the return of such additional evidence. The judgment and decree of the court shall be final, except that the same shall be subject to review by the Supreme Court upon certiorari as provided in section two hundred and forty of the Judicial Code.

Any party required by such order of the commission or board to cease and desist from a violation charged may obtain a review of such order in said circuit court of appeals by filing in the court a written petition praying that the order of the commission or board be set aside. A copy of such petition shall be forthwith served upon the commission or board, and thereupon the commission or board forthwith shall certify and file in the court a transcript of the record as hereinbefore provided. Upon the filing of the transcript the court shall have the same jurisdiction to affirm, set aside, or modify the order of the commission or board as in the case of an application by the commission or board for the enforcement of its order, and the findings of the commission or board as to the facts, if supported by testimony, shall in like manner be conclusive.

The jurisdiction of the circuit court of appeals of the United States to enforce, set aside, or modify orders of the commission or board shall be exclusive.

Such proceedings in the circuit court of appeals shall be given precedence over other cases pending therein, and shall be in every way expedited. No order of the commission or board or the judgment of the court to enforce the same shall in any wise relieve or absolve any person from any liability under the antitrust Acts.

Complaints, orders, and other processes of the commission or board under this section may be served by anyone duly authorized by the commission or board, either (a) by delivering a copy thereof to the person to be served, or to a member of the partnership to be served, or to the president, secretary, or other executive officer or a director of the corporation to be

served; or (b) by leaving a copy thereof at the principal office or place of business of such person; or (c) by registering and mailing a copy thereof addressed to such person at his principal office or place of business. The verified return by the person so serving said complaint, order, or other process setting forth the manner of said service shall be proof of the same, and the return post-office receipt for said complaint, order, or other process registered and mailed as aforesaid shall be proof of the service of the same.

Interpretations of the Clayton Act. "The statute does not in terms except from its operation any agreements or contracts, past, present or future, and in the absence of such exception, it is to be presumed that Congress intended to prohibit not only the making of future contracts but also the further performance of past contracts of the kind specified. * * * It is now too well settled to admit of controversy that a contract to do a thing, lawful when made, may be avoided by subsequent legislation making it unlawwful and that an Act of Congress may lawfully affect rights which had their inception before its passage." Sessions, J., in *Elliott Machine Co. v. Center*, 227 Fed. Rep. 124. "This statute [Clayton Act, sec. 3] forbids the converse of the acts complained of in the present action, and we have nothing to do with what might happen if the Green trading stamp people were seeking to forbid the use by its subscribers of any other kind of trading stamps. This might or might not be a restriction upon competition or tend to effect a monopoly." Chatfield, J., in *Sperry & Hutchinson Co. v. Fenster*, 219 Fed. Rep. 755.

As to an alleged violation of § 3 of the Clayton Act as a defense to a suit for trademark infringement, see *Coca-Cola Co. v. Butler*, 229 Fed. Rep. 224, 233, and *ante* p. 156.

RULES OF PRACTICE BEFORE THE COMMISSION.

(Adopted June 17, 1915.)

I. SESSIONS. The principal office of the Commission at Washington, D. C., is open each business day from 9 A. M. to 4:30 P. M. The Commission may meet and exercise all its powers at any other place, and may, by one or more of its members, or by

such examiners as it may designate, prosecute any inquiry necessary to its duties in any part of the United States.

Sessions of the Commission for hearing contested proceedings will be held as ordered by the Commission.

Sessions of the Commission for the purpose of making orders and for the transaction of other business, unless otherwise ordered, will be held at the office of the Commission at Washington, D. C., on each business day at 10:30 A. M. Three members of the Commission shall constitute a quorum for the transaction of business.

All orders of the Commission shall be signed by the secretary.

II. Complaints. Any person, partnership, corporation or association may apply to the Commission to institute a proceeding in respect to any violation of law over which the Commission has jurisdiction.

Such application shall be in writing, signed by or in behalf of the applicant, and shall contain a short and simple statement of the facts constituting the alleged violation of law and the name and address of the applicant and of the party complained of.

The Commission shall investigate the matters complained of in such application, and if, upon investigation, it shall appear to the Commission that there is a violation of law over which the Commission has jurisdiction, the Commission shall issue and serve upon the party complained of a complaint stating its charges and containing a notice of a hearing upon a day and at a place therein fixed at least forty days after the service of said complaint.

III. Answers. Within thirty days from the service of the complaint, unless such time be extended by order of the Commission, the defendant shall file with the Commission an answer to the complaint. Such answer shall contain a short and simple statement of the facts which constitute the ground of defense. It shall specifically admit or deny or explain each of the facts alleged in the complaint, unless the defendant is without knowledge, in which case he shall so state, such statement operating as a denial.

Answers in typewriting must be on one side of the paper only, on paper not more than 8½ inches wide and not more than 11

inches long, and weighing not less than 16 pounds to the ream, folio base, 17 by 22 inches, with left-hand margin not less than 1½ inches wide, or they may be printed in 10 or 12-point type on good, unglazed paper 8 inches wide by 10½ inches long, with inside margins not less than 1 inch wide.

IV. Service. Complaints, orders and other processes of the Commission may be served by any one duly authorized by the Commission, either (a) by delivering a copy thereof to the person to be served, or to a member of the partnership to be served, or to the president, secretary, or other executive officer, or a director, of the corporation or association to be served; or (b) by leaving a copy thereof at the principal office or place of business of such person, partnership, corporation, or association; or (c) by registering and mailing a copy thereof addressed to such person, partnership, corporation, or association at his or its principal office or place of business. The vertified return by the person so serving said complaint, order or other process, setting forth the manner of said service, shall be proof of the same, and the return post-office receipt for said complaint, order, or other process, registered and mailed as aforesaid, shall be proof of the service of the same.

V. Intervention. Any person, partnership, corporation, or association desiring to intervene in a contested proceeding shall make application in writing, setting out the grounds on which he or it claims to be interested. The Commission may, by order, permit intervention by counsel or in person to such extent and upon such terms as it shall deem just.

Application to intervene must be on one side of the paper only, on paper not more than 8½ inches wide and not more than 11 inches long, and weighing not less than 16 pounds to the ream, folio base, 17 by 22 inches, with left-hand margin not less than 1½ inches wide, or they may be printed in 10 or 12-point type on good, unglazed paper, 8 inches wide by 10½ inches long, with inside margins not less than 1 inch wide.

VI. Continuances and extensions of time. Continuances and extensions of time will be granted at the discretion of the Commission.

VII. Witnesses and subpœnas. Witnesses shall be examined orally, except that for good and exceptional cause for departing from the general rule, the Commission may permit their testimony to be taken by deposition.

Subpœnas requiring the attendance of witnesses from any place in the United States at any designated place of hearing may be issued by any member of the Commission.

Subpœnas for the production of documentary evidence (unless directed to issue by a commissioner upon his own motion) will issue only upon application in writing, which must be verified and must specify, as near as may be, the documents desired and the facts to be proved by them.

Witnesses summoned before the Commission shall be paid the same fees and mileage that are paid witnesses in the courts of the United States, and witnesses whose depositions are taken, and the persons taking the same, shall severally be entitled to the same fees as are paid for like services in the courts of the United States.

VIII. Depositions in contested proceedings. The Commission may order testimony to be taken by deposition in contested proceeding.

Depositions may be taken before any person designated by the Commission and having power to administer oaths.

Any party desiring to take the deposition of a witness shall make application in writing, setting out the reasons why such deposition should be taken, and stating the time when, the place where, and the name and post-office address of the person before whom it is desired the deposition be taken, the name and post-office address of the witness, and the subject-matter or matters concerning which the witness is expected to testify. If good cause be shown, the Commission will make and serve upon the parties, or their attorneys, an order wherein the Commission shall name the witness whose deposition is to be taken and specify the time when, the place where, and the person before whom the witness is to testify, with such time and place, and the person before whom the deposition is to be taken, so specified in the Commission's order, may or may not be the same as those named in said application to the Commission.

The testimony of the witness shall be reduced to writing by the officer before whom the deposition is taken, or under his direction, after which the deposition shall be subscribed by the witness and certified in usual form by the officer. After the deposition has been so certified, it shall, together with a copy thereof, made by such officer or under his direction, be forwarded by such officer under seal in an envelope addressed to the Commission at its office in Washington, D. C. Upon receipt of the deposition and copy, the Commission shall file in the record in said proceedings such deposition and forward the copy to the defendant or the defendant's attorney.

Such depositions shall be typewritten on one side only of the paper, which shall be not more than 8½ inches wide and not more than 11 inches long and weighing not less than 16 pounds to the ream, folio base, 17 by 22 inches, with left-hand margin not less than 1½ inches wide.

No deposition shall be taken except after at least six days' notice to the parties, and where the deposition is taken in a foreign country, such notice shall be at least fifteen days.

No deposition shall be taken, either before the proceeding is at issue, or, unless under special circumstances and for good cause shown, within ten days prior to the date of the hearing thereof assigned by the Commission, and where the deposition is taken in a foreign country, it shall not be taken after thirty days prior to such date of hearing.

IX. Documentary evidence. Where relevant and material matter offered in evidence is embraced in a document containing other matter not material or relevant and not intended to be put in evidence, such document will not be filed, but a copy only of such relevant and material matter shall be filed.

X. Briefs. Unless otherwise ordered, briefs may be filed at the close of the testimony in each contested proceeding. The presiding Commissioner or examiner shall fix the time within which briefs shall be filed and service thereof shall be made upon the adverse parties.

All briefs must be filed with the secretary and be accompanied by proof of service upon the adverse parties. Fifteen copies of

each brief shall be furnished for the use of the Commission, unless otherwise ordered.

Application for extension of time in which to file any brief shall be by petition in writing, stating the facts upon which the application rests, which must be filed with the Commission at least five days before the time for filing the brief.

Every brief shall contain, in the order here stated:

(1) A concise abstract, or statement of the case.

(2) A brief of the argument, exhibiting a clear statement of the points of fact or law to be discussed, with the reference to the pages of the record and the authorities relied upon in support of each point.

Every brief of more than ten pages shall contain on its top fly leaves a subject index with page references, the subject indexed to be supplemented by a list of all cases referred to, alphabetically arranged, together with reference to pages were the cases are cited

Briefs must be printed in 10 or 12 point type on good unglazed paper, 8 inches by 10½ inches, with inside margins not less than 1 inch wide, and with double-leaded text and single-leaded citations.

Oral arguments will be had only as ordered by the Commission.

XI. Address of the commission. All communications to the Commission must be addressed to Federal Trade Commission, Washington, D. C., unless otherwise specifically directed.

APPENDIX N

FALSE STAMPING.

(Act of June 13, 1906, Ch. 3289, 34 Stat. L. 260.)

AN ACT forbidding the importation, exportation, or carriage in interstate commerce of falsely or spuriously stamped articles of merchandise made of gold or silver or their alloys, and for other purposes.

SECTION 1. GOLD AND SILVER ARTICLES—INTERSTATE, ETC., TRANSMISSION OF FALSELY STAMPED, FORBIDDEN. That it shall be unlawful for any person, firm, corporation or association, being a manufacturer of or wholesale or retail dealer in gold or silver jewelry or goldware, silver goods or silverware, or for any officer, manager, director, or agent of such firm, corporation or association to import or export or cause to be imported into or exported from the United States for the purpose of selling or disposing of the same, or to deposit or cause to be deposited in the United States mails for transmission thereby, or to deliver or cause to be delivered to any common carrier for transportation from one state, territory or possession of the United States, or the District of Columbia, to any other state, territory or possession of the United States, or to said District, in interstate commerce, or to transport or cause to be transported from one state, territory or possession of the United States, or from the District of Columbia, to any other state, territory or possession of the United States, or to said District, in interstate commerce, any article of merchandise manufactured after the date when this act takes effect and made in whole or in part of gold or silver, or any alloy of either of said metals, and having stamped, branded, engraved or printed thereon, or upon any tag, card or label attached thereto, or upon any box, package, cover or wrapper in which said article is incased or inclosed, any mark or word indicating or designed or intended to indicate that the gold or silver alloy of either of said metals in such article is of a greater degree of fineness than the actual fineness or quality of such gold, silver or alloy, according to the standards and subject to the qualifications set forth in sections two and three of this act.

SECTION 2. GOLD ARTICLES—DEVIATION FROM MARKED FINENESS ALLOWED—TESTS—ACTUAL FINENESS REQUIRED. That in the case of articles of merchandise made in whole or in part of gold or of any of its alloys so imported into or exported from the United States, or so deposited in the United States mails for transmission, or so delivered for transportation to any common carrier, or so transported or caused to be transported as specified in the first section of this act, the actual fineness of such gold or alloy shall not be less by more than one-half of one carat than the fineness indicated by the mark stamped, banded, engraved or printed upon any part of such article, or upon any tag, card or label attached thereto, or upon any box, package, cover or wrapper in which such article is incased or inclosed; except that in the case of watch cases and flat ware, so made of gold or of any of its alloys, the actual fineness of such gold or alloy shall not be less by more than three one-thousandth parts than the fineness indicated by the mark stamped, branded, engraved or printed upon such article, or upon any tag, card or label attached thereto, or upon any box, package, cover or wrapper in which such article is incased or inclosed: *Provided*, That in any test for the ascertainment of the fineness of any article mentioned in this section, according to the foregoing standards, the part of the article taken for the test, analysis or assay shall be such part or portion as does not contain or have attached thereto any solder or alloy of inferior fineness used for brazing or uniting the parts of said article: *Provided, further*, That in the case of any article mentioned in this section, in addition to the foregoing tests and standards, the actual fineness of the entire quantity of gold or of its alloys contained in such article, including all solder and alloy of inferior fineness used for brazing or uniting the parts of such article (all such gold, alloys and solder being assayed as one piece), shall not be less by more than one carat than the fineness indicated by the mark stamped, branded, engraved or imprinted upon such article, or upon any tag, card or label attached thereto, or upon any box, package, cover or wrapper in which such article is incased or inclosed, it being intended that the standards of fineness and the tests or methods for ascertaining the same provided in this section for articles mentioned therein shall be concurrent and not alternative.

SECTION 3. SILVER ARTICLES—DEVIATION FROM MARKED FINENESS ALLOWED—"STERLING" GOODS—"COIN" GOODS—DIVERGENCE PERMITTED—TESTS—ACTUAL FINENESS REQUIRED. That in the case of articles of merchandise made in whole or in part of silver or any of its alloys so imported into or exported from the United States, or so deposited in the United States mails for transmission, or so delivered for transportation to any common carrier, or so transported or caused to transported as specified in the first section of this act, the actual fineness of the silver or alloy thereof of which such article is wholly or partly composed shall not be less by more than four one-thousandth parts than the actual fineness indicated by any mark (other than the word "sterling" or the word "coin") stamped, branded, engraved or printed upon any part of such article, or upon any tag, card or label attached thereto, or upon any box, package, cover or wrapper in which such article is incased or inclosed; and that no such article or tag, card or label attached thereto, or box, package, cover or wrapper in which such article is incased or inclosed shall be marked, stamped, branded, engraved or printed with the word "sterling" or "sterling silver" or any colorable imitation thereof, unless such article or parts thereof purporting to be silver contains nine hundred and twenty-five one-thousandth parts pure silver; and that no such article, tag, card, label, box, package, cover or wrapper shall be marked, stamped, branded, engraved or printed with the words "coin" or "coin silver" or colorable imitation thereof unless such article or parts thereof purporting to be silver contains nine hundred one-thousandth parts pure silver: *Provided*, That in the case of all such articles whose fineness is indicated by the word "sterling" or the word "coin" there shall be allowed a divergence in the fineness of four one-thousandth parts from the foregoing standards: *Provided*, That in any test for the ascertainment of the fineness of any such article mentioned in this section according to the foregoing standards the part of the article taken for the test, analysis, or assay shall be such part or portion as does not contain or have attached thereto any solder or alloy of inferior fineness used for brazing or uniting the parts of such article: *Provided, further*, That in the case of any article mentioned in this section, in addition to the foregoing tests and standards, the actual fine-

ness of the entire quantity of silver or of its alloys contained in such article, including all solder and alloy of inferior fineness used for brazing or uniting the parts of such articles (all such silver, alloys and solder being assayed as one piece), shall not be less by more than ten one-thousandth parts than the fineness indicatd by the marked (mark ?), stamped, branded, engraved or imprinted upon such article, or upon any tag, card or label attached thereto, or upon any box, package, cover or wrapper in which such article is incased or inclosed, it being intended that the standards of fineness and the tests or methods for ascertaining the same provided in this section for articles mentioned therein shall be concurrent and not alternative.

SECTION 4. PLATED GOODS—DESCRIPTION REQUIRED—USE OF "STERLING" OR "COIN" FORBIDDEN. That in the case of articles of merchandise made in whole or in part of an inferior metal, having deposited or plated thereon or brazed or otherwise affixed thereto a plating, covering or sheet composed of gold or silver, or of an alloy of either of said metals, and known in the market as rolled gold plate, gold plate, gold filled, silver plate, or gold or silver electroplate, or by any similar designation, so imported into or exported from the United States, or so deposited in the United States mails for transmission, or so delivered to any common carrier, or so transported or caused to be transported as specified in the first section of this act, no such article, nor any tag, card or label attached thereto, nor any box, package, cover or wrapper in which such article is incased or inclosed, shall be stamped, branded, engraved or imprinted with any word or mark usually employed to indicate the fineness of gold, unless such word or mark be accompanied by other words plainly indicating that such article or part thereof is made of rolled gold plate, gold plate, or gold electroplate, or is gold filled, as the case may be, and no such article, nor any tag, card or label attached thereto, nor any box, package, cover or wrapper in which such article is incased or inclosed, shall be stamped, branded, engraved or imprinted with the word "sterling" or the word "coin," either alone or in conjunction with other words or marks.

SECTION 5. PUNISHMENT FOR VIOLATIONS—JURISDICTION. That each and every person, firm, corporation or association,

being a manufacturer of or a wholesale or retail dealer in gold or silver jewelry, goldware, silver goods, or silverware, who or which shall knowingly violate any of the provisions of this act, and every officer, manager, director, or managing agent of any such corporation or association having knowledge of such violation and directly participating in such violation or consenting thereto, shall be deemed guilty of a misdemeanor, and upon conviction thereof in any court of the United States having jurisdiction of crimes within the district in which such violation was committed or through which has been conducted the transportation of the article in respect to which such violation has been committed, shall be punished by a fine of not more than five hundred dollars or imprisonment for not more than three months, or both, at the discretion of the court. Whenever the offense is begun in one jurisdiction and completed in another it may be dealt with, inquired of, tried, determined and punished in either jurisdiction in the same manner as if the offense had been actually and wholly committed therein.

SECTION 6. "ARTICLE OF MERCHANDISE" DEFINED. That the expression "article of merchandise" as used in this act shall signify any goods, wares, works of art, commodity, or other thing which may be lawfully kept or offered for sale.

SECTION 7. ORIGINAL PACKAGES NOT EXEMPT FROM STATE, ETC., LAWS. That all articles of merchandise to which this act applies which shall have been transported into any state, territory, district or possession of the United States, and shall remain therein for use, sale or storage, shall, upon arrival in such state, territory, district or possession, be subject to the operation of all the laws of such state, territory, district or possession of the United States to the same extent and in the same manner as though such articles of merchandise had been produced in such state, territory, district or possession, and shall not be exempt therefrom by reason of being introduced therein in original packages or otherwise.

SECTION 8. EFFECT. That this act shall take effect one year after the date of its passage.

INDEX.

References are to pages.

A

"Abacus," 324.

Abandonment—
a question of intent, 211, 216, 217, 573.
burden of proof in establishing, 213.
by adoption of new brand or label, 214.
by advertisement of sales agent, 216.
by dismissing bill for injunction, 212, 217.
by limited registration, 217.
by owner, will not confer title on another fraudulently using mark, 211.
by permitting infringements, 37.
by removal from premises, 212.
by retiring partner, 32.
constructive, 217.
defense of, not favored by courts, 211.
effect of, 22, 71.
involuntary, 214.
leaves mark open for adoption by another, 70, 71, 217.
of features of mark not registered, 217.
of mark owned jointly by independent dealers, by termination of joint business, 32.
proof of intention of, 213, 573.
terminates trademark right, 21, 22.

Aboriginal Words—
as trademarks, 145.

"Abricotine" (liqueur), 114.

"A. C. A." (cloth), 98.

Accessories—
need not be registered, 552.

Accidental Adoption, 17.

Account—
pending the suit, may be ordered where preliminary injunction refused, 452.

References are to pages.

Accounting—
as an incident to injunction, 451.
credits upon, 461, 582.
denied where defendant ignorant of plaintiff's mark, 310.
plaintiff entitled to reference for, as matter of right, when infringement confessed or proven, 453.
refused because of acquiescence, 210.
refused because of laches, 210.
rule the same in trademark and other unfair competition cases, 456.
trade-secret accountings, 267.

"Acid Phosphate," 98, 137.

Acquiescence—
a bar to relief against unfair competition, 52.
always question of fact, 208.
can not be inferred, 209.
distinguished from laches, 208.
is revocable, 209.
may bar right to accounting, 210.
no bar to injunction, 210.
none without knowledge of facts, 209.
tantamount to agreement, 208.

Acquisition—
by alien, 68, 69.
by assignment, 61, 67.
of trademark, generally, 61, 65.

Action (see Action at Law; Suits in Equity)—
forms of, 412.
for trademark and copyright infringement, may be joined, 405, 406.
for trademark and patent infringement, may be joined, 405.
failure to prosecution may effect abandonment of trademark, 211, 217.
for infringement survives owner's death, 400.
for invasion of goodwill, 245.
to compel registration, 574.

Action at Law—
continuando must be pleaded in, 416.
declaration in, 413.
form of declaration, 852.
generally, 52, 412.
trespass on the case, 412.

Act of 1870—
in full, 501.

Act of 1874, 513.

References are to pages.

Act of 1876, 528.
no conviction under, in absence of recital of exclusive ownership in certificate, 531.
not revived by Act of 1881, 531.
void because Act of 1870 invalid, 531.

Act of 1881—
did not make Act of 1876 operative, 531.
in full, 532.
requirements of registration under, 532, *n.* 3.
validity of, 532, *n.* 1.

Act of February 20, 1905, 549.

Actual Deception—
need not be proven, 51.

Added Matter—
in use of false mark, no defense, 333.
may tend to mitigate damages, 333.

Adjectives—
as trademarks, 97.

"Adjectives of the Language,"
may be instruments of frauds, 44, *n.* 34.

Administration—
of goodwill, 33.
trademarks of deceased person should be conveyed by, 34.
trademarks may pass without, 34.
upon trademark, 34.

Administrator—
as plaintiff in suit for infringement, 400.

Adoption—
actual adoption of trademark indispensable, 69, 70.
advertising mark is not, 65.
date of, stated in application, not conclusive, 389.
priority of, not conclusive, 72.
of mark abandoned by another, 70, 71.
validity determined by date of, 195.

Advertisement—
dishonest, deprives user of equitable relief, 75.
misleading, when restrained, 54, 319, 347.
not a trademark, 281.
of fact of assignment, 81.

References are to pages.

Advertising—
an element of goodwill, 319.
as assets, 43.
blind, 366.
mere use of mark in, does not create trademark right, 65, 551.

Advertising Solicitor—
enjoined from using material for rival publication, 259.

Advise of Counsel as a Defense—
to charge of infringement, 450.
to charge of unclean hands, 446.

"Aetna Iron Works" Case, 189.

Affidavits—
ex parte, insufficient as basis of preliminary injunction except in clear case, 476.
in chief, in application for preliminary injunction, must establish all necessary facts, 476.
must be entitled in the cause, 476.
proceeding by, on application for preliminary injunction, 476.

Affixing—
mode of, immaterial, 9, 65, 551.

"A. G.," 342.

Agent—
act done at suggestion of plaintiff's not an infringement, 436.
goodwill of, 222, 223.
liability of, for handling infringing goods, 402, 403.
upon determination of his employment enjoined from using word "agency" upon his signs, 346.

Agency—
effect of false representation of, 346.

Agreements Upon Dissolution—
how interpreted, 234, *n.* 97.

"Ainsworth" (thread), 114, 168.

"Air-Cell," 451, *n.* 24.

Alabama Trademark Statutes, 620.

Alaska Trademark Statutes, 620.

"Alba," 324.

"Albany Beef," 541.

"Allcock's Porous Plasters," 98.

References are to pages.

"Alderney" (oleomargarine), 114.

Alien—
abandoning mark in United States, acquires no right by subsequent legislation in his own country, 22.
acquisition of trademark by, 68.
can not have trademark right as against a citizen making prior adoption in good faith, 68.
might register under Act of 1881, 536, *n.* 11.
need not aver that mark is used in foreign commerce, to come within federal jurisdiction, 547, *n.* 39.
trademark rights of, 68.

Alternatives—
registration of, 336.
what may be registered as, 336, 540.

"Aluminum" (washboards), 98.

Ambiguity—
as a defense, 335.

Amendment—
in Patent Office, right of, 584.

"American" (sardines), 98.

"American Cold Japan" (Paint), 114.

"American Express" (sealing wax), 114.

"American Girl" (shoes), 114, 324.

"American Volunteer" (shoes), 114.

"Ammoniated Bone Superphosphate of Lime," 98.

Amount in Controversy—
in suit to restrain vendor of goodwill from re-engaging in business, 252.
is value of trademark, 546, *n.* 35.

Amusement Enterprises—
protection of names of, 173, 180.

Analogy—
value of, in determining character of infringement, 337.

"Anatolia" (licorice), 114.

"Anchor Brand" (wire), 114.

"Anglo-Portugo" (oysters), 98.

References are to pages.

"Angostura" (bitters), 98, 115.

"A. N. Hoxie's Mineral" (soap), 115.

"Annihilator" (medicine), 115.

"Ansatz" (bitters), 147.

Answer—
form of, 893, 896.

Anticipation—
what constitutes, 72, 559.

"Antiquarian" (book store), 98.

Anti-Trust Laws—
defined, 925.
no defense to infringement, 450.

"Anti-Washboard" (soap), 115.

"Anvil," 324.

"Apollinaris," 115, 324.

Appeal, 464, 584.

Appearance—
of goods, no trademark in, 550.

Appendant, Trademark Right Must Be, 26.

"Apple and Honey" (medicine), 98.

Application—
what is sufficient, of mark, 9.

Application for Registration (see Registration).

Appropriation—
priority of, 69.

Arizona Statutes, 620.

Arkansas, Trademark Statutes, 621.

Article of Manufacture, Defined, 516.
not a trademark, 139.

Artistic Productions—
unfair competition in, 356.

"Asbestos" (wall plaster), 99.

References are to pages.

"Assets and Goodwill"—
sale of, conveys trademarks, 30, *n.* 78.

Assignment—
assignability of trademarks, generally, 30, 58, 547, 575.
assignee acquires trademark subject to necessity of continued user, 36.
assignee must publish fact of assignment, when, 29, 81.
assignee can apply trademark only to same class of goods as assignor, 35.
assignor may be enjoined from use of mark, 36, 179.
general, in insolvency, conveys trademarks without special mention, 30.
general, of business, conveys trademarks without special mention, 30.
limited to specified territory, 29.
of distillery brands, 38.
of mark applied to the product of a secret process, 38.
of mark containing name and portrait of former owner, 29, *n.* 75.
of patent, effect as to patentee's name, 181.
of right to use one's own name, 74.
of right to use proper name can not be reassigned, 244, *n.* 33.
of secret process, 38.
of trademark by implication, 212.
recording, 575.
right of assignee of trademark to use name of assignor, 81, 553.
with reversionary right, 36.

Assignor—
enjoined from using his assigned name, 36.

Associations, Unincorporated—
names of, 190.

"Astral" (oil), 99.

Attachment—
action for damages for injury to goodwill through wrongful, 250.

Attorney—
goodwill of, 227.

"Atwood's Genuine Physical Jaundice Bitters," 80.

Autographic Signature—
misleading use of, enjoined, 349.

"A-V-H" (gin), 115.

References are to pages.

B

"Babbitt's Best" (soap), 12.

"Bacco-Curo" (remedy), 115.

"Baffle" (safes), 115.

Bailee—
of infringing goods, duty of to make discovery, 405.
of infringing goods, liable to injunction, 405.

Baker—
goodwill of, 222.

"Balm of Thousand Flowers" (cosmetic), 78, 99, 115.

Banker—
goodwill of, 222.

Bankruptcy—
trademarks in, 30.

"Barbers Model" (razors), 99.

"Bazaar" (patterns), 99.

"B. B. B.," 115.

"B. B. H." (iron), 115.

"Beatty's Headline" (copy-book), 116.

"Bell of Moscow" (wine), 116.

"Bell's Life" Case, 198.

"Benedictine" (liqueur), 116.

Benefit Societies—
names of, 190.

Bequest—
of goodwill, 225.
of trademark, 31.

"Bethesda" (water), 116.

"Better Than Mother's" (mince meat), 99.

"Bhe Hathi," 322.

Bill in Equity, 426.
averment as to ownership, 430, *n.* 22.
averments of citizenship of parties, 426.
defect on face of, must be met by demurrer and not by plea, 441.

References are to pages.

Bill in Equity—Continued.
form of, 855, 861.
form of interrogatories, 860.
form of, trademark infringement, 855, 872, 879, 884, 890.
form of, unfair competition, 867.
need not be verified, when, 430.
not demurrable because praying for both profits and damages, 429.
should show application of mark in foreign or interstate commerce, 429.
to restrain dealing in fraudulent labels, 430.
to restrain disclosure of secret process, 253.
to restrain unfair competition, 430.
verification, 430.

Bill of Sale—
what words in, convey trademarks, etc., 30.

"Bismarck" (collars), 116, 170.

"Black Diamond," 324.

"Black Package" (tea), 99.

"Blackstone" (cigars), 116.

Blind Advertising—
appropriating, 366.

"Blood Searcher" (medicine), 116.

"Blue Lick Water," 116.

"Bohemian" (beer), 99.

"Boker's Stomach Bitters," 116.

"Bokol" (beer), 144.

Bond—
on preliminary injunction, 453.

Book—
device of, not trademark, 99.
title of, as trademark, 93, 196.

Books and Papers—
discovery and inspection of, 471, 472.

"Booth's Theatre" Case, 179.

"Borax" (soap), 99.

References are to pages.

Bottles—
distinctive, protected, 287.
refilling enjoined, 313.

"Bovilene," 116, 324.

"Bovril" (meat extract), 117.

Boxes—
injunction against competitor buying, 300.

"Braided Fixed Stars" (cigar lights), 99.

Breach of Contract—
inciting, as unfair competition, 363.

Brewer—
goodwill of, 222.

"Bromidia" (medicine), 117.

"Bromo-Caffeine," 117, 138.

"Bromo Celery," 137.

"Bromo-Quinine," 137, 138.

"B. T. Babbitt's Trademark Best Soap," 335.

"Buffalo Pitts," 542.

Bulk Goods—
purchaser of, can not use manufacturer's trademark used only on his own packages, 316.

Burden of Proof—
in establishing abandonment, 214.
in establishing priority against existing registration, in application to register, 545, *n.* 33.
on applicant in interferences, 544, *n.* 29.
strongly upon complainant in refilling cases, 315.

"Burgess," 324.

"Business Connections and Patronage"—
include goodwill, 228.

"Business and Assets"—
conveys trademarks, 30, *n.* 78.

"Buster Brown" Case, 205, 356.

References are to pages.

C

"C. A.," 400.

"Cachemire Milano" (cloth), 100.

California Trademark Statutes, 19, 628.

California Trademark Forms, 637.

"California Syrup of Figs" (laxative), 100.

"Camel Hair Belting" (case), 13, 46, 151, 190.

Canada—
trademark rights of alien in, 69.

Canadian Act, Rules and Forms, 831, 842, 850.

"Canadian Club Whiskey," 167, 324.

Cancellation of Registration, 390, 576, 577.
form of petition, 618.
request by owner for, 578.

"C. A. P." (cream acid phosphate), 100.

Care—
degree of, expected of consumers, 304

Carpet Cleaner—
marks of, 532, *n.* 3.

Carriers—
liable for infringement, 404.

"Carrom" (game-board), 117.

Cartons—
falsely indicating maker, 159, 309.

"Cascarets" (cathartic medicine), 324.

"Cashmere Bouquet" (toilet soap), 117, 325.

"Castoria" (medicine), 100.

Catalogue—
improper use of, restrained, 260.

Catch-Words—
by which goods known to trade, how proven, 469.
suggested by a trademark, protected, 151, 344.

Causes of Action—
joinder of, 405.

References are to pages.

Caution Notices—
as evidence of acquiescence, 210.

"Celebrated Stomach Bitters," 100.

Celebrity—
name of, as trademark, 170.
registration of name of, as trademark, 274.

"Celery Compound" (medicine), 117.

"Cellular Clothing" (case), 13, 100, 153.

"Celluloid," 325.

"Centennial" (clothing, etc.), 100.

"Ceresota" (flour), 117, 325.

Certificate of Registration—
how assigned, 67.
value of, 545, 581.

Certiorari—
generally, 465, 581.
to review contempt proceedings, 476.
to review filing of articles of incorporation, 189.
to review taxation of trademark, 60.
under Act of 1905, 581.

"Champion" (flour), 117.

Change of Ownership—
notice to public, 29.

"Charley's Aunt" (farce title), 117.

"Charter Oak" (stoves), 118.

"Chartreuse" (cordial), 38, 118.

"Chatterbox" (periodical), 26, 118, 325.

"Cherry Pectoral" (medicine), 100.

Cheesemonger—
goodwill of, 222.

hicago Waists" (corsets), 118.

"Chicken Cock" (whiskey), 118, 328.

"Chili Colorow" (condiment), 147, 541.

"Chill Stop" (medicine), 100.

References are to pages.

"Chinese Liniment," 118.

"Chlorodyne" (medicinal compound), 100, 148.

"Christy's Minstrels" (case), 173, 180.

Cigar-Bands—
simulation of, enjoined, 282.

Circulars—
false representations in, deprive from relief, 87.
injunction against, when containing false representations, 319.

Citizenship—
averment of, concerning corporation, not proper, 414
defined, 536.
diverse, must be pleaded in federal practice, 52.
of applicant for registration, immaterial, 536.
what averments necessary in federal equity pleading, 414.

"Clark's O. N. T.," 325.

Classification—
of trademarks, suggested by patent office, 907.

Class of Goods—
must be stated in registering, 537.
infringement must be upon same, 307, 310.
in cases of unfair competition, 309.

Clayton Act—
as a defense, 156.
interpretations, 938.
sections enforceable by Federal Trade Commission, 934.

"Clean Hands"—
equitable rule as to, 78.

"Climax" (stoves), 118.

"Cloverdale," 541.

"Club" (cocktails), 118.

"Club House" (gin), 101.

"Club Soda," 118.

"Coal Oil Johnny's Petroleum" (soap), 118.

Coat-of-Arms—
effect of adding, to trademark, 444.
not registrable, 556.
of state or United States not registrable, 541.

References are to pages.

"Coca-Cola," 333.

"Cocoaine" (hair oil), 118, 137, 325

"Cocoatina," 325.

"Coe's Superphosphate of Lime," 118.

"Cohesive" (tile), 118.

Coined Words—
as trademarks, 142.

Collateral Misrepresentation—
will not debar mark from protection, 81, 166.

Collocation—
in issue of fraudulent use of color, 285.

"Colonial," 333, 336.

Color—
fraudulent imitation of, 87, 284.
infringement of, restrained, 284.
no trademark in, 282.
not registrable as trademark, 287, *note.*
registration in, 287.

Colorable Imitation—
of trademarks, 300.

Colorado—
statutes and forms, 638, 642.

Combinations—
in restraint of trade, 450.
of non-registrable words, 563.
of old word-elements, 560.

"Comfort" (publication), 118.

Commerce—
trademark must be used in, 19.

Commerce Clause—
as basis of federal trademark legislation, 19, 379.

"Commercial Advertiser" (case), 201.

Commissioner of Patents (see Statutes: Act of 1905, and Trademark Rules of Patent Office),
action of, not controlled by mandamus, 543, *n.* 28.
duties of, judicial, 543.
shall keep a record of assignments, 575.

References are to pages.

Common Law—
right of trademark not abridged or qualified by registration act, 19, 547, *n.* 38.

Common to the Trade, 69, 134.
defined, 134.
extensive sales do not make trademark, 191.
package may be, 290, 345.
picture may be, 134, *n.* 52, 141.
resemblance in such particulars no infringement, 282.
words, not subject to exclusive appropriation, 69, 134.

"Compactum" (umbrellas), 118.

Comparison—
by the court, final test of resemblance, 467.
no opportunity of, given consumer, as affecting test of infringement, 302.

"Computing" (scales), 101, 119.

"Concurrence Deloyale," French equivalent for unfair competition, 50.

Confiscation—
abroad, does not deprive owner of his trademark rights within the United States, 69.

Confusion—
of business as evidence of right to relief, 48, 572.

"Congress Water," 119.

Congressional Legislation—
basis of, 19.

Connecticut—
statutes and forms, 643, 649.

Conspiracy—
to suppress competition, 50, *n.* 47.

Construction—
of contracts affecting trade secrets, 261.

Containers, 345.

Contempts—
action upon, not reviewed on appeal, 476.
by circulating matter prejudicial to defense, 474.
by offering infringing goods for sale, though no sale effected, 474.
by publishing perverted construction of injunction, 474.
by violation of decree, 474.

References are to pages.

Contempts—Continued.
costs of unsuccessful motion to commit, 494.
costs upon appeal, 494.
enlarging decree on hearing, 474.
erroneous action upon, reached by *certiorari*, 476.
in disobeying subpoena, 264.
intent of contemnor, immaterial, 474.

"Continental" (fire insurance corporation), 101, 186.

Continuando—
must be pleaded in action at law, 416.

Continuity—
of use, trademark right dependent on, 20.

Contracts—
for sale of goodwill, 235.
how construed, 261.
in reference to trade secrets, 253.
in restraint of trade, 235.
not to disclose trade secret, implied as between master and servant, 258.

Contracts Affecting Use of Trademark (see Statutes: Acts of 1881 and 1905)—
not amounting to transfer or assignment, can not be registered, 547, *n.* 40.

Controlling Feature—
must be registrable, 561.

Conveyance—
of "all business and assets" conveys trademark, 30, *n.* 78.

"Copenhagen" (snuff), 101.

Copyrights—
action for infringing, joinder of, 406.
distinguished from trademarks, 2.
effect of expiration, on title, 91, 563.
effect on registration, 553.

"Corona," 325.

Corporate Names—
as trademarks, 183.
fraudulent, enjoined, 178.
governed by same principles as names of partnerships and individuals, 187.
individuals using, 189.
registrable, when, 557.

References are to pages.

Corporation—
can not acquire right to use proper name in unfair competition, 188.
can not be a citizen, 414.
creation of, no defense to infringement by incorporators, 443.
goodwill of, 226.
having common interest, may join as plaintiff, 400.
injunction may issue against all persons connected with infringing, 240.
jurisdiction of federal courts in suits against, 414.
may oppose registration, 566.
may hold trademarks, 61.
restraint of, from improper use of proper name in corporate name, 74, 188.
stock issued for goodwill, 226.
transfer of goodwill of, 227.

Costs—
as against innocent warehouseman, 493.
as against retailer, 437.
avoiding by submission, 403, 404, 405, 438.
awarded bailee who has made discovery, 493.
caused by unfounded charge in bill, 493.
generally, 490.
in unsuccessful motion to commit for contempt, 494.
may be adjudged on interlocutory decree, 494.
may be allowed where damages refused, 490.
on appeal, when decree reversed in part, 495.
on interlocutory decree, 494.
pleading to avoid, 437.
refused as against retail dealer, 437.
refused as against label manufacturer acting ignorantly, 437.
refused because of delay, 493.
refused successful defendant, when, 494.
subject to prior lien of wharfinger's charges, 493.
upon appeal from committal for contempt, 494.
usually follow the event, 490.
want of notice, no defense to recovery of, 490.
where sales too small to justify accounting, 493.

"Cottolene," 119, 325.

"Cough Cherries" (confectionery), 119.

"Cough Remedy," 101.

Counsel Fees—
as element of damage, 457.

Counterfeiting—
infringement by, 300.
trademarks, 300.

References are to pages.

Court of Appeals D. C.—
decisions of, not appealable to supreme court, 574.

Courts—
jurisdiction of, in cases of unfair competition, 53.

Covenants—
not to re-engage, 233.

"Crack Proof" (rubber), 101.

"Cramp Cure," 101.

"Cream" (baking powder, etc.), 101, 119.

Credits on Accounting, 461.

"Cresylic" (ointment), 101.

Criminal Prosecution—
for trademark infringement, 410

"Cristalline" 541.

"Cromarty," 541.

Cross-Bill—
in opposition proceeding, 568.
not necessary where affirmative relief sought by a defendant, 434.

"Croup Tincture," 101.

"Crow" (whiskey), 119, 126.

"Crown Seixo" (case), 321.

"Crystallized Egg," 101.

"Cupola," 325.

Customers' Brands, 216, *n.* 56.

"Cuticura," 119, 333.

"Cyclops Machine Works," 325.

"Cylinder" (glass), 101.

Cypher Code—
improper use of, when restrained, 260.

References are to pages.

D

Damages—
amount of, does not fix jurisdiction of federal courts in trademark cases, 393.
and profits both assessed in equity, 455.
awarded in equity where no loss of profit shown, 457.
counsel fees as an element, 457.
election between, and profits, in English practice, 455.
for invasion of goodwill, 229, 243.
in actions at law, 419.
in cases of unfair competition only where intentional fraud, 455.
increasing, under Act of 1905, 582.
jury may make inferences as to, from all the evidence, 421.
loss of sales as an element of, 421, 422, 423.
lost by failure to imprint, 586.
may be mitigated by showing matter added to mark in use, 333.
nominal, in actions at law, 421.
plaintiff must elect between, and profits, under English practice, 455.
punitive, can not be assessed in equity, 460.
punitive, may be recovered at law, 419.
punitive, only where fraudulent intent shown, 419.
punitive or exemplary, where may be allowed where no actual damage proven, at law, 421, *n.* 43.

Date of Adoption—
determines validity of trademark, 195.

Davids Case, 563, 564, 861.

"Day & Martin," 47.

Dead Languages—
trademarks consisting of words from, 143.
words from, may be used as trademark, when, 143.

Dealer—
goodwill of, 222, 223.
in fraudulent labels, 298.
purchasing infringing goods from manufacturer, injunction against, 449.

Deceit—
action of, by defrauded purchaser, 405.

Deception, 43.
doubt as to, resolved in favor of complainant, 307.
need not be shown, when, 51.
probability of, as test of infringement, 290.
proof of, when necessary, 290.

References are to pages.

Deceptive Marks—
not registrable, 541.

Declaration (see Forms)—
in action of trespass, 413

Decorative Use—
does not anticipate, 72.

Decree—
directing defendant how to use a proper name, 462.
directory, generally, 462.

Defendant (see Parties Defendant)—
unsuccessfully attaching plaintiff's title is wanton trespasser, 440.

Defenses—
abandonment, 210.
action at law better susceptible of defense than suit in equity, 418.
acquiescence, 208.
added matter used with infringing mark, ineffective, 333, 450.
adverse adjudication in a foreign country, 449.
attacking plaintiff's right to sue, 417.
denying, infringement, 418.
equality of quality no defense, 337.
estoppel, 417.
explanatory matter, 449.
fraudulent representations by plaintiff, as, 436.
in action at law, 417.
ineffective, that refilling was done at request of customer, 313.
in equity, 417.
insanity, 449.
laches, as defense to accounting, 206.
laches or delay, 206.
license from owner, 59, 418.
misrepresentations by owner, 80.
no defense that purchaser was notified of real nature of infringing goods, 436.
none to show defendant added "Improved" to infringing mark, 442.
none to show defendant placed his name, initials or address on infringing goods, 337.
non-infringement, 418.
of abandonment, not favored, 211.
of equality of quality of goods, 442.
of infancy, 441.
of plaintiff adding coat-of-arms to trademark, 444.
of prior use, ineffective, where user accompanied by false representations, 443.

References are to pages.

Defenses—Continued.
of registration of defendant's mark, 441.
of using name and address in conjunction with trademark, 442.
plaintiff's failure to advertise assignment, 81.
prior use must be on same class, 442.
showing that infringement has ceased, ineffective, 448.
that complainant is a party to a combination in restraint of trade, 450.
that defendant added word "Improved," 442.
that defendant did not intend to sell, ineffective, 442.
that defendant did not sell, ineffective, 448.
that defendant did not make infringing article, ineffective, 448.
that defendant has been licensed, ineffective where license revoked, 448.
that defendant has ceased infringing, 423.
that defendants have incorporated, ineffective, 443.
that defendant is acting as agent, ineffective, 448.
that infringing goods were made by plaintiff, ineffective, 442.
that infringement has ceased, no defense in action at law, 423.
that infringement is only partial, ineffective, 444.
that infringement of proper name is done under fraudulent license, ineffective, 444.
that infringement committed by agents or servants, 443.
that licensee has not joined in action, 448.
that mark has become *publici juris*, 418.
that mark is common to the trade, 417.
that others are infringing, ineffective, 443.
that plaintiff's mark infringes another's, 437.
that plaintiff is guilty of misrepresentation to public, 444.
that registrant has failed to imprint, 586.
that territorial licensee is not joined in suit, ineffective, 448.
use by others on goods of another class, 443.
want of notice, ineffective, 443.
wrongful use of words "patent" or "patented," 81.

Definitions—
acquiescence, 208.
acts to regulate commerce, 925.
affixed, 550, 586.
amount in controversy, 546, *n.* 35.
anti-trust acts, 925.
applicant, 586.
article of manufacture, 516.
article of merchandise (False Stamping Act), 948.
citizenship, 536.
coin goods, 946.
commerce, 925.
"common to the trade," 134.

References are to pages.

Definitions—Continued.
corporation, 925.
counterfeit mark, 300.
distinctive, 9, *n.* 4.
distinctive names, under Food and Drugs Act, 154.
documentary evidence, 925.
domicile, 536, *n.* 9.
essential features of trademark, 537, *n.* 13.
exclusive use, 564.
fac-simile, 538, *n.* 14.
function of trademarks, 17, 18, 551.
generic term, 93, 132.
goodwill, 218.
imitation mark, 300.
infringement, 279.
label, 515.
laches, 206.
location, 536, *n.* 10.
misbranding, 560.
owner, 586.
pending, 584.
person, 586.
print, 515.
quack medicine, 254.
"quality," 132.
registrant, 586.
renewal, 576.
right of privacy, 267.
secondary meaning, 190.
states, 586.
sterling goods, 946.
substitution, 317.
trademark, 4, 586.
tradename, 10.
trade secret, 253.
treaty, 535, *n.* 6.
United States, 586.

Degree of Care—
expected of consumers, 304.

Degree of Resemblance, 187.

Delaware Statutes, 649.

Delay—
to secure evidence, 206.

"Delsarte" (shoes), 119.

References are to pages.

Demurrer—
confesses allegation of fraud, and injunction issues if demurrer overruled, 453.
interposed on application for preliminary injunction, 453.
proper attack on defects upon face of bill, 441.
sustained where exhibited conflicting marks show no infringement, 440.
to title shown in bill, 441.
will not lie to bill in equity on ground of uniting prayers for damages and profits, 430.

"Dent, London," 31, 48.

Depositions—
before Federal Trade Commission, 941.
generally, 481.
in actions at law, 477.

"Derby," 284.

"Derringer" (fire-arms), 119.

Description——
requisites of, in registration, 553, 554.

Descriptive Picture—
not a trademark, 80, 541.

Descriptive Words—
as tradenames, 14, 191.
invalid because generic, 94.
not registrable, 540, *n.* 24.
of secondary meaning, 192.
valid trademarks if remotely descriptive, 96.
why objectionable as trademarks, 191.

Design—
patented by another, not registrable as trademark, 542, *n.* 26.

"Dessicated" (codfish), 101.

Details—
similarity of, 343.

Device—
as trademark, 4, *n.* 3.

"Dewey's Chewies," 274, *n.* 89.

"Diamond Steel" (case), 322.

Directors—
of corporation as defendants in action for infringement by corporation, 403.

References are to pages.

Directory—
name as trademark, 201.

Discovery—
to avoid costs, 405.
when compelled, 471.

Dismissal—
of cancellation proceeding, 578.

"Disque," 451.

Dissimilar Word or Mark—
may infringe, 332, 559.

Dissolution—
of interference, 571.
use of trademarks by partners on, 31.
use of trade secrets by partners on, 262.

Distillery Brands—
assignability of, 38.

"Distillers"—
effect of, 78.

Distinctive—
defined, 9, *n.* 4.
trademark must be, 9, 20, 46, 73.

"Distinctive Names"—
under Food and Drugs Act, 154.

Distinguishing Feature—
must be registrable, 561.

District of Columbia—
courts of appeals, jurisdiction under Act of 1905, 581.

Disuse—
abandonment of trademark by, 212.

Diverse Citizenship—
must be pleaded, in federal practice, 52.

Division—
order of, appealable, 554, 574.
order of, effect of, 574.

"Dog's Head Beer" (case), 322.

Domicile—
defined, 536, *n.* 9.

References are to pages.

"Doric," 326.

Double Meaning—
words of, 194.

Doubt—
resolved in favor of registrant, 563.

Dress—
of goods, 53.

"Dr. Johnson's Yellow Ointment," 49.

"Dr. Lobenthal's Essentia Antiphthisica," 120.

"Druggists' Sundries" (cigars), 101.

"Druggists' Sundries"—
too broad for class in registration, 537.

"Dry Monopole" (champaigne), 102.

"Dublin" (soap), 120, 541.

"Duplex," 326.

Duplication—
of tradename not enjoined, when, 48, *note.*

Duration—
of life of trademarks, 21, 23.
of term of registration, 21.

"Durham" (tobacco), 102, 120, 160, 326.

"Dyspepticure," 120, 336.

E

"Economy," 326.

"Edelweiss" (perfume), 120.

"Egg" (macaroni), 102.

"Egyptian Deities," 326.

"Elastic" (book-cases), 120.

"Elastic Seam" (drawers), 102.

"El Cabio" (tobacco), 144.

"El Destino" (cigars), 144.

Election—
between profits and damages, 429, 455.
of remedies, 413.

References are to pages.

"Electro-Silicon," 120, 138, 326.

"Elgin" (watches), 102, 164.

"Elk" (cigars), 120.

Eminent Domain—
goodwill subject to, 229.

"Emollia" (toilet cream), 120.

"Emolliorum" (leather dressing), 102.

"Empire" (stoves), 120.

Employee—
enjoined from disclosing trade secrets, 255.
liable for infringement, 403.

Empty Packages—
competitor enjoined from buying, 299.

"Encyclopedia Britannica," 102.

England—
trademark legislation in, —.
trademark rights of alien in, 68.

Engraver—
of fraudulent marks, 298.

Ensemble—
imitation of, 293.

Entirety—
trademarks as, 57.

"Epicure" (canned salmon), 120.

Equality of Quality—
no defense, 337.

Equity (see Account, Accounting, Decree, Forms, Injunction, Interlocutory Decree, Laches, Master, Preliminary Injunction, References, etc.).
acquiescence, 52.
delay, 206, 208.
fraud confers jurisdiction, 54.
jurisdiction over fraud, 55.
jurisdiction over unfair competition, 55.
laches, 52.
not bound by arbitrary rules, 51.
relief in, 54, 451.
'unclean hands," 78, 446.

References are to pages.

"Estate and Effects"—
goodwill, not included in, 227.

Estoppel—
as a defense, 417.
must be pleaded, 417.
of license to deny validity, 60.
of withdrawing partner as against subsequent creditor, where old firm name used, 245.

"Ethiopian" (stockings), 120, 147, *n.* 24.

"Eton" (cigarettes), 215.

"Eureka" (fertilizer, etc.), 120, 121, 143.

"Eureka" (shirts), 120, 143.

"Evaporated" (food), 102.

"Ever Ready" (coffee mills), 102.

"Everyday Soap," 326, 333.

Evidence—
burden of proof in refilling cases, 468.
burden of proving abandonment, 214.
burden of proving prior right, 213, *n.* 48.
delay in order to secure, not laches, 206.
expert, on question of infringement, 469.
matters of which courts take judicial notice, 467.
of abandonment, 210.
of deception, when necessary, 469.
of defendant's sales, 469.
of experts, as to habits of customers, 468.
of fraud, 310.
of fraud, particular instances, 310.
of fraudulent intent—
in criminal prosecution, 310.
in other cases of unfair competition, 310.
in trademark cases, 310.
of good faith, 469.
of intent of contemnor immaterial, 474.
of loss of sales, 422, 423.
of loss of sales, in action at law, 423.
of other frauds, 311.
of submission of others, 472.
printing label in foreign language, evidence of frauds, 167.
registration as, of extent of claim, 386.

References are to pages.

Evolution of Law of Trademarks, 16.

"Excelsior" (soap), 121, 143, 215, 326.

"Excelsior" (stoves, etc.), 121, 143.

Exclusive Licensee—
must be a party, 59.

Exclusiveness—
as test of trademark's validity, 20.

Exclusive Use—
defined, 564.

Execution—
may be levied on trade secret, 263.
on goodwill, 226.

Exemplary Damages—
in actions at law, 421, 422.
may be allowed where no actual damages proven, 421, *n.* 43.

Exhibits—
attaching to injunctive order, 471.
demurrer may be sustained on inspection of, 440.
introducing conflicting marks, as, 440.

Existence—
of trademark right, 21.

Expert Evidence—
as to habits of customers, 470.
as to variance in alcoholic proof in liquors, 468.
on catch-words applied to goods, 469.
on question of infringement, 348.
on technical and scientific questions, 468.
valuable in doubtful case, 468.

Expiration of Patent—
effect of, on right to protection of dress, 87, 151.
effect of, on trademarks, 88.

Exporters—
may have trademarks, 63.

Extensive Sale—
does not invalidate mark, 149.

"Extract of Night-Blooming Cereus" (perfume), 102.

References are to pages.

F

"Faber" (pencils), 102, 121.

Fac-simile—
defined, 438, *n.* 14.
need not contain unessential features of mark, 532.
one only needed for registration, under Act of 1881, 532.
required in registration, under Act of 1905, 549.

"Fadettes" (case), 180.

"Fairbank's Patent" (scales), 102.

Fair Trade—
required by equity, 49.

False Labels—
averment of bill to restrain dealing in, 890.

False Pretenses—
in sale of goods under imitation mark, 410.

False Representation, 45.
as bar to registration, 561.
as to foreign origin of goods, 167, 215.
deprives owner of registered mark of protection, 546, *n.* 35.
in connection with trademarks, 78, 79, 80.

Falsely Marking—
article "patented," 84.

False Stamping—
gold and silver articles, "article of merchandise" defined, 946.
"coin" goods, 946.
deviation from marked fineness, 945.
fineness required, 945.
original packages, 948.
plated goods, requirements as to, 947.
punishment, jurisdiction, 947.
"sterling" goods, 947.
to be properly stamped, 946.

"Family" (sälve), 121.

"Famous" (stoves), 102.

"Fancy Goods"—
too broad for class in registration, 537, ***n.* 12.**

References are to pages.

Fancy Words—
protected as trademark, 153, 166.

"Farthest North" (book title), 335.

"Favorita" (flour), 121.

"Favorite" (letter file), 103.

Federal Anti-Trust Acts—
private actions under, 375.

Federal Courts—
jurisdiction concurrent with state courts in trademark cases, 395.
jurisdiction dependent upon diverse citizenship in cases of unregistered trademarks, 391.
jurisdiction of, in cases of unfair competition, 52.
jurisdiction of, in trademark cases, 395, 581.

Federal Statutes (see Statutes, Federal).

Federal Trade Commission—
Act of September 26, 1914, establishing:
Sec. 1. Federal Trade Commission—Creation—Membership—Vacancies—Seal, 923.
2. Salaries—Employees—Classified Civil Service—Expenditures—Rent of offices, 923.
3. Bureau of corporations abolished—Transfer of employees, etc.—Principal office—Inquiries elsewhere, 924.
4. Definitions, 925.
5. Power to prohibit unfair competition—Procedure—Review, 926.
6. Additional powers, 928.
7. May act as master in chancery, when, 930.
8. Records, etc., of governmental departments furnished commission, 930.
9. Documentary evidence—Attendance of witnesses—Depositions—Incriminating evidence, 931.
10. Penalties, 932.
11. Anti-trust acts and acts to regulate commerce not repealed, 934.
rules of the commission, 938.

Fees (see Statutes; Act of 1905, and Statutes of the Several States)—
for registration of trademark in patent office, 578.
registration, when refunded, 539, *n.* 17, 579.

"Ferro-Manganese" (mineral water), 137.

"Ferro-Phosphorated Elixir of Calisaya Bark," 103, 137.

References are to pages.

"Fibre Chamois" (dress linings), 121.

Figurative Words—
as valid trademarks, 194.

"Filofloss" (silk), 121, 334.

"Filoselle," 335.

"Filtre Rapide" (filters), 121.

"Fire-Board," 451, *n.* 24.

"Fire-proof," (oil), 103.

Firm Name—
as part of goodwill, 244.
as trademarks, 168.
passes to purchaser of assets only by express agreement, 243.

Fish Inspector—
marks of, 532, *n.* 3.

Flag—
not registrable, 556.

"Flinch" (game), 103.

"Flor de Margaretta," 326.

"Flor Fina" (cigars), 144.

Florida, Statutes, 653.

Food and Drugs Act—
misbranding under, 560.

Foreign Adjudications—
upon right to trademark, 209, *note.*

Foreign Corporation—
right of, to enjoin formation of new corporation under same name, 187, 189.

Foreign Corporation Law—
effect of non-compliance, 22.

Foreigners—
had no special privilege under Act of March 3, 1881, 548, *n.* 41.

Foreign Language—
printing generic word in letters from, does not make trademark, 95.
use of, as evidence of unfair competition, 166.
words from, as trademarks, 143.

References are to pages.

Forgery—
counterfeiting trademarks is not, 57, 410.

Form—
not registrable as trademark, 538, *note.*
infringement of, 287.

Form, Size and Color—
no trademark in, 280, 284, 287, 550.

Former—
adjudication, 570.

Forms (forms for state registration are indexed under the names of the several states)—
answer, 893, 896.
bill of complaint:
against dealer in spurious labels, 867.
trademark infringement, 855, 872, 879, 884, 890.
under ten-year clause, 861.
unfair competition, 867.
cancellation, application for, 618.
contract against disclosing trade secret, 257.
covenant not to re-engage, 225, *n.* 52.
declaration, action at law, 852.
drawing, form of, 619.
injunction:
final decree, 91, 459, 903, 904, 905.
interlocutory decree, 901.
writ, 903.
interrogatories, 860.
mandate, circuit court of appeals, 906.
opposition, notice of, 617.
pleading registration of trademark, 861, 881, 886.
registration, prints and labels:
application by:
an individual—prints, 524.
a firm—prints, 524.
a corporation—prints, 525.
an individual—labels, 526.
a firm—labels, 526.
a corporation—labels, 526.
trademark registration:
petition, 611.
statement by an individual, 612.
declaration for an individual, 612.
statement by a firm, 613.
declaration for a firm, 613.

References are to pages.

Forms—Continued.
trademark registration:—continued.
statement by a corporation, 614.
declaration for a corporation, 614.
declaration under ten-year proviso, 615.
declaration for a foreign applicant, 617.
notice of opposition, 617.
petition for cancellation, 618.

Forms of Action, 405.

Former Adjudication—
as basis for preliminary injunction, 453.
value of, 453.

Formula—
protection of, 267.
relation to trademark, 38.

Fraud—
as the basis of equitable jurisdiction, 2, 3, 4, 12, 14, 47.
circumstantial evidence of, 469, *n.* 13.
evidence of, 166.
how charged in bill to restrain unfair competition, 430, *n.* 22.
in using one's own name, 178.
no fixed rules for dealing with, in equity, 346.
must be pleaded in action at law, 415.
must be proven in cases of unfair competition, 43, 51.
presumed from printing American label in foreign language, 167.
presumed from wrongful use of trademark, 42, 51.

Fraudulent Intent—
how proven, 311.
may be inferred, 294, 295.
must be shown in action at law, 295.
presumed in equity from wrongful use of trademark, 42, 294.
proof of, 297.

Fraudulent Packages—
liability of dealer in, 405.

Fraudulent Representations—
by plaintiff, as a defense, 417, 436.

"French" (paints), 103.

"French Tissue" (medicated paper), 103.

"Fruit Salt," 439.

"Fruit" (vinegar), 103.

Function—
of trademarks, 17, 18, *n.* 33, 551.

References are to pages.

G

"Galen" (manufactured glass), 103.

"G. E." (electric lamps), 342.

General Effect—
doctrine of, 346.

Generic Terms—
a matter of evidence, 149.
can not be trademarks, 75, 133.
classified, 93.
common to trade, no exclusive right to, conveyed by registration, 134, 135.
defined, 93.
from dead languages, not valid trademarks, 143.
illustrations of, 98.
include geographical and descriptive words and proper names, 93.
judicially defined, 132.
may be distinctive, 154.
not made trademarks by registration, 385.
when protected, 149.

"Genuine Yankee" (soap), 283.

Geographical Names—
as employed by sole owner of natural product and place of production, 160.
as trademarks, 61, 93, 159.
can not be essential feature of trademark, 541.
classification of, 541.
false use of, vitiates trademark, 165.
fancifully used, 166.
may be descriptive or deceptive, 540, *n.* 24.
not made registrable by surrounding geometrical figure, 542, *n.* 24.
not registrable, generally, 541.
not registrable under Act of 1905, 557.
not trademarks because generic, 93.
protected against unfair competition, 149.
secondary meaning, 192.
when protected as trademarks, 192, 160.
when registrable, 541, 562.
who may complain of false use of, 162.
why objectionable as trademarks, 159, 163, 164.

Georgia, Statutes, 657.

References are to pages.

"German" (sweet chocolate), 166, 326.

"German Household Dyes," 326.

"Germania," 326, 535.

"Germea," 326.

Get-up—
property in, 46, 297, 298.

"G. F.," 342.

"Gibraltar" (lamp chimneys), 103.

Glassblowers and Glass-stainers—
goodwill of, 222.

"Glendon" (iron), 103.

"Glenfield" (starch, etc.), 121.

"Gold Dust," 326.

Gold and Silver Ware—
false stamping, 944.

"Gold Label" (bread), 103.

"Gold Medal" (saleratus), 103.

"Golden Crown" (cigars), 121, 327.

"Golden" (ointment), 103.

"Golden Wedding" (whiskey), 121.

"Goliath," 535, *n.* 6.

Good Faith—
as a defense, 295.

Goodwill—
administration of, in partnership estate, 245.
advertising as an element of, 43.
appraisal of, 238.
analogous to trademarks, 229.
as subject to levy and sale, 225.
classes of business having, 221.
competition between vendor and vendee, 239.
conveyance of, by stockholders, 226.
covenant to make valuable, 242.
covenants not to re-engage in business, 233.
damages for impairment of, 246.

References are to pages.

Goodwill—Continued.
defined, 218, 219, 220.
general and local, distinguished, 218, 228.
goes to personal representative, 240.
in bankruptcy, 221.
in relation to firm and corporate names, 229.
inseparable from trademarks, 28, 575.
invasion of, 161.
involuntary alienation of, 226.
jurisdiction of federal courts in cases involving, 252.
local, 227, 229.
mortgage of, 226.
not necessarily included in mortgage of entire assets, 228, *n.* 72.
of foreign corporation, 226.
of learned professions, 224, 241.
of newspaper, 221.
of partnership, 35, 220, 239, 243.
professional, 223.
property in, 220.
remedies of purchaser, 245.
rescission of contract for sale of, 250.
right of vendee to re-assign, 233.
rights of vendor, 230.
sale of, 225.
sale of, on dissolution, 238.
sale of, conveys trademarks without special mention, 28.
subject to eminent domain, 229.
taxation of, 226.
trademarks inseparable from, 68, 161, 575.
trademarks can only be assigned with, 68, 575.
valuation of, 32, 238.
vendee of, enjoined from re-engaging in business, 241.
what words necessary to convey, 227.

"Goodwill, etc."—
defined, 228.

"Goodyear Rubber Co.," 103, 185.

"Gothic," 327.

"Gouraud's Oriental Cream" (cosmetic), 122.

Grade, Style or Quality—
marks of, not registrable, 573.

"Grand Master" (cigars), 122.

"Granite" (kitchen utensils), 104.

References are to pages.

"Granolithic" (artificial stone), 104.

"Granulated Dirt-Killer" (soap), 104.

"Grape-Nuts," 333.

"Greatest Value for the Money" (shoes), 104.

"Green Mountain" (scythe-stones, etc.), 104.

"Grenade" (syrup), 122, 154.

"Grenadine" (syrup), 147.

Groups of Letters—
as trademarks, 340.

"Guaranteed" (corsets), 104.

"Guenther's Best" (flour), 104.

Guilty Knowledge—
need not be proven, when, 299.

"Guinness," 327.

"Gyrator" (bolting machines), 104.

H

"Habana," 492, *n.* 16.

Haberdasher—
goodwill of, 222.

Habit—
of customers is foundation of goodwill, 220.

Hallmarks—
combination of as trademark, 72.

"Hamburg" (tea), 104.

"Hand Grenade" (fire extinguisher), 104.

"Hanford's Chestnut Grove" (whiskey), 122.

"Hansa" (lard, etc.), 122.

Hardware Dealer—
goodwill of, 222.

"Harvard Classics" (books), 122.

"Harvey's Sauce," 104.

References are to pages.

Hawaii—
trademarks in, 609, 611.

"Hazleton Boiler Company" (case), 189.

"Headache Wafers," 104.

"Health Food" (cereal products), 104.

"Health Preserving" (corsets), 104.

"Heliotype" (prints), 122.

"Hermitage" (whiskey), 327.

"Hero" (jars), 122.

"Highly Concentrated Compound Fluid Extract of Buchu," 104.

"Holbrook's" (school apparatus), 104.

"Holeproof" (hosiery), 122, 327.

"Holland House" (case), 356.

"Home" (sewing machines), 122, 327.

"Homeopathic Medicines," 105.

"Honeymoon," 327.

"Hoosier" (drills), 122.

"Hostetter's Bitters"—
infringement by dealing in material for refilling, 313.
infringed by other words, 327.

Hotel Names, 354.

"Howqua's Mixture," 122.

"Humphrey's Homeopathic Specifics," 327.

"Hunter" (shoes, etc.), 122.

"Huntsman's Cherry Brandy," 322.

"Hunyadi" cases, 105, 207, 207, 884.

"Hurricane," 333.

"Hydro-Bromo Soda Mint," 105.

"Hygeia" (water), 123.

"Hygienic" (underwear), 105.

"Hygieniques" (suspenders), 123.

References are to pages.

I

Idaho, Statutes, 661.

"Ideal" (fountain pens), 123.

"Ideas"—
as property, 368.

Idem Sonans—
in proper name cases, 183.

Identity—
of infringing mark, 14, *n.* 21.

Illinois, Statutes and Forms, 664, 668.

Illiteracy of the Consumer, 306.

Illustrations—
of generic terms, 98.
of valid trademarks, 114.

Imitation—
of particulars common to the trade, 300.
of trademarks, 300.
of trademark, may be limited or partial, 300.
the right of, 358.

"Imperial" (beer, etc.), 105, 123.

Importers—
may have trademarks, 63.

Imposition—
on the public, as test of infringement, 305.

Imprint—
effect of omission, 586.

Improper Joinder—
of other causes of action with suits to restrain unfair competition, 405.

"Improved"—
addition of, to mark, no defense, 442.

Inciting Breach, 363.

India—
trademark rights of alien in, 69.

Indiana, Statutes and Forms, 669, 673.

References are to pages.

"Indian Pond" (scythe-stones), 123.

"Indian Root" (pills), 123.

Indian Tribes—
commerce with may be wholly in a single state, 534, *n.* 5.

"Indurated Fibre" (wood-pulp products), 105, 137.

Industry—
symbolized by trademark, 4, *n.* 3.

"In-er-Seal" (bakery products), 123.

Infancy—
not a defense, 441.

Infant—
liable for costs, 490.

Infringer—
liable for whole profit on infringing article, 456.
may recover from person procuring the infringement, 494.

Infringement—
by a non-identical word or mark, 321.
by applying manufacturer's mark to his goods not intended to be so marked, 315.
by counterfeiting, 300.
by goods of equal quality, 337.
by imitation, 300.
by others than defendant, no defense, 443.
by refilling genuine packages, 313.
by solicitation of complainant's agent, 436.
defined, 279.
discontinuance of, no defense to action for damages, 448.
evidence of loss of sales resulting from, 423.
expert evidence as to, 467.
how pleaded, in action at law, 413.
in another jurisdiction, 348.
judicial tests of, 301, 342, 352.
liability of person ordering, to manufacturer, 299.
may be partial, 279, 444.
must be on same class of goods, 307, 310.
of book titles and play titles by motion picture titles, 204.
of catch-words, 151, 344, 469.
of form, size and color, 280, 287.
tested by probability of deception, 301.
tests of, 301, 342, 352.
what participants liable for, 402.
when single instance of, warrants injunction, 437.

References are to pages.

Initials—
as trademarks, 338.

Injunction (see Forms; Interlocutory Decree; Preliminary Injunction)—
against dealers, printers, engravers, etc., 298.
against disclosure of trade secret, 253.
against fraudulent imitation of tin tag, 281
against licensee on breach of condition, 448.
against refilling, 313.
against vendee of goodwill re-engaging in business, 239.
can not issue in suit to which exclusive licensee is not a party, 59.
denied when doubt whether plaintiff's mark generic, 451.
denied when plaintiff guilty of laches, 206.
denied where exclusiveness of plaintiff's right doubtful, 451.
denied where plaintiff's right not exclusive, 452.
denied where plaintiff's right or defendant's infringement doubtful, 451.
enlarging on hearing of contempt proceedings 473.
forms of, 789, 791.
granted against threatened infringement, 448.
granted on *ex parte* affidavits only in clear case, 452.
limited as to territory, 23.
may be granted without costs, 493.
may issue against all persons connected with infringing corporation, 240.
no contempt in violation of, where stayed by appeal, 473.
preliminary, may be reviewed and enlarged on appeal, in federal practice, 465.
preliminary, refused where defendant solvent, and injury may be repaired by money judgment, 451, *n.* 21.
preliminary, weight of former adjudications concerning plaintiff's title, upon, 453, 472, 570.
refused owner of registered mark containing false representation, 546, *n.* 35.
right to, not lost by laches and acquiescence, 208.
value of interlocutory decree in another case, 473.
when warranted by evidence of single infringement, 369, 437, 443.
who liable to, 295.
will lie against registrant by one having prior right, 546, *n.* 35.

Injury—
need not be proven, 448.

Inoperative Defenses (see Defenses)—
that the mark has become indicative of quality through extensive sales, 148.

References are to pages.

Insanity—
not a defense to charge of infringement, 449.

"Insectine" (insect powder), 123.

Inspection—
of books and papers, 472.

Inspection by the Court—
of conflicting marks, 311.

"Instantaneous" (tapioca), 105, 194.

"Insurance" (oil), 123.

Integrity—
symbolized by trademark, 4, *n.* 3.

Intent—
distinction between trademark and other cases as to, 294.
generally, 293.
immaterial in action in equity, 293.
immaterial where no injury done, 294.
of parties as to assignment of trademark, 212.
successive changes of dress as evidence of, 470.

Intention—
actual intention to adopt trademark necessary, 26.

Interference—
appeals, 572.
better title prevails, 544, 571.
between registrant and applicant, 389.
burden of proof upon applicant, 389, 544, 545.
effect of decision, 510, 571.
effect of laches, 572.
may be declared between partner and firm, 544.
nature of issues in, 571.
nature of practice in, 571.
preliminary statement, 389.
registrant under Act of 1870 notified of application under Act of 1881 to register similar mark, 544.
words of like looks and sound, 571.

Interlocutory Decree (see Forms)—
as evidence of right to trademark, 473.
decree may adjudge costs, 495.

Intermittent Use—
will not establish trademark right, 26.

References are to pages.

"International Banking Co.," 105.

International Convention—
for protection of industrial property, 909.
United States a party, 920.

Interrogatories, 486.
form of, 860.

Interrupted Use—
will not create title, 26, 64.

Interstate Commerce—
present federal act relates to trademarks used in, 19.

"Intimidad" (cigars), 144 .

Invention—
name of an unpatented, 136.
trademark not dependent on, 72, 73.

"Invigorator" (spring bed bottoms), 123.

Iowa, Statutes and Forms, 674, 676.

"Iron Bitters," 105.

"Iron Clad" (boots), 123.

"Ironstone" (water pipe), 105.

J

Jeopardy—
of mark by defendant's acts should be pleaded, 394.

"J. H. W." (boots), 342.

"Johnson's American Anodyne" (liniment), 105.

Joinder—
of causes of action, 405.
of parties plaintiff, 399.

Joint Tort-Feasor—
liable for whole damage resulting from tort, 460.
licensor and licensee as, 179.

Judicial Definitions—
of goodwill, 218.
of trademarks, 4.

Judicial Notice, 467.

References are to pages.

Judicial Tests—
of infringement, 342.

"Julienne" (soup), 105.

"Junket Tablets," 123, 327.

Jurisdiction—
infringement in another, 348.
of equity based on right of property in trademark cases, 47.
of equity in matters of trade secret, 255.
of federal courts in cases involving goodwill, 244.
of federal courts in cases of unfair competition, 52, 392, 393.
of federal courts in trademark cases, 391.
of federal courts under Act of 1881, 384.
of federal courts under Act of 1905, 581.
of federal courts in trademark actions between citizens of same state, 52.
of state courts, in trademark cases, 395.
of state and federal courts, concurrent in trademark cases, 395.
where complainant an alien, 547, *n.* 39.

K

"Kaiser" (beer), 69, 105, 124.

Kansas Statutes, 677.

"Katharion" (remedy), 124.

Kentucky Statute and Form, 679.

"Kentucky Club" (whiskey), 106.

"Kentucky's Criterion," 327.

"Keystone" (oil, etc.), 94, 124.

"Keystone Line," 402.

"Kid Nee Kure," 95, 106.

"Kidney and Liver" (bitters), 106.

"King Bee" (smoking tobacco), 124.

"Kitchen Crystal" (soap), 124.

"Knickerbocker" (shoes), 124.

"Koffio" (cereal coffee), 124.

"Kokoko"—
aboriginal, refused registration as trademark for cotton goods, 145.

References are to pages.

L

Label—
as commercial dress, 296.
dealer in, liable for damages, 458.
defined, 521.
designing by court for defendant's direction, 176.
effect of prior use by others, 71.
engraver, liability of, 298.
false, averments of bill to restrain dealing in, 299.
false, manufacture of, 298.
fraudulent intent of manufacturer presumed, where, 299.
if containing false statements invalidates trademark used therewith, 76.
intended to be removed by retail dealer, 344.
new label, abandonment of old, 214.
serves same purpose as trademark, 296.

Label Manufacturer—
liability of, 298.

Laches—
as a defense, 206.
as bar to preliminary injunction, 207.
as bar to relief against unfair competition, 52, 188.
as governed by statute of limitations, 423.
caution notice as evidence, 210.
distinguished from acquiescence, 208, 209.
effect of, in interference, 572.
in secret process cases, 267.
may bar account, 206, 440.
may work abandonment, 148.
no bar to injunction, 206.
none where delay is to secure evidence, 206.
none where plaintiff ignorant of infringement, 206.
rule the same in trademark and other unfair competition cases, 52.

"Lackawanna" (coal), 106.

"La Cronica" (newspaper), 124.

"Lacto-Peptine," 124, 328.

"La Favorita" (flour), 124, 144.

"L'Aiglon" Case, 203.

"Lake" (glass product), 106.

"Lamoille" (scythe-stones), 124.

References are to pages.

"Landlords' Protective Bureau," 328.

"La Norma" (cigar boxes), 124.

"La Normandi" (cigars), 106.

"Lanoline" (patented wool-fat preparation), 137, 207.

Laudatory Adjectives—
as trademarks, 97.

Lectures—
publication of, restrained, 260.

"Leopold" (cloth), 124.

"Leopoldshall," 328.

"Le Page" (glue), 124.

Letters and Numerals—
protected against unfair competition, 339.
whether subject to appropriation as trademark, 4, *n.* 3, 338.

Letters Patent—
compared with trademarks, 17.

Levy and Sale—
on goodwill, 226.
on trade secrets, 263, 264.

Liability—
of all connected with infringement, 295.
of contributory infringer, 405.
of deception, in case of unfair competition, 310.

Libel—
charging trademark infringement, 55.
in trade, 53.

License, 59.
as a defense, 59.
joint, of patent and trademark, 59.
once revoked, no defense to subsequent infringement, 59.
revocable, to use trademark, 59, 155.
to use mark or name for fraudulent purpose, 188.

"Licensed Victuallers" (relish), 124.

Licensee—
estopped to deny validity, 60.
exclusive, must be party to action, 59.
joint tort-feasor with licensor, 179.
may sue for infringement, 59, 399.
territorial, need not be joined as plaintiff, 59.

References are to pages.

Licensor—
necessary party to suit for infringement, 92.

"Liebig's Extract of Meat," 106.

"Lieutenant James' Horse Blister," 106.

Life—
of trademark right, 21.

"Lightning" (hay knives), 125, 328.

"Liliputian Bazaar" Case, 352.

"Limetta," 328.

Limited Use—
effect of, 539, *n.* 16.

"Linoleum," 106, 137.

"Lion" (merchandise), 125.

Liquidated Damages—
in contracts affecting goodwill, 246.

"Listerine" (antiseptic), 125, 328.

Literary Property—
not protected by trademark, 197.

Lithographs—
improper reproduction of, restrained, 259.

"Little Shop," 328.

"Liveroid," 336.

"Liverpool" (cloth), 125.

Livery Stable—
goodwill of, 222.

Local User—
mere, effect of, 23.

Location—
change of, as evidence of fraud, 312.

"Loch Katrine' (whiskey), 106.

Locus Penitentiae—
in dismissal for unclean hands, 447.

"London Dry Gin," 154.

References are to pages.

"London Whiffs" (cigars), 125.

"Lone Jack" (tobacco), 125, 308.

Loss of Sales—
as proof of damages, 423.
how established in cases of infringement, 470.

Louisiana Statutes and Forms, 679, 682.

M

Made-up Words—
as trademarks, 142.

"Magic" (scythe-stones), 125.

"Magnetic Balm" (ointment), 125, 137.

"Magnolia" (whiskey), 39, 125.

"Magnolia" (metal), 106.

Mail-Matter—
protection of, 181, *n.* 38, 352.

Maine Statutes and Forms, 683, 686.

"Maizena" (corn flour), 125.

Malicious Prosecution—
dissolution of injunction on final hearing as ground for action of, 454.

"Malted Milk," 106.

Mandamus—
does not lie to direct action of commissioner on trademark applications, 543, *n.* 28.
to compel issuance of certificate of incorporation, 189.

Manufacture—
trademark need not indicate, 9, *n.* 5, 18, *n.* 33, 158.

Manufactured Articles—
unnecessary resemblances, 292.

Manufacturer—
can not enjoin dealer held out as maker, 159.

Manufacturer of False Labels—
liability of, 296, 298.

"Manufacturers' Outlet Co.," 328.

"Maple Leaf," 336.

References are to pages.

Mark—
common to the trade, 134, 135.

Marking Article "Registered U. S. Patent Office," 387.

Marque de Commerce—
comprehended by our word trademark, 8.

Marque de Fabrique—
comprehended by our work trademark, 7.

Married Woman—
having separate estate, liable for costs, 490.

"Marshall's Celebrated" (liniment), 106.

"Marvel" (mill products), 125.

Maryland Statutes and Forms, 686, 689.

"Maryland Club Rye," 107, 328.

"Masonic" (cigars), 107.

"Masons Patent" (jars), 82.

Massachusetts Statutes and Forms, 689, 695.

Master—
proceedings before, 455.

Master and Servant—
implied contract not to disclose trade secret, 256.

Material—
not registrable as trademark, 538, *note.*

"Matzoon" (fermented milk), 107, 145.

"Mazawattee" (tea), 144.

Meaningless—
trademark must be, 80, *n.* 19.

Measure of Damages—
in action for breach of covenant not to re-engage, 247.
in actions for invasion of goodwill, 245.

"Mechanics Store," 328.

Medals—
of award, fictitious, 312.

"Medicated Mexican Balm" (medicine), 125.

References are to pages.

"Medicated Prunes" (medicine), 107.

"Menlo Park" (watches), 125.

Merchandise—
can not be a trademark, 139.
of substantially the same descriptive properties, 546

"Metallic Clinton" (paint), 107.

Method of Arrangement—
not a trademark, 142, 280.

Method of Display—
deceptive, 48, *note.*

Michigan Statutes and Forms, 696, 700.

"Microbe Killer," 107.

Minnesota Statutes, 700.

"Minnesota Patent" (flour), 10, *n.* 8.

Minor Differences—
of forms and dress, no defense, 344, *n.* 28.

Misbranding—
under Food and Drugs Act, 154.
registration barred by, 560.

Misrepresentation—
as to size of package, when package is ordinary size known to the trade, 445.
collateral, 81, 166.
enjoined whether oral or written, 318.
in connection with plaintiff's goods, 80.
plaintiff's, effect of, 80.
plaintiff's by use of "Patent" or "Patented," 81.
plaintiff's, by use of "trademark," 83.

Mississippi Statutes, 709.

Missouri Statutes and Forms, 710, 718.

Misspelling—
generic word does not make trademark, 95.

Mistake—
in registration by a partner, creates a trust, 399, *n.* 35.
refund of fees paid by, 579.

References are to pages.

Mode of Application—
immaterial, 9, *n.* 6.
must be stated in application for registration, 537.

Mode of Packing—
when protected in equity, 314.

Modern Foreign Languages—
words taken from, as trademarks, 143.

Modification—
in patent office, 568.

"Mojava" (coffee), 126.

"Moline" (plows), 107, 351.

"Momaja," 328.

"Moneys, Stock in Trade, Debts, Effects and Things"—
includes goodwill, 227.

"Monkey"—
not geographical, 165.

Monograms—
as trademarks, 342.

Monopolies—
trademark rights as, 2, 56.

Montana Statutes, 720.

"Montserrat" (lime juice), 107.

"Morse's Compound Syrup of Yellow Dock Root," 329.

Mortgage—
of assets of business does not necessarily include goodwill, 228, *n.* 72.
of goodwill, 226.

Mortgagee—
lien of, upon infringing goods, 404.

Motions—
for injunction, 451.
for particulars, 434.
to dismiss, 432.
to dissolve, 572, 573.
to strike, 436.
to suppress evidence, 574.

Motive—
immaterial, 293.

References are to pages.

"Mottled German Soap," 329.

"Moxie Nerve Food," 329.

"Mount Vernon Rye," 287.

"Mufflet" (neck scarfs), 126.

Musical Organization—
name of, 180.

N

Name (see Proper Names)—
affixed to establishment, 179.
necessary, of a product, 134.
of book, 91.
of celebrity, 170.
of defendant, added to mark, circumstance in his favor, 337.
of patented article, 88.
of patented article, not registrable, 90.
of place of amusement, 179.
of secret preparation, 253.
one's own, 74, 171, 172.

Name of Patented Article—
made *publici juris* by expiration of patent, 88.
protected from unfair competition after expiration of patent, 151.

Names—
Christian, of applicants for registration should be given, 536.
of benefit societies, 190.
of celebrities, 170.
of corporations, 183.
proper, in trade, 172.
right to assume, 171, *n.* 5.

"Napoleon" (cigars), 126.

"National Police Gazette" Case, 199.

"National Sperm" (candles), 107.

"Native Guano" (fertilizer), 107.

Natural Product—
name of, as trademark, 18.

Nebraska Statutes, 721.

Necessary Name—
of product, 138.

References are to pages.

"No Plus Ultra," 143.

Nevada Statutes, 723.

"New Coinage"—
doctrine, 142.

"New Era" (newspaper), 126, 199.

New Hampshire Statutes and Forms, 724, 726.

New Jersey Statutes, 727.

"New Manny" (harvester), 107.

New Mexico Statutes, 737.

Newspaper—
goodwill of, 41.
infringement of name of, 41.

"New York" (glass products), 107.

New York Statutes, 738; form, 756.

"Nick Carter," Case, 205.

"Nickel" (soap), 126.

"Nickel-in" (cigars), 126, 329.

Nick-Names and Their Infringement, 322.

"Nitro," 336.

Nominal Damages—
in actions at law, 421.

Non-Functional Color, 287.

Non-Identical Mark—
infringement by, 321.

Non-Infringement,
defense of, 418.

"Normal," 329.

North Carolina Statutes and Forms, 757, 763.

Nort Dakota Statutes, 764; form, 767.

Notice—
before suit, inadvisable, 438, 490.
defendant not entitled to, 438.
effect of, 53.
want of, no defense, 438.

References are to pages.

Notice of Opposition
form of, 617.
requisites of, 567.

"No-To-Bac" (medicine), 126, 334.

"Nourishing London" (stout), 108.

Numerals—
as trademarks, 338.

O

"O. F. C." (whiskey), 126, 342.

Offer of Submission (see Submission).

Official Brand—
not a trademark, 532.

Officers of Corporations—
when liable for infringement, 403.

Ohio Statutes, 768; forms, 773.

Oklahoma Statutes, 774.

"Old Bourbon" (whiskey), 108.

"Old Country" (soap), 108.

"Old Crow" (whiskey), 126.

"Old Innishowen" (whiskey), 108.

"Old London Dock" (gin), 108.

"Old Mill" (soap), 329.

"Old Pepper" (whiskey), 77, 213.

"Old Sleuth Library" Case, 197.

"Olive" (bicycles), 108.

"Omega Oil" (liniment), 126.

Omnibus—
as instrument of unfair trade, 50.

"One Night Cure," 334.

References are to pages.

One's Own Name—
generally, 35.
gratuitous permission to use, may be withdrawn at will, 209, *n.* 18.
injunction against use of, after assignment, 181.
revocation of license to use, 182.
sale of right to use, 172.

"Only Genuine"—
improperly used by one not having exclusive title, 36.

"Oomoo" (cotton goods), 145.

Opinion Evidence—
as to probability of deception, 348.

"Opportunity of Comparison," 343.

Opposition—
notice, for, 617.
proceedings in, 390, 565, 566, 567, 568, 569, 570, 571.
right of opposer to register, 570.
user by opposer necessary, 569.
what proof admissible, 568.
when maintainable by corporation, 566.

Oral Representations—
of identity, enjoined when false, 318.

Oregon Statutes and Forms, 776, 780.

"Oriental Cream" Case, 108.

"Origin or Ownership"—
generally, 4, *n.* 3, 44.
test of, 157.

"Original"—
use of, after expiration of patent, 151.

Originality—
not a test of trademark right, 17, 70.

"Osborne House" Case, 213.

"Osman" (towels), 127.

"Otaka" (biscuit), 127.

Ownership—
change of, public should be notified of, 29.
joint and several, 58, 139.
need not be indicated in connection with mark, 8.
prerequisite to registration, 532.

"Oxford" (bibles), 127.

References are to pages.

P

Packages—
can not be a trademark, 140, 297.
distinguished from contents, 314.
empty, restraint of competitor from buying, 299.
fraudulent, liability of dealer in, 405.
proof of deception by, 290.
protection in use of, 297.

Packing—
method of, not trademark, 142, 280.

"Pain-Killer" (medicine), 127.

Palming Off—
enjoined, 42.

"Pancoast," 329.

"Parabola" (needles), **127.**

"Paraffin" (oil), 108.

"Paragon," 329.

"Parcheesi" (game), 108.

"Paris" (garters), 127.

"Parson's Purgative" (pills), 108.

Parties Defendant, 295.

Parties Plaintiff—
must include exclusive licensee, 59, 399.
where trademark is incident to realty, 400.
who may be, 167.

Partner—
when trustee of mark for firms' benefit, 399, *n.* 35.

Partnership—
administration of partnership estate, 34.
agreements upon dissolution, 234, *n.* 97.
effect of retirement of one partner, 35.
goodwill of, 35.
injunction by withdrawing partner against use of firm name, 245.
name must not import incorporation (in Illinois), 189.
one not a partner can not secure registration of mark, 540, *n.* 19.
rights of partners in trademarks on dissolution, 58, 243.
sale of goodwill on dissolution conveys trademarks without special mention, 32.
trademarks of individuals merged in partnership property, 34.

References are to pages.

Partnership Names, 74.

"Passing Off"—
the English equivalent of unfair competition, 2.

Patent—
action for infringement of:
improperly joined with charge of unfair competition, 430, *n.* 22.
properly joined with charge of trademark infringement, 405.
compared with trademarks, 2.
effect of expiration, 87, 88, *et seq.*, 570.
effect of unsuccessful application for, 92.

Patent Office Rules (see Trademark Rules of Patent Office), 588.

Patented Article—
dress of, protected after expiration of patent, 87.
registration refused name of or mark for, 90.
trademark right in name applied to, 88.
trademark right in name applied to, not abandoned during life of patent, 92.
unfair trade in, 52.

"Patent," "Patented," "Patentee"—
unauthorized use of words, 81, 84, 437.

Patentee—
right to use name of, 181.

"Patent Plumbago Crucibles," 82.

"Patent Solid-Headed Pins," 85.

"Patent Thread," 86.

"Pectorine" (medicine), 127.

Penal Laws (see Names of the Several States).

Pending—
in Act of 1905, meaning, 584.

Pennsylvania Statutes and Forms, 782, 785.

"Pepko," 336.

"Pepto-Mangan" (medicine), 127, 144.

"Perfect Face Paste," 108.

"Perfection" (mattresses), 127.

References are to pages.

Periodical—
infringement of name of, 198, 199, 200.
titles of, as trademarks, 41, 198, 200.

Perpetual Existence of Trademarks, 21.

"Persian" (thread), 127.

Personal Representative—
goodwill goes to, 240.

"Pessendede" (watches), 147.

"Philadelphia" (beer), 109.

Philippines—
protection of registered trademarks in, 609, 611.

Phonograph Records—
imitation of, 282.

Photographs—
improper reproduction of, restrained, 259, 273.

Pictures—
as trademarks, 141.
common to the trade, 135, *n.* 52, 141.
descriptive, not a trademark, 141.

Physician—
goodwill of, 223.

"Pigs in Clover" (puzzle), 127.

"Pile Leclancha," 451.

Places of Amusement—
names of, 179.

Play Title as Trademark, 202.

Plea—
can not reach defects upon face of bill, 441.
in avoidance of discovery, 472.

Pleading—
in the action at law, 349.
jurisdictional facts in proceedings in federal courts, 391.
tendency of mark to deceive, 398.

Plurality of Marks for Single Article, 350.

References are to pages.

"Pocahontas" (coal), 109.

"Porous" (plasters), 109.

"Portland" (stoves), 127, 329.

Porto Rico—
protection of registered trademarks, 609, 611.

Portrait—
of owner, effect on assignability, 29, *note.*
unauthorized publication of, 259, 271, 272.

Postcard—
illustrated, as trademark, 140.

"Post Office" (directory), 109.

Prayer for Relief—
in bill in equity, 430.

Preliminary Injunction (see Injunction, Preliminary)—
appeal from order granting, 465
denied because of laches, 207.
not granted on *ex parte* affidavits except in a clear case, 452.

"Premises, Stock in Trade, etc."—
goodwill not included in, 227.

Presumptions—
as to carelessness of consuming purchaser, 343.
none in favor of federal jurisdiction, 391.

"Pride" (cigars), 127.

"Pride of Rome," 329.

"Prime Leaf" (lard), 109.

Primitive Merchandise Marks, 1.

Principal—
liable for infringement by agent, 404.

Prints and Labels (see Forms; Statutes, Prints and Labels)—
adverse decision, appeal from, 521.
advertisement, when considered a print, 521.
appeal to commissioner, 521.
application, 519.
for renewal, 522.
requisites of, 519.

References are to pages.

Prints and Labels (see Forms; Statutes, Prints and Labels)—
Continued.
articles of manufacture, definition of the words, 516.
assignment of, 522.
certificate of registration, 521.
renewal of, 522.
signature to, etc., 521.
commissioner, appeal to, 521.
copies of print or label, filing of, 519.
decisions pertaining to registry of labels, 515.
duration of term of registration, 521.
examiner, appeal from decision of, 521.
fees, 522.
label, definition of the words, 521.
pertinence to the article of manufacture required in prints, 521.
print, definition of the word, 521.
proprietor or agent should sign the application, 519.
renewal of certificate of registration, 522.
term of registration, 521.

Printer—
of fraudulent labels, 298.
proof of intent of, 299.

Printing—
as means of fraud, 152.

Priority of Appropriation—
generally, 69.

Prior Right—
burden of proving, 213, *n.* 48.

Prior Use—
controls even as against registrant, 546, *n.* 35.
no defense, unless on same class, 72.
void because accompanied by false representations, no defense, 443.

Privacy—
right of, 267.

Private Letters—
publication of, restrained, 260.

"Prize Medal," 109.

Probability of Deception—
as test of infringement, 301.
in unfair competition cases, 301.

References are to pages.

Process—
secret, 253, 265.

Producer—
trademark need not indicate, 158.

Product—
necessary name of, 136.

Profits—
and damages may be recovered in equity, 366, 429.
made by sale of infringing article may be recovered, 429.
plaintiff not limited to profits due to use of mark, 383.

Promoter—
unfair competition of, **181.**

Proof of Fraud—
in other cases, 51.
in trademark cases, **51.**

Proper Name—
assignment of, can not be re-assigned, 244, *n.* 37.
can not be assigned for fraudulent use in competition, 73, 188.
can not be technical trademark, 168.
could not be registered under Act of March 3, 1881, 542.
defendant using his own in good faith, 174.
defendant using in manner calculated to deceive, 177.
fictitious, does not disentitle to relief in equity, 182.
how conveyed, 74.
not trademarks because generic, 94.
of celebrity, 170.
of first owner of mark being included in mark does not render it unassignable, 29.
registration of, under Act of 1905, 549.
secondary meaning, 168.
the right to assume, 171.
the use of one's own name, 35, 178.

"Property, Credits and Effects"—
goodwill not included in, 227.

Protection—
relative, of patents and trademarks, 16.

Publication—
effect of, 567.

Public Policy—
as to contracts involving title, 58.
as to covenants not to re-engage, 235.

References are to pages.

Publici Juris—
extensive sale does not render mark, 134.
test of whether word has become, 149.
that mark has become, as a defense, 134.
words may become, by laches, 148.

"Puddine," 127, 334.

Puffing—
harmless misrepresentation, 445.

Punitive Damages—
allowed where no actual damage proven, 421, ***note.***
can not be assessed in equity, 460.
in actions at law, 419.

Purchaser—
degree of care of, 304.
presumptions as to care of, 303.

Pure Food Law—
distinctive names, 154.
misbranding under, 154.
tradename as defense to violation of, 80.

"Purity" (oleomargarine), 109.

Q

Quack Medicines—
trademarks applied to, are not protected, 228, 254.

Quality—
defined, 132.
(inferiority or superiority) of infringing goods immaterial, 338.
not indicated by trademark, 20.

"Queen" (shoes), 127, 194.

"Queen Quality" (shoes), 127, 194.

R

"Radium" (silk), 128.

"Raleigh," 160.

"Ranier" (beer), 128.

Real-Estate Dealer—
mark used by, not a trademark, 532, *n.* 3.

"Red Cross"—
Act of January 5, 1906, 922.

References are to pages.

"Red Cross Plaster," 323.

"Red" (snuff), 109.

Referee—
reluctance to disturb findings of, in competent cases, 474.

Reference—
for accounting, 454.

Refilling—
burden of proof in cases of, 315.
enjoined even when done at the customer's request, 313.
packages with spurious goods, 313.

Refitting—
trademarked articles, 315.

Refund—
of Patent Office fees, 579.

"Registered Trademark"—
falsely imprinting, 86.

Registration (see Forms; Statutes; Trademark Rules of Patent Office)—
action to compel, 574.
advantages of, 384.
application for, 553.
a prerequisite to trademark right under English statute, 20.
as evidence of extent of registrant's claim, 386.
by aliens, 503, *n.* 7, 549, 590.
by one partner through mistake, 399, *n.* 35.
can not validate mark otherwise invalid, 66.
certificate will issue to assignee, 575.
citizenship of applicant immaterial, 549.
class of goods must be stated, 549.
constitutionality of Act of 1905, 379.
date of adoption stated in application not conclusive, 389.
defense that it does not make valid trademark of mark common to the trade, 417.
description of essential features, 537, *n.* 13.
disadvantages of, 386.
does not preclude third party, 546, *n.* 35.
doubts as to similarity resolved against applicant, 540, *n.* 20, 563.
effect given by state courts, 565.
features of mark not included in, abandoned, 386.
federal, advantages of, 384.
fraudulent, effect of, 67.
function of commissioner in applications for, as to title, 543, *n.* 27.

References are to pages.

Registration (see Forms; Statutes; Trademark Rules of Patent Office)—Continued.
granted only for class in which mark is actually used, 537, *n.* 12.
granted only to valid trademarks, 532, *n.* 1.
in color, 287.
invalid federal statutes, 378.
is record of adoption of trademark, 384.
jurisdiction of congress concerning, 379.
limits registrant to matter claimed, 386.
mode of application must be stated, 538, *n.* 15.
must be pleaded, 415.
no institution of suit for trademark infringement without, under English act, 378.
not a grant of right or privilege, 385.
not a means of acquiring trademark, 19, 65, 539, *n.* 16.
not conclusive as to right to trademark, 546, *n.* 35.
not granted for use on "fancy goods," 537, *n.* 12.
of corporate names, 542, *n.* 25.
of defendant's mark, not a defense, 440.
of geographical words, 562.
of mark common to trade, 546, *n.* 35.
of mark of voluntary association of manufacturers, refused, 507, 533.
of name of celebrity, 274, *n.* 89.
of name of or mark for patented article, refused, 533.
of partnership mark, granted only on application of partner, 540, *note.*
of proper name does not create trademark right, 66.
of trademark, does not cure objection of its being colorable imitation of another mark, 385.
only prima facie evidence of ownership, 385, *n.* 16.
ownership a prerequisite, 532, *n.* 4.
pleading, form of, 852.
prima facie evidence of ownership, 385, *n.* 16.
refused coat-of-arms of the United States, 493.
refused descriptive words reproduced in letters from foreign language, 147.
refused form, material and color, 508.
refused generic words, 506.
refused geographical names, 541, *n.* 24.
refused name of patented article, 90.
refused picture and word not true alternatives, 540, *n.* 22.
refused proper and geographical names joined, 542, *n.* 25.
remedies conferred by, 67.
right to, not concluded by registrability in foreign country, 535, *n.* 6.
state (see statutes of the several states), 66.
the valid federal statutes (see Acts of 1881 and 1905, in Appendix).
under Act of 1870 was equivalent to public use, 64.

References are to pages.

Registration (see Forms; Statutes; Trademark Rules of Patent Office)—Continued.
under English statute constructive user of trademark, 63.
use of fac-similes, in, 538, 549.
validity of present federal statute, 379.
value of, 384, 535, *n.* 7.
when refused, fee not refunded, 539, *n.* 17.

Reissue of Patent—
extends life of trademark applied to patented article, 93.

Relative Protection Given by Patents and Trademarks, 16.

Relief—
in equity 451.

Religious Order—
trademarks of, 69.

"Remington," 66, *n.* 24.

Removal of Business—
notice of, as unfair competition, 312.
to plaintiff's locality, as proof of fraud, 312.

Renewal Privilege Under Act of 1905, 21, 576.

Repair Parts, 315.
sale of, under name of manufacturer of machine to be repaired, 358.

Replacement—
of parts of trademarked articles, 315.

Republication—
when ordered, 567.

Res Adjudicata—
effect of, 488.
how proven, 488.
in opposition proceedings, 570.
none created by decision of court of foreign country, 449.

Rescission—
of contract for sale of goodwill, for vendor's fraud, 250.

Resemblance—
inspection by court as test of, 300, 342.
may establish right to injunction, 294.
need not be such as to deceive purchasers having opportunity of comparison, 342.
unnecessary, 292.

References are to pages.

Restaurants—
names of protected, 354.

Restraint of Trade—
combination in, 235.
contract relating to trade secret is not in, 253.
in sale of goodwill, 235.
in sale of right to use proper name, 179.

Retail Dealer—
costs may not be imposed against, 493, n. 20.

Revocation of License to Use Name, 182.

Revival—
of action against deceased infringer's representative, 400.

Rhode Island Statutes and Forms, 786, 790.

"Richardson's Patent Union" (machine), 109.

Right of Privacy, 267.
New York statute, 278.

Right to Imitate, 291, 358.

"Rising Sun" (stove polish), 128.

"Roachsault," 95, 128.

"Robert's Parabola Gold-Burnished Sharps," 330.

"Roger Williams" (cloth), 128, 170.

"Rogers," 330.

"Rose" (vanilla extract), 109.

"Rosebud" (canned salmon), 128.

"Rosendale" (cement), 110.

"Rough on Rats," 335.

"Royal" (baking powder), 128.

"Royal Blue" (carpet sweeper), 128.

"Roy Watch Case Co.," 330.

Royalties on Articles Made by Secret Process, 264.

"R. P. Hall," as Trademark, 173.

"Rubberset" (brushes), 110, 330.

"Ruberoid" (roofing), 110, 330.

"Rye and Rock" (liquor), 110.

References are to pages.

S

"Safety" (powder), 110.

"Sagafoam," 336.

Sale—
of business, conveys trademarks used therein, 27.
of trademarks, 27.

Sales—
diminution of, as evidence of damage, 423.
evidence of extent of, 470.
extensive, does not destroy trademark, 191.

Saloon—
goodwill of, 222.

"Sanitary" (filter), 110.

"Sanitas," 143, 330.

"Sapolio" (scouring brick), 128, 330.

"Saponifier" (concentrated lye), 128.

"Sappota Tolu," 334.

"Sarsaparilla and Iron" 110.

"Satinine" (starch and soap), 110.

"Satin Polish" (boots and shoes), 110.

"Satin Skin," 336.

"Sawyer's Crystal Blue and Safety Box," 330.

"S. B.," 334.

"Schiedam Schnapps," 110.

Scienter, 293.

Scope—
comparative, of trademarks and tradenames, 14.

Scotland—
trademark rights of alien in, 69.

Search Warrants—
under Act of 1876, 531, *n.* 1.
under local statutes (see statutes of the several states).

References are to pages.

Secondary Meaning, 190.
defined, 190.
doctrine applied to tradenames, 14, 190.
how proven, 153.
of proper names, 169.

Secret—
in trade, 253.

Secret Preparation—
name of, as trademark, 265.

Secret Process, 38.
assignability of, 38.
trademarks on product of, 265.

Section 3449, R. S. U. S., 408.

"Selected Shore" (mackerel), 110.

Selectors—
of merchandise, may have trademarks, 61.

"Sefton" (cloth), 129.

"Self-Washer" (soap), 151.

Servant—
liable for infringement, 403.

Shape—
infringement of, restrained, 287.

"Shawknit" (stockings), 129, 330.

"Sherlock Holmes" Case, 204.

Sherman Anti-Trust Act, 375.
claim for damages under, can not be joined with bill to restrain unfair competition, 430, *n.* 22.

Show-Card—
as trademark, 9, *n.* 6.

"Shrewsbury, Marshall & Co. Patent Thread," 331.

Signs—
fraudulent, when enjoined, 319.

"Silver Grove" (whiskey), 129.

Silver Ware—
false stamping, 946.

References are to pages.

"Similarity"—
degree of, 50.

"Simplex," 331.

"Singer" (sewing machines), 111, 137.

Single Sale—
when sufficient to secure injunction, 369, *n.* 13, 437, 443, ***n.* 71.**

"Sir J. Clark's Consumption Pills," 436.

"Six Little Tailors," 129, 331.

Size—
imitation of, restrained 290.
no trademark in, 287.

Skill—
symbolized by trademark, 4, ***n.* 3.**

Slander—
in trade, 53.
of title to trademark, 55.

"Slate Roofing" (paint), 129.

"Sliced Animals" (toys), 129.

"Snowflake" (crackers), 111.

"Social Register" (directory), 129, 335.

"Sole Manufacturer"—
as bar to relief, 78.

"Sole Proprietor"—
use of words enjoined, 401.

Solicitation—
of former customers, 359.

"Somatose" (meat extract), 111, 143.

South Carolina Statutes, 791; form, 794.

South Dakota Statutes, 795; form, 800.

"Southern Company, St. Louis," 331.

"Sorosis," 331.

"Spearmint" (gum), 111.

Specific Performance—
of contract for sale of goodwill, 225.

References are to pages.

Specimens—
investigation, 552, 593.

"Splendid" (flour), 111.

"Standard A" (cigars), 111.

Stage Line—
goodwill of, 222.

"Star" (tobacco, etc.), 111, 129.

"Stark," 331.

State Penal Laws, 411.

State Registration—
advantages of, 395.

State Statutes (see Statutes, State).

Statute of Frauds—
agreement not to engage in rival business does not come within, 233.

Statute of Limitations—
in case of laches, 209.

Statutes, Federal: Act of 1870, 501.

Statutes, Federal: Act of 1876, 528.

Statutes, Federal: Act of March 3, 1881, 532.
action:
by commissioner on application (sec. 3), 540
for damages (secs. 7, 9), 545, 546.
for an injunction (sec. 7), 545.
jurisdiction of United States courts in an (sec. 7), 545.
when barred (sec. 8), 546.
appellate jurisdiction of United States courts (sec. 7), 545.
applicant:
citizenship of, to be recited (sec. 1), 532.
domicile of, to be recited (sec. 1), 532.
name of, not registrable (sec. 3), 540.
name of, to be specified in the application (sec. 1), 532.
statement of, to recite what (sec. 1), 532.
application:
action on same by the commissioner (sec. 3), 540.
conflicting with another (sec. 3), 540.
length of time of use of mark, to be recited in (sec. 1), 532.
must be accompanied by a written declaration (sec. 2), 540.
must recite what (sec. 1), 532.
time of receipt of, to be recorded (sec. 3), 540.

References are to pages.

Statutes, Federal: Act of March 3, 1881—Continued.
article:
if injurious, an action for damages or injunction is barred (sec. 8), 546.
not manufactured in this country, term of registration for (sec. 5), 545.
assignment, commissioner to prescribe forms and rules for (sec. 12), 547.
bars:
to an action for damages or injunction (secs. 8, 11), 546, 547.
to registration (secs. 1, 2, 3), 532, 540.
business, if unlawful, bars an action for damages or injunction, (sec. 8), 546.
certificates of registration:
how and when issued (secs. 4, 13), 544, 548.
use of same in courts as evidence (sec. 4), 544.
citizenship of applicant:
as affecting the right to register (sec. 1), 532.
to be specified in the application (sec. 1), 532.
claim, presumptive lawfulness of, to be decided by the commissioner (sec. 3), 540.
class of merchandise to be recited in the application (sec. 1), 532.
commerce with foreign nations or Indian tribes, use of trademark in, necessary to registration (secs. 1, 2, 3), 532, 540.
commissioner:
action on application (sec. 3), 540.
to decide presumptive lawfulness of claim (sec. 3), 540.
to prescribe regulations for registration (sec. 1), 532.
to prescribe rules and forms for assignments and transfers, (sec. 12), 547.
to sign certificates of registration (sec. 4), 544.
common law and equitable rights:
not abridged by expiration of term of certificate (sec. 11), 547.
not abridged by statute (sec. 10), 547.
compensation, registrant aggrieved may recover (sec. 7), 545.
conflicting applications (sec. 3), 540.
convention with a foreign power as conferring the right to register (sec. 3), 540.
confusion of the public mind by similarity of marks bars registration (sec. 3), 540.
copies:
of printed specifications to be kept on record (sec. 4), 544.
under official seal to be evidence (sec. 4), 544.
copying and using registered trademark, damages for (sec. 7), 545.
counterfeiting, damages for (sec. 7), 545.

References are to pages.

Statutes, Federal: Act of March 3, 1881—Continued.
courts of equity, practice to be followed in office action on conflicting applications (sec. 3), 540.
courts of the United States, jurisdiction of (sec. 7), 545.
damages:
action for, when barred (sec. 8), 546.
for affixing fraudulent trademark to merchandise (sec. 7), 545.
for false or fraudulent registration (sec. 9), 546.
for wrongful use of registered trademark (sec. 7), 545.
deceit of the public:
action to defend trademark so used, not maintainable (sec. 8), 546.
by similarities in marks, bars registration (secs. 2, 3), 540.
declaration:
must be in writing (sec. 2), 540.
must be verified by whom (sec. 2), 540.
must contain what (sec. 2), 540.
when false or fraudulent damages for (sec. 9), 546.
with a foreign power, as conferring the right to register (sec. 3), 540.
description:
must truly represent the mark (sec. 2), 540.
of the goods required (sec. 1), 532.
of the mark required (sec. 1), 532.
domicile of applicant must be recited in the application (sec. 1), 532.
duration of certificate (sec. 5), 545.
equitable rights not affected by statute, or expiration of term (secs. 10, 11), 547.
equity:
aggrieved registrant may resort to (sec. 7), 543.
courts of, practice followed in interference cases (sec. 3), 540.
evidence:
copies under seal to be received as (sec. 4), 544.
of ownership, registration to be *prima facie* (sec. 7), 545.
of registry (sec. 4), 544.
expiration of term of certificate does not abridge common-law or equitable rights (sec. 11), 547.
fac-similes:
of trademarks to be filed (sec. 1), 532.
presented, must truly represent the mark (sec. 2), 540.
false registration, damages for (sec. 9), 546.
fees:
for registry, and how payable (sec. 1), 532.
formerly paid with intent to procure registration (sec. 6), 545.
foreign countries, residents of may register when (secs. 1, 3), 532, 540.

References are to pages.

Statutes, Federal: Act of March 3, 1881—Continued.
foreign nations or Indian tribes, trademarks used in commerce with, alone registrable (secs. 1, 2, 3), 532, 540.
foreign power convention with, as conferring right of registration (sec. 3), 540.
former rights and remedies preserved (sec. 10), 547.
forms for assignments to be prescribed by commissioner (sec. 12), 547.
fraud in obtaining registration bars an action (sec. 8), 546.
fraudulent:
declaration and registration, damages for (sec. 9), 546.
trademark, damages for affixing same to merchandise (sec. 7), 545.
goods, particular description of same, to be recited (sec. 1), 532.
identity with other trademarks, bars registration when (secs. 2, 3), 540.
imitation of registered trademark, penalty for (sec. 7), 545.
Indian tribes or foreign nations, trademarks used in commerce with, alone registrable (secs. 1, 2, 3), 532, 540.
infringement, remedy for (sec. 7), 545.
injunction:
action for, when barred (sec. 8), 546.
against the wrongful use of a registered trademark (sec. 7), 545.
interference practice, to follow the rules of United States courts of equity (sec. 3), 540.
issue of certificates of registration (sec. 4), 544.
jurisdiction, original and appellate, of United States courts (sec. 7), 545.
lawfulness of claim to trademark to be decided by commissioner (sec. 3), 540.
length of time of use of mark to be recited (sec. 1), 532.
location of applicant to be specified (sec. 1), 532.
manufacture of articles abroad, registration for (sec. 5), 545.
merchandise, class of to be recited (sec. 1), 532.
mistake or confusion in the public mind, caused by similarity of trademarks, bars registration (sec. 3), 540.
mode of affixing, to be recited (sec. 1), 532.
name of applicant:
not registrable (sec. 3), 540.
to be specified in the application (sec. 1), 532.
oath to declaration, how and by whom made (sec. 2), 540.
ownership, registration to be *prima facie* evidence of (sec. 7), 545.
penalty:
for false or fraudulent registration (sec. 9), 546.
for imitation of trademark (sec. 7), 545.
printed copies of specification to be kept of record (sec. 4), 544.
receipt of application, time of to be recorded (sec. 3), 540.

References are to pages.

Statutes, Federal: Act of March 3, 1881—Continued.
recording:
of time of receipt of application (sec. 3), 540.
of transfers of right of use (sec. 12), 547.
records of trademarks, statements, declarations, etc., to be kept (sec. 4), 544.
registration:
as a condition precedent to registration abroad (sec. 13), 548.
authorized when (sec. 1), 532.
bars to (secs. 1, 2, 3), 532, 540.
by residents of foreign countries (secs. 1, 3), 532, 540.
certificates of, how and when issued (secs. 4, 13), 544, 548.
certificates of use of same in courts as evidence (sec. 4), 544.
expiration of term of, does not abridge common-law or equitable rights (sec. 11), 547.
fee for (secs. 1, 6), 532, 545.
how effected (sec. 1), 532.
marks are registrable (sec. 5), 540.
obtained by false or fraudulent representations, damages for (sec. 9), 546.
records of, to be kept (sec. 4), 544.
renewal of, can be made when (sec. 5), 545.
restricted to marks used in foreign or Indian commerce (secs. 1, 2, 3), 532, 540.
right to, as affected by citizenship of applicant (sec. 1), 532.
right to, as conferred by treaty convention, or declaration with a foreign power (sec. 3), 540.
right of action secured thereby (sec. 7), 545.
rules for, to be prescribed by the commissioner (sec. 1), 532.
to be *prima facie* evidence of ownership (sec. 7), 545.
use in foreign and Indian commerce a prerequisite to (secs. 1, 2, 3), 532, 540.
regulations and rules to be prescribed by the commissioner (secs. 1, 12), 532, 547.
remedy for infringement (sec. 7), 545.
renewal of registration (sec. 5), 545.
reproduction and use of registered trademark, penalty for (sec. 7), 545.
resemblance to other marks must be avoided (secs. 2, 3), 540.
restrictions:
on actions for damages or an injunction (sec. 8), 546.
on actions for infringement (secs. 8, 11), 546, 547.
on registration (secs. 1, 2, 3), 532, 540.
right to use the mark must belong exclusively to the applicant (sec. 2), 540.

References are to pages.

Statutes, Federal: Act of March 3, 1881—Continued.
rights at common law and equity not abridged:
by expiration of the term of registration (sec. 11), 547.
by the enactment of the statute (sec. 10), 547.
rules and regulations, to be prescribed by the commissioner (secs. 11, 12), 547.
similarity to other marks bars registration, when (secs. 1, 12), 532, 547.
specifications, printed copies of, to be kept of record (sec. 4), 544.
statement of applicant:
to recite what (sec. 1), 532.
recording of (sec. 4), 544.
terms of registration:
duration of (sec. 5), 545.
expiration of, does not abridge common-law or equitable rights (sec. 10), 547.
limitation of (sec. 5), 545.
renewal of (sec. 5), 545.
time of receipt of application to be recorded (sec. 3), 540.
of use to be recited (sec. 1), 532.
transfers of the right of use, how regulated (sec. 12), 547.
treasury department, deposit of trademark in, 609.
treaties as conferring the right of registration (sec. 3), 540.
United States:
citizens of, may obtain registration (sec. 3), 540.
courts of, to have jurisdiction, when (sec. 7), 545.
use:
if an unlawful business, bars an action (sec. 8), 546.
if wrongful, common-law and equitable rights unimpaired (sec. 10), 547.
if wrongful or unlawful, bars registration (sec. 3), 540.
length of time of, to be recited (sec. 1), 532.
right of, must be exclusive in the applicant (sec. 2), 540.
right of, transfers of (sec. 12), 547.
unlawful, of trademark, damages or injunction (sec. 7), 545.
verification of declaration, how and by whom made (sec. 2), 540.

Statutes, Federal: Act of February 20, 1905, 549.
abandoned trademarks, action may not be brought on (sec. 21), 583.
action:
by commissioner on application (sec. 6), 565.
for damages (secs. 16, 19, 25), 579, 581, 585.
for an injunction (sec. 19), 581.
jurisdiction of United States courts in an (secs. 17, 18, 19, 20), 581, 582.
when barred (secs. 21, 28), 583, 586.
Act of 1881, rights of registrants under (secs. 12, 30), 576, 587.

References are to pages.

Statutes, Federal: Act of February 20, 1905—Continued.
"affixed" defined (sec. 29), 586.
amendments to applications filed under Act of 1881 (secs. 14, 24), 578, 584.
appeals:
fees for (secs. 8, 14), 573, 578.
to the commissioner of patents (secs. 7, 8, 13), 570, 573, 576.
to the court of appeals of the District of Columbia (sec. 9), 574.
patent practice and procedure to govern (sec. 9), 574.
appellate jurisdiction of United States courts (sec. 17), 581.
applicant:
"applicants" defined (sec. 29), 586.
citizenship of, to be recited (sec. 1), 549.
domicile of, to be recited (sec. 1), 549.
location of, to be recited (sec. 1), 549.
name of, to be recited (sec. 1), 549.
statement of, to recite what (sec. 1), 549.
who may apply for registration (sec. 1), 549.
applications:
action on same by the commissioner (sec. 6), 565.
conflicting (sec. 7), 570.
date of, in foreign country must be stated when (sec. 2), 554.
examination of (sec. 6), 565.
fees on filing (secs. 1, 14), 549, 578.
filed under the Act of 1881 may be amended (secs. 14, 24), 578, 584.
length of time of use of mark to be recited in (sec. 1), 549.
may be assigned (sec. 10), 574.
must be addressed to the commissioner of patents (sec. 1), 549.
must be accompanied by a drawing (sec. 1), 549.
must be accompanied by a written declaration (sec. 2), 554.
must be accompanied by specimens of the trademark (sec. 1), 549.
must be filed in the patent office (sec. 1), 549.
must be in writing (sec. 1), 549.
must be signed by the applicant (sec. 1), 549.
must recite what (sec. 1), 549.
must state how trademark is applied or affixed to the goods (sec. 1), 549.
article, if injurious, an action for damages or injunction is barred (sec. 21), 583.
assignments:
applications for registration may be assigned (sec. 10), 574.
fees for recording (sec. 10), 574.
must be acknowledged according to laws of country or state in which executed (sec. 10), 574.

References are to pages.

Statutes, Federal: Act of February 20, 1905—Continued.
assignments:—continued.
must be in connection with the goodwill of the business (sec. 10), 574.
must be in writing (sec. 10), 574.
record of assignments to be kept in the patent office (sec. 10), 574.
shall be void unless recorded in the patent office within three months (sec. 10), 574.
trademarks may be assigned (sec. 10), 574.
bars:
to action for damages or injunction (secs. 21, 28), 583, 586.
to registration (secs. 1, 2, 4, 5), 549, 554, 556.
business, if unlawful, bars an action for damages or injunction (sec. 21), 583.
cancellation, proceedings for (secs. 13, 22), 576, 583.
certificates of registration:
in case of foreign registration, shall cease when the foreign registration expires (sec. 12), 576.
issued under the Act of 1881, may be renewed under the Act of February 20, 1905 (sec. 12), 576.
issued under the Act of 1881, shall remain in force (secs. 12, 30), 576, 587.
may be cancelled (secs. 13, 22), 576, 583.
may be issued to the assignee (sec. 11), 575.
may be renewed (sec. 12), 576.
shall bear the seal of the patent office (sec. 11), 575.
shall be signed by the commissioner of patents (sec. 11), 575.
shall not be issued to foreign applicants until they have obtained registration in country of residence (sec. 4), 556.
shall remain in force not more than 20 years (sec. 12), 576.
shall state date of application (sec. 11), 575.
use of copies of in court as evidence (sec. 11), 575.
citizenship:
as affecting right to register (sec. 1), 549.
of applicant to be recited (sec. 1), 549.
class of merchandise to be recited in application (sec. 1), 549.
coats of arms not registrable (sec. 5), 556.
commerce:
between states (sec. 1), 549.
foreign applicants need not state that the trademark has been used in commerce with the United States or among the states thereof (sec. 2), 554.
with foreign nations (sec. 1), 549.
with Indian tribes (sec. 1), 549.
commissioner:
action on application (sec. 6), 565.

References are to pages.

Statutes, Federal: Act of February 20, 1905—Continued.
commissioner:—continued.
appeals to (sec. 8), 573.
jurisdiction of, to cancel registrations (secs. 13, 22), 576, 583.
may refuse to register interfering marks, when (sec. 7), 570.
to decide presumptive lawfulness of claim (sec. 6), 565.
to prescribe regulations for registration (sec. 26), 585.
to sign the certificates of registration (sec. 11), 575.
common-law and equitable rights not abridged by statute (sec. 23), 584.
conflicting applications (sec. 7), 570.
confusion of the public mind by similarity of marks bars registration (sec. 5), 556.
constitutionality of, 379.
contempt, action for violating injunction (sec. 20), 582.
convention with a foreign power as conferring the right to register (secs. 1, 4), 549, 556.
copies:
of actual trademark or *fac-similes* required from applicant (sec. 1), 549.
of printed specifications to be kept of record (sec. 11), 575.
of records of injunction proceedings furnished to courts applying for same (sec. 20), 582.
of publications, prices (sec. 14), 578.
of records under official seal to be evidence (sec. 11), 575.
copying and using registered trademarks:
damages for (secs. 16, 19), 579, 581.
restraint of (sec. 19), 581.
counterfeiting, damages for (sec. 16), 579.
courts of the United States, jurisdiction of (secs. 16, 17, 18, 19), 579, 581.
damages:
action for, when barred (secs. 21, 28), 583, 586.
for affixing fraudulent trademark to merchandise (sec. 16), 579.
for false or fraudulent registration (sec. 25), 585.
for wrongful use of registered trademarks (secs. 16, 19), 579, 581.
may be increased (secs. 16, 19), 579, 581.
deceit of the public:
action to defend trademark used in, not maintainable (sec. 21), 583.
by similarity in marks, bars registration (sec. 5), 556.
deceptive trademarks, action under, may not be brought (sec. 21), 583.
declaration:
may be verified, before whom (sec. 2), 554.
must be in writing (sec. 2), 554.
must be verified, by whom (sec. 2), 554.

References are to pages.

Statutes, Federal: Act of February 20, 1905—Continued.
declaration:—continued.
must contain what (sec. 2), 554.
for foreign applicants (sec. 2), 554.
under ten-year proviso (sec. 5), 556.
when, false or fraudulent, damages for (sec. 25), 585.
definitions of "affixed," "applicant," "owner," "person," "registrant," "states," "trademark," "United States" (sec. 29), 586.
description:
must truly describe the mark (sec. 2), 554.
of the goods required (sec. 1), 549.
of the mark required (sec. 1), 549.
descriptive trademarks, not registrable (sec. 5), 556.
destruction of infringing trademarks (sec. 20), 582.
domicile of applicant must be recited in the application (sec. 1), 549.
drawing of the trademark required (sec. 1), 549.
duration of the certificate of registration (sec. 12), 576.
equity, aggrieved parties may resort to (secs. 17, 19, 22, 23), 581, 583, 584.
evidence:
copies under seal to be received as (sec. 11), 575.
of ownership, registration to be *prima facie* (sec. 16), 579.
of registry (sec. 11), 575.
examination of applications:
applicant to be notified of the result of (sec. 6), 565.
commissioner of patents to cause (sec. 6), 565.
fac-similes of trademarks, when to be filed (sec. 1), 549.
false registration, damages for (sec. 25), 585.
fees:
additional fee not required for applications pending at the date of passage of this act (sec. 14), 578.
for copies (sec. 14), 578.
for recording assignments (sec. 14), 578.
for registration or renewals (secs. 1, 14), 549.
if paid by mistake may be refunded (sec. 15), 579.
on appeal to the commissioner of patents (secs. 8, 14), 573, 578.
on filing notice of opposition (sec. 14), 578.
flags or coats of arms not registrable (sec. 5), 556.
foreigners:
entitled to date of application in country of residence in certain cases (sec. 4), 556.
must designate representative in the United States (sec. 3), 555.
must first register in country of residence (secs. 2, 4), 554, 556.
must give date of registration in country of residence or date of application therefor (sec. 2), 554.

References are to pages.

Statutes, Federal: Act of February 20, 1905—Continued.
foreigners:—continued.
must reside in a country affording similar privileges to the citizens of the United States (sec. 4), 556.
need not state that mark has been used in commerce with the United States or among the states thereof (sec. 2), 554.
notices for, may be served on their representatives in the United States (sec. 3), 555.
when entitled to register (secs. 1, 2, 4), 549, 554, 556.
foreign nations, registration of trademark used in commerce with (sec. 1), 549.
foreign powers conventions or treaties with, and laws of, as affecting right of registration (secs. 1, 4), 549, 556.
former rights and remedies preserved (secs. 12, 23), 576.
fraud in obtaining registration, bars an action (sec. 21), 583.
fraudulent:
declaration and registration, damages for (sec. 25), 585.
trademarks, damages for affixing same to merchandise (sec. 16), 579.
geographical terms, not registrable (sec. 5), 556.
goods, particular description of, to be recited (sec. 1), 549.
identity with other trademarks bars registration when (sec. 5), 556.
imitation of registered trademarks, penalty for (secs. 16, 19), 579, 581.
immoral or scandalous matter not registrable (sec. 5), 556.
importation of articles of merchandise bearing unlawful trademarks prohibited (sec. 27), 585.
Indian tribes, registration of trademarks used in commerce with (sec. 1), 549.
infringement, remedy for (secs. 16, 19), 579, 581.
injunction:
action for, when barred (secs. 21, 28), 583, 586.
against the wrongful use of a regsitered trademark (sec. 19), 581.
may be enforced by proceedings to punish for contempt (sec. 20), 582.
may be enforced in any jurisdiction (sec. 20), 582.
notice of, may be served wherever defendant can be found in United States (sec. 20), 582.
injurious articles, action may not be brought on trademarks used on (sec. 21), 583.
interferences:
examiner in charge of has jurisdiction over—
cancellations (sec. 13), 576.
interferences (sec. 7), 570.
oppositions (sec. 7), 570.
when declared (sec. 7), 570.

References are to pages.

Statutes, Federal: Act of February 20, 1905—Continued.
interfering trademarks, suits, and proceedings in equity (sec. 22), 583.
issue of certificates of registration (secs. 6, 11), 565, 575.
to assignees (sec. 11), 575.
jurisdiction:
of the commissioner of patents (secs. 8, 13), 573, 576.
of the examiner of interferences (secs. 7, 13), 570, 576.
original and appellate, of the United States courts (secs. 9, 16, 17, 18, 19, 20, 22), 574, 579, 581, 582, 583.
lawfulness of claim to trademark to be decided by the commissioner (sec. 6), 565.
lawful trademarks, or those used lawfully, alone registrable (sec. 5), 556.
length of time of use of trademark to be recited (sec. 1), 549.
list of trademarks to be published in the Official Gazette (sec. 6), 565.
location of applicant to be specified (sec. 1), 549.
merchandise bearing unlawful trademarks, importation prohibited (sec. 27), 585.
merchandise, class of, to be recited (sec. 1), 549.
mistake, or confusion in the public mind caused by similarity of trademarks, bars registration (sec. 5), 556.
mode of affixing trademark to be recited (sec. 1), 549.
name of applicant:
not registrable, except on certain conditions (sec. 5), 556.
to be specified in the application (sec. 1), 549.
notice of opposition and of the grounds therefor to be given to applicants (sec. 7), 570.
notice of registration:
registrants must give (sec. 28), 586.
form of (sec. 28), 586.
notice for foreign applicants may be served on their representatives in the United States (sec. 3), 555.
oath to declaration may be made before whom (sec. 2), 554.
oppositions:
may be made by any person who believes he would be damaged by registration (sec. 6), 565.
must be accompanied by fee (sec. 14), 578.
notice of grounds of opposition shall be given to applicants (sec. 7), 570.
notice of, must be filed within 30 days after publication (sec. 6), 565.
notice of, must be verified (sec. 6), 565.
proceedings under (sec. 7), 570.

References are to pages.

Statutes, Federal: Act of February 20, 1905—Continued.
oppositions:—continued.
publication of trademarks in Official Gazette before registration to enable opposition to be made (sec. 6), 565.
"owner" defined (sec. 29), 586.
ownership, registration to be *prima facie* evidence of (sec. 16), 579.
penalty:
for false or fraudulent registration (sec. 25), 585.
for imitation of trademark (secs. 16, 19, 20), 579, 581, 582.
"person" defined (sec. 29), 586.
petition, to contain what (sec. 1), 549.
portraits of living individuals not registrable without their consent in writing (sec. 5), 556.
printed copies of specifications to be kept of record (sec. 11), 575.
printed copies of trademarks to be furnished by the office (secs. 11, 14), 575, 578.
profits may be recovered (sec. 19), 581.
publication of trademarks in the Official Gazette (sec. 6), 565.
publications, prices of copies of (sec. 14), 578.
recording:
fees for (sec. 14), 578.
of assignments (sec. 10), 574.
records of trademarks, statements, declarations, etc., to be kept (sec. 11), 575.
refunding of fees (sec. 15), 579.
refusal of an application (secs. 6, 7), 565, 570.
"registrant" defined (sec. 29), 586.
registrants under the Act of 1881, rights of (sec. 12), 576.
registration:
authorized by (sec. 1), 549.
bars to (secs. 1, 2, 4, 5), 549, 554, 556.
by residents of foreign countries (secs. 1, 3), 549, 555.
certificates of—
duration (sec. 12), 576.
how and when issued (secs. 6, 11), 565, 575.
renewal of (sec. 12), 576.
use of, in courts as evidence (sec. 11, 16), 575, 579.
fees for (sec. 14), 578.
how effected (secs. 1, 2), 549, 554.
marks not registrable (sec. 5), 556.
obtained by false or fraudulent representation, damages for (sec. 25), 585.
of marks used 10 years prior to the passage of this act (sec. 5), 556.
records of, to be kept (sec. 11), 575.
renewal of, can be made, when (sec. 12), 576.

References are to pages.

Statutes, Federal: Act of February 20, 1905—Continued.
registration:—continued.
right to—
as affected by citizenship of applicant (secs. 1, 4), 549, 556.
as conferred by treaty, or convention with a foreign power, or by the laws of a foreign country (secs. 1, 4), 549, 556.
rules for, to be prescribed by the commissioner (sec. 26), 585.
to be *prima facie* evidence of ownership (sec. 16), 579.
use in foreign or Indian or interstate commerce, a prerequisite to (sec. 1), 549.
who is entitled to (secs. 1, 4), 549, 556.
regulations and rules to be prescribed by the commissioner (sec. 26), 585.
remedies for infringements (secs. 16, 19, 20, 23), 579, 581, 582, 584.
renewal of certificate of registration (sec. 12), 576.
must be made not more than six months prior to expiration (sec. 12), 576.
who may request (sec. 12), 576.
representatives in the United States, foreign applicants must designate (sec. 3), 555.
reproduction and use of registered trademarks, penalty for (secs. 16, 19, 20), 579, 581, 582.
resemblances to other marks must be avoided (sec. 5), 556.
residence of applicants required (sec. 1), 549.
restrictions:
on actions for damages or an injunction (secs. 21, 28), 583, 586.
on actions for infringement (secs. 21, 28), 583, 586.
on registration (sec. 5), 556.
review by commissioner of adverse decision (sec. 9), 574.
right to use the trademark must belong exclusively to the applicant (sec. 2), 554.
rights at common law or equity not abridged (sec. 23), 584.
rules and regulations to be prescribed by the commissioner (sec. 26), 585.
scandalous or immoral matter not registrable (sec. 5), 556.
schedule of fees (sec. 14), 578.
similarity to other trademarks, bars registration when (sec. 5), 556.
specifications, printed copies of, to be kept of record (sec. 11), 575.
specimens of the trademark required (sec. 1), 549.
statement of applicant:
to recite what (sec. 1), 549.
recording of (sec. 11), 575.
"states," defined (sec. 29), 586.
states, registration of trademarks used in commerce between (sec. 1), 549.

References are to pages.

Statutes, Federal: Act of February 20, 1905—Continued.
ten years' use prior to the passage of this act permits registration of certain marks (sec. 5), 556.
term of registration:
duration of (sec. 12), 576.
limitation of (sec. 12), 576.
renewal of (sec. 12), 576.
time of use to be recited (sec. 1), 549.
"trademark" defined (sec. 29), 586.
trademarks to be published in Official Gazette (sec. 6), 565.
transfers of the right of use, how regulated (sec. 10), 574.
treasury department, deposit of trademark in (sec. 27), 585.
treaties, as conferring the right of registration (secs. 1, 4), 549, 556.
United States:
citizens of, may obtain registration, when (sec. 1), 549.
courts of, to have jurisdiction, when (secs. 16, 17, 18, 19), 579, 581.
definition of the term "United States" as used in this act (sec. 29), 586.
unlawful business, use of trademarks in, bars an action (sec. 21), 583.
use:
if in an unlawful business, bars an action (sec. 21), 583.
if wrongful, common-law and equitable rights unimpaired (sec. 23), 584.
length of time of, to be recited (sec. 1), 549.
mode of, to be recited (sec. 1), 549.
right of, must be exclusive with the applicant (sec. 2), 554.
right of, transfers of (sec. 10), 574.
unlawful, of trademarks, damages or injunctions (secs. 16, 19, 20), 579, 581, 582.
verification of declaration, how and by whom made (sec. 2), 554.
writ of *certiorari*, may be granted by the Supreme Court of the United States (sec. 18), 581.

Statutes, Federal: Prints and Labels—(Act of 1874)—
art, works of, not registrable (sec. 3), 513.
commissioner: 513.
jurisdiction as to registration (sec. 3), 513.
to sign and seal the copy of record of registration (sec. 3), 513.
copyright law, application to registry of prints and labels (sec. 3), 513.
cut, the word construed as meaning what (sec. 3), 513.
engraving, the word construed as meaning what (sec. 3), 513.
fees for registration (sec. 3), 522.
fine arts, registry not allowed to illustrations or works connected with (sec. 3), 513.
illustrations, when registrable (sec. 3), 514.

References are to pages.

Statutes, Federal: Prints and Labels—(Act of 1874)—Continued.
labels, registration of (sec. 3), 514.
law of copyright, application of to registry of prints and labels (sec. 3), 514.
Patent Office rules, 517..
pictorial illustrations, when registrable (sec. 3), 515.
print, the word construed as meaning what (sec. 3), 515.
record of registration, copy of, fee for (sec. 3), 522.
registration, provisions as to (sec. 3), 519.
works of art, not registrable (sec. 3), 516.

Statutes, Federal—
Section 3449, R. S. U. S., 408.

Statutes, State—
Alabama, 620.
Alaska, 620.
Arizona, 620.
Arkansas, 621.
California, 19, *n.* 40, 628.
Colorado, 638.
Connecticut, 643.
Delaware, 649.
Florida, 653.
Georgia, 657.
Idaho, 661.
Illinois, 664.
Indiana, 669.
Iowa, 674.
Kansas, 677.
Kentucky, 679.
Louisiana, 679.
Maine, 683.
Maryland, 686.
Massachusetts, 689.
Michigan, 696.
Minnesota, 700.
Mississippi, 709.
Missouri, 710.
Montana, 720.
Nebraska, 721.
Nevada, 723.
New Hampshire, 724.
New Jersey, 727.
New Mexico, 737.
New York, 738.

References are to pages.

Statutes, State—Continued.
North Carolina, 757.
North Dakota, 764.
Ohio, 768.
Oklahoma, 774.
Oregon, 776.
Pennsylvania, 782.
Rhode Island, 786.
South Carolina, 791.
South Dakota, 795.
Tennessee, 801.
Texas, 805.
Utah, 807.
Vermont, 809.
Virginia, 813.
Washington, 817.
West Virginia, 822.
Wisconsin, 826.
Wyoming, 829.

"Steel Shod" (shoes), 111.

"Steinway," 331.

"Stephens," 331.

"Sterling" (ale), 129.

"Stillman Mills," 213.

"St. James" (newspaper, etc.), 130.

"Stock Belonging to the Partnership"—
includes goodwill, 227.

"Stock in Trade and Effects"—
goodwill not included in, 227.

Stock Quotations—
as property, 366.
contracts for, 366.
protection of, 366.

"Stoga Kip" (boots), 111.

"Stone Ales"—
case, 162, *n.* 72.

"Straight Cut" (cigarettes), 111.

Structure—
imitation of, 292.

"Stuart's Dyspepsia Tablets," 331.

References are to pages.

Submission—
by others as evidence of right to trademark, 472.
offer of on conditions insufficient, 492.
to avoid costs, 403, 404, 405, 438, 492.
must be complete, 491, 492.
may be made at any stage of the case, 491.

Subpoena Duces Tecum—
for drawings enforced against objection they relate to secret process, 263.

"Substitution"—
defined, 317.

"Successor to"—
right of purchaser of business to advertise as, 230.

Suggestiveness—
does not invalidate, 95, 96, 194, 195.

Suits in Equity—
for invasion of goodwill, 245.
generally, 424.

"Sunlight" (soap), 130, 331.

Supreme Court (U. S.)—
appeals to under Act 1905, 581.
certiorari from, under Act 1905, 581.

Surname—
as trademark, 173.
registrable under Act of 1881, 564.

"Svenska Snusmaganiset," 112.

"Swan," 331.

"Swan Down" (complexion powder), 130.

"Sweet Caporal" (cigarettes), 130.

"Sweet Lotos" (tobacco), 112.

"Sweet Opoponax of Mexico" (perfume), 130.

"Swing" (scythe-sockets), 112.

Symbol—
as trademark, 4, *n.* 3, 158.
may be infringed by, or infringe, a word, 332.

Syphons—
acts to protect (see statutes of the several states).

"Syrup of Figs" (medicinal preparation), 149.

"Syrup of Red Spruce Gum" (medicine), 130.

Systems of Licensing, 155.

References are to pages.

T

"Taffy Tolu" (chewing gum), 112.

Tags—
as trademarks, 281, 283.

Tailor—
goodwill of, 222.

"Tamar Indien" (lozenges), 130, 144.

"Tasteless" (drugs), 112.

Taxation of Good-Will, 226.

Taxation of Trade Secrets, 263.

Taxation of Trademarks, 60.

Telegraph Blanks—
not merchandise within Act of 1881, 546, *n.* 34.

"Telegraphone," 336.

Telephone Number—
as medium of unfair competition, 113.

Tendency—
to deceive, as test of infringement, 305.

Tennessee Statutes, 801.

Ten-Year Clause—
explained, 564.

Term of Registration, 576.

Territorial Limitation—
none as applied to trademarks, 21.

Territorial Right—
assignability, 20, 29.
assignment of refused recordation, 575.

Tests of Infringement, 19.

Texas Statutes, 805.

Theatre—
name of, 179.

"The Demon," 323.

"The Good Things of Life" (periodical), 130.

References are to pages.

"The Nile" (playing cards), 130.

Thomsonian (medicines), 112.

"Thomson's Glove-Fitting Corsets," 241.

Threats—
as unfair competition, 372.

"Tidal Wave" (tobacco), 130.

Time—
as an element in unfair competition, 189.
required to create trademark right, 64, *n.* 16.

"Time-Keeper" (watches), 112.

Tin Tag—
not a trademark, 281.
fraudulent imitation of, enjoined, 281.

Title—
book, as trademark, 93.
former adjudication establishing, conclusive on application for preliminary injunction, 453.
of periodical as trademark, 198.
of play as trademark, 202.
registration only *prima facie* evidence of, 441.
should be pleaded, 441.

"Tipo" (wine), 112, 148.

"Tivoli" (beer), 130.

"Tod" (watches), 144.

"Tonge's," 331.

"Toothache Gum," 112.

"Tower Palace" case, 213.

Trade Libel, 53.
slander or libel not actionable in absence of proof of special damage, 54.

Trademark—
abandonment of, 210.
acquisition of, generally, 61, 65, 72.
adjectives as, 97.
alien can not have, as against a citizen making prior adoption in good faith, 68.
analogy of to goodwill, 28.
article itself is not, 139.
as monopoly, 56.
assignability of, 27.

References are to pages.

Trademark—Continued.
assignment by implication, 30.
assignment of territorial rights in, 20, 29.
bequest of, 31.
can not exist "in gross": must be "appendant," 25.
can only be assigned with goodwill, 36.
casual use can not create, 64.
counterfeiting, 300.
courts not critical of, where fraudulent competition exists, 441.
defined, 4.
defined by Act of 1905, 586.
dependent on priority of appropriation, 69.
distinguished from patents and copyrights, 17.
distinguished from tradename, 10.
does not become *publici juris* through extensive sales, 134.
earliest recognition of, 15.
evolution of the law of, 16.
function of, defined, 17.
imitation of, may be limited or partial, 279.
includes the French *marque de fabrique* and *marque de commerce*, 7.
infringement akin to forgery, 57.
in initials, 340.
in name of secret preparation, 253.
inseparable from business, 25.
inseparable from goodwill, 31, 32.
in title of book, 196.
in title of periodical, 198.
in title of play, 202.
invalidated by dishonest label, 76.
is an assurance of quality, 132.
letters and numerals as, 338.
"made-up" words as, 142.
may be a word in common use, when, 95.
may be purely fanciful, 95.
may consist of word from dead language, 143.
may indicate natural product, 94.
may pass by implication as incident to realty, 37.
method of arranging goods, 142.
misspelling generic word does not make, 95.
mode of affixing, immaterial, 9, *n.* 6.
must be distinctive, 4, 5, 6, 7, 8, 9, *n.* 4.
must be exclusive, 7, 20.
must be meaningless, 80, *n.* 19.
must be truthful, 75.
must not be common to the trade, 69, 134.
names as, 4.

References are to pages.

Trademark—Continued.
need not indicate manufacture or place of manufacture, 9, *n.* 5.
none in name of patented article after expiration of patent, 93.
no right of, in form, size or color, 139, 282.
no right of, in necessary name of product, 136.
not acquired by registration, 19.
not defined by Acts of 1870 and 1881, 536, *note.*
of bankrupt, 30.
of partnership, passes with sale of goodwill, 31.
or variable sound and pronunciation, 349.
on product of secret process, 265.
packages as, 140.
perpetual existence of, 21.
pictures as, 80, 141.
printing generic word in letters from foreign alphabet does not make, 95.
proper names can not constitute, 94.
remotely descriptive word may be, 96.
reproduction of, proof of fraudulent intent, 294.
requisites of valid, 20.
right acquired only by adoption and actual use, 25.
right of, in word applied to patented article during life of the patent, 92.
where use of mark antedates patent, 90.
right to, a common-law right, 19.
right to, a right of property, 18.
right to, may be common to several owners, 32, 58.
right to, must be exclusive, 7, 20.
right to, is not monopoly, 2, 56.
right to, protected in territory under military government of the United States, 609.
suggestive words may be, 95, 96.
taxation of, 60.
territorial limitation, 21, 23.
territorial rights to, can not be conveyed, 20, 29.
the law of, but part of law of unfair trade, 4, 49, 50.
unlawful to apply to manufacturer's product to which he does not intend its application, 315.
water-mark may be, 9.
what are essential features of, 537, *n.* 13.
words and devices common to the trade can not be, 132, 133, 134.
words of variable sound, 349.
words from dead languages 143.
words from foreign languages, 143.
words of double meaning as, 194.
valid, illustrations, 114.

Trademark Rules of Patent Office—

Subject.	Rules.	Pages.
Abandoned applications	45 (*a*) 57 (*a-d*)	599, 603
Abandoned trademarks	19	591
Act of 1881, rights of registrants under	61	605
Action of the office to be directed to the merits	39	598
Additions to papers not permitted	42	598
Advertising stamp of attorneys not permitted on drawings	36 (7)	597
Allowance:		
Amendments after	44	599
Notice of	40	598
Amendments:		
After allowance	44	599
Form of	42	598
In general	41, 42 43, 44, 45	598, 599
New matter not permitted in	41	598
To amendment, form of	43	598
To applications filed under Act of 1881	26	593
Will give such applications new serial numbers and dates of filing	26	593
To declaration, will not be permitted	35	596
To rules, will be published in the Official Gazette	74	608
To statement, when permitted	41	598
Appeals:		
To the Commissioner of Patents	56	603
To the Court of Appeals of the District of Columbia	57	603
Applicant:		
Foreign, must file certified copy of foreign registration in certain cases	17	590
May prosecute his own case	11	589
Should not correspond with office if he has an attorney	7, 8	588
Applications:		
Abandoned	45 (*a*) 57 (*a-d*)	599, 603
Are preserved in secrecy	25	593
Conflicting, practice, etc.	46, 47 48, 49, 50	601
Date of, in foreign country, must be stated, when	33	595

Trademark Rules of Patent Office—Continued.

Subject.	Rules.	Pages.
Applications:—continued.		
Examination of	38, 39, 40	597, 598
Fee on filing	22 (*f*), 69	593, 606
Filed under Act of 1881 may be amended	26	593
Will be given new serial numbers and dates of filing under Act of Feb. 20, 1905	26	593
May be assigned	63	605
May include all goods comprised in a single class upon which trademark is used	30	594
Suspension of	45 (*b-d*)	599
To contain what, form of	22	592
Assignments:		
Fees for recording	69	606
Must be recorded within three months	64	606
Orders for copies of, must give liber and page of record	67	606
Provisions regulating	63, 64, 65	605
Attendance of applicants in person not necessary	6	588
Attorneys:		
Correspondence will be held with	7	588
Disbarment of	15	590
In general	11, 12, 13, 14, 15	589
May not act as notary	34	596
Registration of	11	589
Stamp of, not permitted on face of the drawing	36 (7)	597
Substitution of	13	589
Bars to registration	17, 19	590, 591
Cancellation, proceedings for	52, 53, 54, 55	602
Certificate of registration:		
Date of	40	598
Duration of	59	604
Issue of	40, 58	598, 604
Issued under Act of 1881, shall remain in force.	61	605
May be renewed under Act of Feb. 20, 1905.	61	605
Description of the trademark itself required, when (see statute)	22 (*b*)	592
Descriptive marks not registrable	19	591
Disbarment of attorneys	15	590
Domicile to be recited (see statute)	22 (*b*)	592

Trademark Rules of Patent Office—Continued.

Subject.	Rules.	Pages.
Double correspondence not allowed	8	588
Drawing:		
Furnished by the office	37	597
Must not be folded	36 (6)	597
Requisites of	36	596
Duration of term of registration	59	604
Emblem of fraternal society not registrable	19	591
English language to be used in the application papers and assignments	23, 63	593, 605
Erasures by applicant or attorney not permitted	42	598
Examination:		
Applicants will be notified of the result of	38	597
Of applications	38, 39, 40	597, 598
Of applications for registration of trademarks previously registered under Act of 1881	26	593
Examiner in charge of trademarks, original jurisdiction of proceedings before	38	597
Express charges must be prepaid	10	589
Fac-simile of trademark, when to be filed	22 (*e*)	593
Fees:		
Additional fee not required for applications pending at the date of the passage of Act of Feb. 20, 1905	26	593
How paid	3, 70, 71	588, 607
Refunded, when	72	608
Schedule of	69	606
Flags or coats of arms not registrable	19	591
Foreigners:		
Entitled to date of application in country of residence in certain cases	27	594
Having manufacturing establishments within the United States may obtain registration, when	18	590
Must designate representative in United States.	28	594
Must file certified copy of foreign registration unless application is made under section 3 of the Act of May 4, 1906	17, 18	590
Must first register in country of residence unless application is made under section 3 of the Act of May 4, 1906	18, 62	590, 605

Trademark Rules of Patent Office—Continued.

Subject.	Rules.	Pages.
Foreigners:—continued.		
Must give date of registration in country of residence or date of application therefor unless application is made under section 3 of the Act of May 4, 1906	33	595
Must reside in a country affording similar privileges to the citizens of the United States unless application is made under section 3 of the Act of May 4, 1906	17	590
Need not state that mark has been used in commerce with the United States or among the states thereof unless application is made under section 3 of the Act of May 4, 1906	17	590
Notices for, may be served on their representatives in the United States	29	594
When entitled to register	17, 18	590
Foreign nations, registration of trademarks used in commerce with	19	591
Fraternal society, emblem of, not registrable	19	591
Geographical terms not registrable	19	591
Goods, particular description of, to be recited (see statute)	22 (*b*)	592
Goods, to be included in a single registration, must be comprised in a single class	30	594
Immoral or scandalous matter not registrable	19	591
May be issued to an assignee	65	606
May be canceled	52	602
Renewal of	60	605
Will not be issued to foreign applicants until they have obtained registration in country of residence, except as provided by section 3 of the Act of May 4, 1906	18, 62	590, 605
Charges for express, postage, etc., must be prepaid.	10	589
Citizenship:		
As affecting right to register	16	590
Of applicant to be recited	22 (*b*)	592
Class of merchandise to be recited in application	22 (*b*)	592
Coats of arms not registrable	19	591
Commerce:		
Between states	19	591

Trademark Rules of Patent Office—Continued.

Subject.	Rules.	Pages.
Commerce:—continued.		
Foreign applicants need not state that the trademark has been used in commerce with the United States or among the state thereof, unless application is made under section 3 of the Act of May 4, 1906	18, 33	590, 595
With foreign nations	19	591
With Indian tribes	19	591
Commissioner of Patents:		
Appeals to	56	603
Communications to be addressed to	3	588
Petitions to	56	603
No fee required for	56	603
Communications. (See Correspondence.)		
Conflicting applications, interferences, patent practice to govern in	46	599
Copies of actual trademark required from applicant	22 (*c*)	593
Copies of publications, prices of	69	606
Copy of foreign registration required of foreign applicants unless application is made under section 3 of the Act of May 4, 1906	17	590
Corporations must recite under the laws of what state or nation incorporated	22 (*b*)	592
Correspondence:		
Charges for postage, etc., must be prepaid	10	589
Checks, drafts, etc., to be drawn to the Commissioner's order	3	588
Decorum and courtesy required	2	588
Double correspondence not permitted	8	588
Letters relating to application should state what	5	588
Letters relating to registered marks should state what	5	588
Must be addressed to the Commissioner of Patents	3	588
Must be in writing	1	588
Office can not expound the law, etc	9	589
Personal attendance unnecessary	6	588
Separate letter for each subject of inquiry required	4	588
Will be held with the attorney	7	588

Trademark Rules of Patent Office—Continued.

Subject.	Rules.	Pages.
Courtesy and decorum required of applicants and attorneys	2	588
Date of certificate of registration	40	598
Deceptive trademarks not registrable	19	591
Declaration:		
In general	15, 31, 32 / 33, 34, 35	590, 595 / 596
May not be amended	35	596
Requisites of	31, 32, 33	595
For foreign applicants	33	595
Under ten-year proviso	32	595
To be verified before whom	34	596
Decorum required from applicants and attorneys	2	588
Indian tribes, registration of trademarks used in commerce with	19	591
Information of certain kinds not furnished	9, 25	589, 593
Injurious articles, trademarks used on, not registrable	19	591
Insertions by applicants or attorneys not permitted	42	598
Interferences:		
Commissioner's attention invited to—		
Irregularity in declaring	48	600
Matter not relating to priority	48	600
Statutory bar to registration	48	600
Examiner in charge of, has jurisdiction over—		
Cancellations	52, 54	602
Interferences	46	599
Oppositions	51, 54	601, 602
From decision of examiner of trademarks, appeal may be taken	48	600
Motion to dissolve, when made	49	601
Decision of examiner of trademarks binding upon examiner of interferences	50	601
Motion to shift burden of proof—		
Made before, and determined by, the examiner of interferences	49	601
Motion to stay proceedings	49	601
Not delayed by failure to prepare for	47	600
Preliminary questions must be settled by examiner of trademarks before declaration	47	600
Preparation for	47	600

Trademark Rules of Patent Office—Continued.

Subject.	Rules.	Pages.
Interferences:—continued.		
Publication of trademark must be made in the Official Gazette before interference is declared	47	600
Suspension of interference for consideration	48	600
Trademarks must have been decided to be registrable	47	600
When declared, practice	46, 47 48, 49, 50	599 600, 601
Issue of certificates of registration	58, 62	604, 605
To assignee	65	606
Lawful trademarks, or those used lawfully, alone registrable	19	591
Length of time used to be recited (see Statute)	22 (*b*)	592
Letters, rules and regulations governing. (See Correspondence.)		
List of trademarks to be published in the Official Gazette	68	606
Merchandise, class of, to be recited (see Statute)	22 (*b*)	592
Merits, office action to be directed to the	39	598
Mode of applying and affixing trademark to the goods to be recited (see Statute)	22 (*b*)	592
Mutilation of papers not permitted	42	598
Name of applicant not registrable, except under certain conditions	19	591
Name of applicant will be made uniform	24	593
Name of applicant to be recited (see Statute)	22 (*b*)	592
New matter not permitted by amendment	41	598
Notary, attorney may not act as	34	596
Notice of allowance	40	598
Notice of opposition, and of the grounds therefor, to be given to applicants	54	602
Notice of registration:		
Form of	73	608
Registrants must give	73	608
Notices for foreign applicants may be served on their representatives in the United States	29	594
Oath, to be made before whom	34	596
Oppositions:		
May be made by any person who believes he would be damaged by registration	51	601

Trademark Rules of Patent Office—Continued.

Subject.	Rules.	Pages.
Oppositions:—continued.		
May be filed by attorney	51	601
Must be accompanied by fee	51	601
Notice of grounds of opposition shall be given to applicants	54	602
Notice of, must be filed within thirty days after publication	51	601
Notice of, must be verified	51	601
Proceedings under	51, 54, 55	601, 602
Orders for copies, to specify what	67	606
Personal attendance of applicants unnecessary	6	588
Petitions to Commissioner of Patents	56	603
No fee required for	56	603
Petition to contain what	22 (*a*)	592
Portraits of living individuals not registrable without their consent in writing	19	591
Postage must be prepaid	10	589
Powers of attorney:		
Filing of	12	589
Requisites of	12	589
Revocation of	14	589
Printed copies of trademarks furnished by the office	66	606
Priority proceedings, patent practice to govern	46	599
Publication in the Official Gazette:		
Of registered trademarks	68	606
Of trademarks before registration	40	598
Publications, prices of copies of	69	606
Recording assignments	62, 63	605
Fees for	69	606
Refunding of fees	72	608
Refusal of an application, office proceedings	38, 39	597, 598
Registrants under Act of 1881, rights of	61	605
Registration:		
Barred, when	17, 19, 62	590,591,605
Certificate of, date, duration, etc	40, 59	598, 604
Of attorneys	11	589
Of marks used ten years prior to the passage of the Act of Feb. 20, 1905	20	592
Of particular trademarks, office can not advise as to	9, 25	589, 593
Renewal of	60	605
Who is entitled to	16, 17, 18	590

Trademark Rules of Patent Office—Continued.

Subject.	Rules.	Pages.
Remittances, how made	3, 70, 71	588, 607
Renewal of certificates of registration	60	605
Repayment of money, when made	72	608
Representatives in the United States, foreign applicants must designate	28	594
Residence of applicants required (see Statute)	22 (*b*)	592
Restrictions on registration	17, 19	590, 591
Return of papers lacking in courtesy and decorum	2	588
Return of application papers not allowed	45	599
Review by Commissioner of Patents of adverse decision	56	603
Scandalous or immoral matter not registrable	19	591
Schedule of fees	69	606
Secrecy, applications preserved in	26	593
Separate letters, when required	4, 42	588, 598
Signatures of applicants must be uniform	24	593
Specimens of the trademark required	22 (*c*)	593
Statement:		
May be amended	41	598
Must recite what	22 (*b*)	592
States, registration of trademarks used in commerce among	19	591
Substitute declaration, when required	35	596
Substitution of attorneys	13	589
Suspension of applications	45 (*b-d*)	599
Ten years' use prior to Feb. 20, 1905, permits registration of certain marks	20	592
Term of registration:		
Duration of	59, 61	604, 605
Renewal of	60, 61	605
Transfer of trademark rights (see also Assignments)	63	605
Unlawful business, trademarks used in, not registrable	19	591
Use:		
Manner, or mode of, to be recited	22 (*b*)	592
Time of, to be recited (see Statute)	22 (*b*)	592
Verification of declaration	34	596
Weekly issue to close on Thursday	40	598
Writing, business to be transacted in	1	588

INDEX TO TRADEMARK FORMS.

Subject.	Forms.	Pages.
Application for cancellation of a trademark	13	618
Declaration for:		
Applications under ten-year proviso	8	615
Associations	7	614
Corporations	7	614
Forms	5	613
Foreigners	9	616
Under section 3 of the Act of May 4, 1906	11	617
Individuals	3	612
Notice of opposition	12	617
Petition	1	611
Statement for:		
Associations	6	614
Corporations	6	614
Firms	4	613
Foreigners under section 3 of the Act of May 4, 1906	10	616
Individuals	2	612

References are to pages.

Trade Names—
defined, 10.
distinguished from trademarks, 10, 11, 12, 13, 14, 15, 48.
generally, 10.

"Trade Rights"—
conveys tradenames, 30, *n.* 78.

Trade Secrets—
actions and defenses, 266.
as subject of levy and sale, and taxation, 263.
conveyed with goodwill, 256.
defined, 253.
fraudulent, 254.
may be subject of expired patent, 261.
must be unknown to others, 261.
privilege of witness from disclosure, 255, 263, 264, 265.
subject to levy and sale, 263.
subject to taxation, 263.

Trade Slander, 53.

References are to pages.

Trades Union—
label of, as trademark, 62.

"Trafford," 331.

Treaty—
defined, 535, *n.* 6.
-making power of Congress, basis of Act of 1881, 380.

Treaties and Conventions—
as conferring right to registration, 549, 556.
judicial notice taken of, 467.
with foreign nations, enumerated, 909.

"Trenton," 540, *n.* 24.

"Trilby" (gloves), 130.

Trustee—
duty of, to protect title to trademark, 399.
in bankruptcy has title to bankrupt's trademarks, 30, ***n.* 79.**

Trusts—
concerning titles to trademarks, 399.

Truth—
indispensable to valid mark, 75.

"Tucker Spring" (bed), 112.

"Turpentine Shellac"—
as tradename, 14.

"Twin Brothers" (yeast), 131.

"Tycoon" (tea), 112.

U

Ultimate Consumer—
probable deception of, as test of infringement, 307.

"Unclean Hands"—
as a defense, 446.

"Uneeda" (biscuit), 12, 131, 331.

Unfair Competition (see Infringement, and Jurisdiction)—
between vendor and vendee of goodwill, 230.
bill in equity to enjoin, 430, *n.* 22.
by improper use of proper name, restrained, 47.
by use of tradename, 14, *n.* 21.
distinguished from trademark infringement, 47.

References are to pages.

Unfair Competition (see Infringement, and Jurisdiction)—Continued.
generic words protected against, 47.
in what it consists, 2.
law of, includes law of trademarks, 4.
law of, is well settled, 42.
relief against, based on fraud against the plaintiff and the public, 47.

Union Labels—
and other marks of trades unions, 507, 532, 867.
as trademarks, 62.
infringement of, enjoined because unfair competition, 62.

"Union Metallic Cartridge Co.," 542.

"Union Station" (cigars), 303.

"United States" (dental rooms), 112.

United States—
defined in Act of 1905, 586.

United States Statutes (see Statutes, Federal).

"Universal," 331.

Unwary—
deception of, as test of infringement, 304.

User—
a prerequisite to acquiring trademark, 539, 573.
after application filed, may be shown by supplemental petition, 539, *n.* 16.
casual, insufficient to create trademark right, 63, 64, 72.
character of, necessary, 64, 539.
held immaterial under Act of 1870, 64, 539.
must be shown to secure registration, 539.
must be actual, 63, 573.
must be upon goods actually upon the market, 70.
of trademark, limited to indicating origin and ownership, 157.
originally unlawful, not cured by abandonment of mark by owner, 71.
single instance of, sufficient to establish right to trademark, 64.

Utah Statutes, 807.

References are to pages.

V

"Vacuum" (tires), 113.

Validity—
as of date of adoption, 195.

Valuation of Goodwill, 32, 238.

Valuation of Trademark, 32,

Value of Trademark—
should be pleaded in federal practice, 415.

"Valvoline" (lubricating oil), 113, 131.

Variable Sound—
words of, as trademarks, 349.

"Velva," 336.

Vendee—
of goodwill, right to re-assign, 233.

Vendor—
of goodwill, rights of, 230.

Venue—
how laid in action at law, 414.

Verification—
of bill in equity, 430.

Vermont Statutes and Forms, 809.

"Vertical Top" (cigar molds), 113.

"Vichy" (mineral water), 335.

"Victoria" (lozenges), 113.

"Vienna" (bread), 166.

"Vita-Ore," 113, 331.

"Vitascope" (machine), 131.

Virginia Statutes and Forms, 813, 816.

"V-O" (medicine), 113.

Voluntary Association—
registration for mark used by, refused, 509, 533.

"Vulcan" (matches), 131.

References are to pages.

W

Waiver—
always question of fact, 208.
none without knowledge of facts, 208.

"Waltham" (watches), 10, *n.* 8.

"Wamsutta" (muslin), 308, 332.

Warehouseman—
submission of, to avoid costs, 493.

"Warren," 332.

"Warner" (corsets), 131.

Washington Statutes, 817.

Water-mark—
may be a trademark, 9, 65.

"Water of Ayr" (stone), 113.

"Waverly" (bicycles), 131.

"Weber" (pianos), 334.

"Webster's Dictionary." 113.

"Welcome" (soap), 332.

West Virginia Statutes, 822.

Wharfingers—
handling infringing goods, given lien for charges, 404.
lien of, upon infringing goods, 404.

"Whirling Spray" (syringes), 113.

"Willoughby Lake" (scythe-stones), 131.

Wisconsin Statutes, 826.

"Wistar's Balsam of Wild Cherry," 131.

Witness—
privilege as to disclosure of secret process, 263.

"Wonderful Magazine" Case, 198.

"Worcestershire" (sauce), 113.

References are to pages.

Words—
adjectives, 97.
as trademarks, 5, 95, 97, 141.
become generic through use, 148.
from a foreign language, 143.
libelous *per se*, 54.
may be infringed by, or infringe, a symbol, 332.
of double meaning, 194.
suggestive, 95.

Wrappers, 140.

Writ of Injunction—
form of, 791.

Wyoming Statutes, 829.

Y

"Yale" (locks), 113.

"Yama-Mai," 334.

"Yankee" (soap), 131.

"Yucatan" (leather), 113.

"Yusea," 332, 350.

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